Reports of Cases

OPINION OF ADVOCATE GENERAL
BOT
delivered on 1 February 2017 [1]

Joined Cases C-361/15 P and C-405/15 P

Easy Sanitary Solutions BV (C-361/15 P),
European Union Intellectual Property Office (EUIPO) (C-405/15 P)
v

Group Nivelles NV

(Appeals — Regulation (EC) No 6/2002 — Invalidity proceedings — Registered Community design representing a shower drain — Earlier design — Assessment of the novelty and individual character of the contested design — Burden of proof on the invalidity applicant — Requirements relating to the reproduction of the earlier design — Terms and scope of Article 3 of Regulation No 6/2002 — Competences conferred on EUIPO relating to the taking of evidence — Article 63(1) of Regulation No 6/2002 — Limits of the General Court's power of judicial review — Article 61(2) of Regulation No 6/2002 — Ground involving a matter of public policy)

I – Introduction

1. The present cases should lead the Court to clarify the scope of the terms and basic principles for the application of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs. [2]

2. In particular, the Court should be prompted to consider the underlying objective of that regulation and the competences which should or should not be conferred upon the departments of the European Union Intellectual Property Office (EUIPO) in the context of the examination of an application for a declaration of invalidity of a registered Community design.

3. This dispute arose after I-Drain BVBA, now known as Group Nivelles N.V., submitted an application for a declaration of invalidity [3] of the registered Community design held by Easy Sanitary Solutions BV [4] which, according to that registration, relates to a 'shower drain'. In support of its application for a declaration of invalidity lodged at the EUIPO's Invalidity Division, Group Nivelles claimed that that design lacked novelty and individual character, relying on the existence of an earlier design which had been made available to the public. The many difficulties which arose during the examination of that application for a declaration of invalidity were related to the errors made both by the invalidity applicant, which did not duly submit its prior art, and by the EUIPO's Invalidity Division and Third Board of Appeal, which did not make a proper comparison of the designs at issue.

1 Original language: French.

2 OJ 2002 L 3, p. 1. That regulation was amended by Council Regulation (EC) No 1891/2006 of 18 December 2006 (OJ 2006 L 386, p. 14).

3 I-Drain BVBA has since been acquired by Group Nivelles N.V. ('Group Nivelles').

4 'ESS'.

4. In its judgment of 13 May 2015 in *Group Nivelles* v *OHIM — Easy Sanitary Solutions* (*Shower drainage channel*),[5] the General Court therefore annulled the decision of the Third Board of Appeal of EUIPO of 4 October 2012.[6]

5. By their appeals, EUIPO and ESS ask the Court, respectively, to set aside that judgment and to set it aside in part.

6. In this Opinion, I shall propose first of all that the Court raise of its own motion a ground based on the General Court's lack of competence. I consider that the General Court exceeded the limits of its power of judicial review under Article 61(2) of Regulation No 6/2002 in the examination of the incidental plea raised by ESS, and accordingly the judgment under appeal should, in my view, be set aside in part.

7. Secondly, I shall propose that the Court dismiss the appeal brought by EUIPO in Case C-405/15 P.

8. I shall first set out the reasons why, in my view, the General Court did indeed commit an error of law, in paragraphs 77 to 79 of the judgment under appeal, in requiring EUIPO to reconstruct the earlier design by combining the different component parts of the design reproduced in the various catalogue extracts annexed to the application for a declaration of invalidity. I shall explain that, since such an obligation is contrary to the terms and scope of Article 3 of Regulation No 6/2002, it cannot form part of the assessment of novelty of a design for the purposes of Article 5 of that regulation and cannot, as such, fall within the competences conferred upon the departments of EUIPO by Article 63(1) of that regulation.

9. I shall then set out the reasons why that finding, nevertheless, cannot lead to the judgment under appeal being set aside.

10. Thirdly and lastly, I shall propose that the Court dismiss the appeal brought by ESS.

II – European Union legal framework

A – Regulation No 6/2002

11. As set out in Article 3(1)(a) of Regulation No 6/2002, 'design' means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.

12. Under Article 4(1) of that regulation, a design is to be protected by a Community design to the extent that it is new and has individual character.

13. As set out in paragraph 2 of that article, a design applied to or incorporated in a product which constitutes a component part of a complex product is to be considered to be new and to have individual character only if the component part, once it has been incorporated into the complex product, remains visible during normal use of the product, and to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

5 T-15/13, EU:T:2015:281, 'the judgment under appeal'.

6 Case R 2004/2010-3 relating to invalidity proceedings between I-Drain BVBA and ESS.

14. Under Article 5(1)(b) of that regulation, a registered Community design is to be considered to be new if no identical design has been made available to the public before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.

15. In accordance with Article 5(2) of Regulation No 6/2002, moreover, designs are to be deemed to be identical if their features differ only in immaterial details.

16. According to Article 6(1)(b) of that regulation, a registered Community design is to be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced by any design which has been made available to the public before the date of filing the application for registration or, if a priority is claimed, the date of priority.

17. As set out in Article 7(1) of that regulation, for the purpose of applying Articles 5(1)(b) and 6(1)(b), a design is to 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 date on which the design for which protection is claimed has first been made available to the public, 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.

18. Article 10 of Regulation No 6/2002, entitled 'Scope of protection', provides in paragraph 1 that the scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.

19. According to Article 25(1)(b) of that regulation, a Community design may be declared invalid if it does not fulfil the requirements of Articles 4 to 9 of the regulation.

20. In Title VII, entitled 'Appeals', of that regulation, Article 61(2) provides that 'the action may be brought [before the Court of Justice] on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power'.

21. In Title VIII, entitled 'Procedure before the Office', of Regulation No 6/2002, Article 63(1) provides, moreover, that 'in proceedings before it the Office shall examine the facts of its own motion. However, in proceedings relating to a declaration of invalidity, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought'.

22. Under Article 65(1) of that regulation, EUIPO may, in any proceedings before it, adopt means of giving or obtaining evidence and may, in particular, hear the parties and the witnesses, request information and the production of documents and items of evidence, and request opinions by experts.

B – Regulation No 2245/2002

23. Finally, Article 28(1)(b)(v) and (vi) of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation No 6/2002[7] provides as follows:

'1. An application to the Office for a declaration of invalidity pursuant to Article 52 of Regulation [No 6/2002] shall contain:

…

7 OJ 2002 L 341, p. 28, 'the implementing regulation'.

(b) as regards the grounds on which the application is based:

…

(v) where the ground for invalidity is that the registered Community design does not fulfil the requirements set out in Article 5 or 6 of Regulation [No 6/2002], the indication and the reproduction of the prior designs that could form an obstacle to the novelty or individual character of the registered Community design, as well as documents proving the existence of those earlier designs;

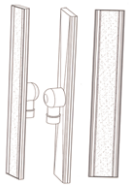
(vi) an indication of the facts, evidence and arguments submitted in support of those grounds;

…'

III – Background to the dispute

24. ESS is the holder of Community design registered under No 000107834-0025 filed on 28 November 2003 ('the contested design').

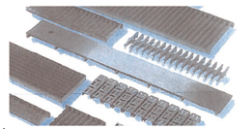
25. The contested design is represented as follows:



26. According to that registration, the design relates to a 'shower drain'.

27. On 3 September 2009, the applicant, I-Drain BVBA, made an application to EUIPO for a declaration of invalidity of the design based on Article 25(1)(b) of Regulation No 6/2002. In the application for a declaration of invalidity, the applicant claimed that the contested design did not fulfil the requirements under Articles 4 to 9 of Regulation No 6/2002 in so far as the part of that design which is visible during normal use, namely the non-perforated cover plate, lacked novelty and individual character.

28. In support of its application for a declaration of invalidity and in order to prove that an identical earlier design had been made available to the public, the applicant produced extracts of catalogues of products made by the undertaking Blücher, dated 1998 and 2000 [8] containing the following illustration ('the earlier design'):



29. By decision of 23 September 2010, the EUIPO Invalidity Division found that the contested design lacked novelty for the purposes of Article 5 of Regulation No 6/2002, and granted the application for a declaration of invalidity of the contested design based on Article 25(1)(b) of that regulation.

8 'The Blücher catalogues'.

30. The Invalidity Division took the view that the only visible feature of the design after installation was the cover plate. It thus considered that that cover plate was identical to the plate shown in the centre of the illustration reproduced in paragraph 28 above and, on that basis alone, granted the application for a declaration of invalidity.

31. On 15 October 2010, ESS brought an appeal against the decision of the Invalidity Division under Articles 55 to 60 of Regulation No 6/2002.

32. In those proceedings, the Third Board of Appeal of EUIPO allowed the new facts and evidence which the parties submitted in support of their claims.

33. By a decision dated 4 October 2012, the Third Board of Appeal annulled the decision of the Invalidity Division ('the decision at issue').

34. Unlike the Invalidity Division, the Third Board of Appeal of EUIPO considered that the contested design was composed not only of a rectangular cover plate but also of the elongated slots on either side of the cover plate and the outer edges of the shower drain. Accordingly it compared the contested design with the earlier design which, in its opinion, consisted 'of a very simple rectangular shower drain consisting of a cover plate with a hole in it'. [9]

35. On that basis, the Third Board of Appeal of EUIPO found that the contested design was novel for the purposes of Article 5 of Regulation No 6/2002 in so far as it was not identical to the earlier design since there were differences between the two designs which were 'easily perceivable' and were not 'minimal and difficult to appreciate objectively'. [10]

36. Consequently, the Third Board of Appeal of EUIPO remitted the case to the Invalidity Division.

IV – The procedure before the General Court

A – The pleas raised by the parties

37. By application lodged at the Registry of the General Court on 7 January 2013, Group Nivelles brought an action for the annulment of the decision at issue.

38. In support of its action, Group Nivelles put forward a single plea alleging that the Third Board of Appeal of EUIPO erred in comparing the contested design with the earlier design which Group Nivelles had relied on in support of its application for a declaration of invalidity. According to Group Nivelles, that error led the Third Board of Appeal of EUIPO to the incorrect conclusion that the contested design was novel for the purposes of Article 5 of Regulation No 6/2002. Accordingly, Group Nivelles produced a new document to prove that the contested design lacked novelty. The applicant also asked the General Court to alter the decision at issue.

39. In its response, lodged with the Registry of the General Court on 15 July 2013, ESS sought the annulment of the decision at issue on a ground other than those relied on by Group Nivelles in the application for annulment. ESS claimed that, in paragraph 31 of the decision at issue, the Third Board of Appeal of EUIPO, first, had not taken into account its arguments that the fact that the product in which the earlier design is incorporated is made for industrial use distinguishes the earlier design

9 Paragraph 31 of the decision at issue.

10 Paragraph 32 of the decision at issue.

from the contested design and, secondly, had failed to give sufficient reasons for its decisions in that regard.[11] ESS asserted, therefore, that the Third Board of Appeal of EUIPO had not correctly identified the earlier design, which had impacted on the assessment of the merits of the application for a declaration of invalidity.

B – The judgment under appeal

40. The judgment under appeal is made up of three parts.

41. In the first part, which consists of paragraphs 15 to 35 of that judgment, the General Court considered the questions of admissibility raised by ESS and EUIPO. That reasoning is not disputed in the present appeals.

42. In the second part of that judgment (paragraphs 36 to 92), the General Court examined the two heads of claim in Group Nivelles' action for annulment.

43. First (in paragraphs 36 to 88 of the judgment under appeal), the General Court upheld the single plea relied on by Group Nivelles.

44. In paragraphs 59 to 70, the General Court found that the Third Board of Appeal of EUIPO had in fact committed an error in its assessment of the novelty of the contested design in comparing all the visible features of the contested design with a single feature of the earlier design, with the result that, in the decision at issue, it did not draw the appropriate conclusions from the error which it found had been committed by the Invalidity Division. That reasoning is not disputed in the present appeals.

45. In paragraphs 71 to 86, the General Court then considered the arguments put forward by EUIPO and ESS in order to ascertain whether those arguments called that assessment into question. The General Court rejected all those arguments and then imposed on EUIPO a new requirement, which the latter contests in its appeal. Following that analysis, the General Court upheld the single plea put forward by Group Nivelles in its action and upheld Group Nivelles' action for annulment.

46. Secondly (in paragraphs 89 to 92 of the judgment under appeal), the General Court rejected Group Nivelles' claim for alteration of the decision at issue, holding that it did not fall to the General Court, in the place of the departments of EUIPO, to carry out a full assessment of the novelty of the contested design.

47. In the third and final part of that judgment (paragraphs 93 to 139), the General Court examined the incidental plea raised by ESS alleging infringement of the obligation to state reasons.

48. Having found, in paragraph 100 of that judgment, that the Third Board of Appeal of EUIPO had given sufficient reasons for its decision, the General Court, in paragraphs 102 to 133 of that judgment, considered whether identification of the precise product in which the earlier design, relied on in support of the application for a declaration of invalidity, is incorporated is relevant for the purposes of assessing the novelty or individual character of the contested design. Following that analysis, the General Court considered that it was, in fact, relevant for assessing the individual character of the contested design. It subsequently found that the Third Board of Appeal of EUIPO had incorrectly described the product shown in the centre of the illustration submitted in annex to the application for a declaration of invalidity as a 'shower drain', therefore upholding the action for annulment brought by ESS.

11 ESS submits that the earlier design relied on by Group Nivelles, including that shown in the Blücher catalogues, cannot call into question the novelty and individual character of the contested design since it covered different products, namely drainage channels for liquid waste, intended for industrial use.

49. By the judgment under appeal, the General Court therefore upheld both the single plea raised by Group Nivelles and the incidental plea raised by ESS and, consequently, annulled the decision at issue. However, the General Court rejected Group Nivelles' claim for alteration of that decision.

V – The forms of order sought and the procedure before the Court

50. By its appeal in Case C-405/15 P, EUIPO asks the Court to set aside the judgment under appeal and order Group Nivelles and ESS to pay the costs which it incurred.

51. ESS asks the Court to uphold the appeal as regards EUIPO's first two grounds of appeal and to order Group Nivelles to pay the costs incurred by EUIPO. It also asks the Court to dismiss the appeal as regards EUIPO's third ground of appeal and to order EUIPO to pay the costs incurred by ESS in relation to that ground of appeal.

52. Group Nivelles asks the Court to dismiss the appeal and to order EUIPO to pay the costs which it has incurred.

53. The United Kingdom, which, by order of the President of the Court of 20 January 2016, was granted leave to intervene in support of the form of order sought by EUIPO, asks the Court to set aside the judgment under appeal, though it asks to bear its own costs.

54. By its appeal in Case C-361/15 P, ESS asks the Court to set aside in part the judgment under appeal and to order the losing party to pay the costs of the proceedings.

55. EUIPO and Group Nivelles ask the Court to dismiss that appeal and to order the applicant to pay the costs incurred by each of them.

56. By order of the President of the Court of 8 June 2016, Cases C-361/15 P and C-405/15 P were joined for the purposes of the oral procedure and the judgment.

VI – Preliminary observations

57. In the present appeals, I propose that the Court raise of its own motion a ground which, to my mind, involves a matter of public policy, namely that the General Court exceeded the limits of its power of judicial review as defined in Article 61(2) of Regulation No 6/2002.

58. For reasons which I shall now set out, it seems that the General Court exceeded the competences conferred upon it in the context of its review of the legality of the decision at issue.

59. Infringement of the rules of competence constitutes an infringement of an essential procedural requirement and, as such, must be regarded as involving a matter of public policy which must be raised by the Court of its own motion. [12] The aim of those rules is to safeguard a fundamental value of the EU legal order, namely the institutional balance on which the division of powers between EUIPO and the General Court is based, and which is laid down by the legislature in Article 61 of Regulation No 6/2002. Moreover, those rules are clearly in the interest of the public in general.

12 According to the case-law, the lack of competence of the institution which has adopted the contested measure must be raised by the Community judicature of its own motion. See, to that effect, judgments of 10 May 1960, *Germany* v *High Authority* (19/58, EU:C:1960:19, p. 488); of 30 September 1982, *Amylum* v *Council* (108/81, EU:C:1982:322, paragraph 28); of 13 July 2000, *Salzgitter* v *Commission* (C-210/98 P, EU:C:2000:397, paragraphs 56 and 57); of 27 February 1992, *BASF and Others* v *Commission* (T-79/89, T-84/89 to T-86/89, T-89/89, T-91/89, T-92/89, T-94/89, T-96/89, T-98/89, T-102/89 and T-104/89, EU:T:1992:26, paragraph 31); of 24 September 1996, *Marx Esser and del Amo Martinez* v *Parliament* (T-182/94, EU:T:1996:130, paragraph 44); of 28 January 2003, *Laboratoires Servier* v *Commission* (T-147/00, EU:T:2003:17, paragraph 45), and of 21 September 2005, *Kadi* v *Council and Commission* (T-315/01, EU:T:2005:332, paragraph 61).

60. When an action for annulment has been brought before the General Court, the Court of Justice, whose role is to ensure that the law is observed, is therefore required to ensure that the General Court does not exceed the competences conferred on it by the legislature in the context of actions brought against decisions of the EUIPO Boards of Appeal.

61. In its case-law, the Court of Justice has, moreover, often held that the lack of competence of the institution which has adopted a contested measure constitutes an issue of public policy which may, and even must, be raised by the EU judicature of its own motion, even though none of the parties has asked it to do so. [13]

62. In the present case, the parties were invited to submit their observations on that point.

63. Therefore, I see no obstacle to the Court's raising of its own motion that ground which, to my mind, involves a matter of public policy.

VII – The ground involving a matter of public policy, alleging that the General Court exceeded the limits of its power of judicial review when examining the incidental plea raised by ESS

64. Under Article 61(2) of Regulation No 6/2002, an action against any decision of the EUIPO Boards of Appeal may be brought before the General Court for infringement of the Treaty, of that regulation or of any rule of law relating to their application.

65. According to the case-law, it follows from that provision that the General Court may annul or alter the decision against which an action has been brought only if, at the time the decision was adopted, it was vitiated by one of the grounds for annulment or alteration set out in Article 61(2) of that regulation. [14] Accordingly, the power of the General Court to alter decisions does not have the effect of conferring on that Court the power to substitute its own reasoning for that of a Board of Appeal of EUIPO or to carry out an assessment on which that Board of Appeal has not yet adopted a position. [15]

66. In its examination of the incidental plea raised by ESS and, in particular, in paragraphs 112 to 133 of the judgment under appeal, the General Court proceeded to consider whether the intended use of the product in which the earlier design relied on in support of the application for a declaration of invalidity is incorporated is actually relevant for the purposes of assessing the novelty or individual character of the contested design, an issue which the Third Board of Appeal of EUIPO had not addressed in the decision at issue.

67. Admittedly, in the present case, the parties had discussed this issue before the departments of EUIPO. [16] In paragraph 20 of its decision, the Invalidity Division had rejected the argument, explaining that the intended use of the product in which the earlier design is incorporated is not relevant for the purposes of comparing the designs at issue in so far as the intended use of the product bears no relation to its appearance.

68. Moreover, ESS had, once again, argued before the General Court that the fact that the product in which the earlier design is incorporated is made for industrial use has an impact on the assessment of the merits of the application for a declaration of invalidity. [17]

13 Judgment of 13 July 2000, *Salzgitter* v *Commission* (C-210/98 P, EU:C:2000:397, paragraph 56 and the case-law cited), and order of 13 April 2011, *Planet* v *Commission* (T-320/09, EU:T:2011:172, paragraph 41 and the case-law cited).

14 See, by analogy, judgment of 5 July 2011, *Edwin* v *OHIM* (C-263/09 P, EU:C:2011:452, paragraph 71).

15 Judgment of 5 July 2011, *Edwin* v *OHIM* (C-263/09 P, EU:C:2011:452, paragraph 72).

16 See paragraphs 104 to 111 of the judgment under appeal.

17 See paragraphs 93 to 96 and 101 of the judgment under appeal.

69. Nonetheless, as the General Court expressly stated in paragraph 111 of the judgment under appeal, the Third Board of Appeal of EUIPO 'did not comment [on that matter] in the [decision at issue]'.

70. Consequently, in examining in place of the Third Board of Appeal of EUIPO Articles 5 to 7 of Regulation No 6/2002 in the light of the arguments discussed and the evidence presented before the latter, the General Court altered the decision at issue without having first made a finding that that decision was vitiated by any of the grounds for annulment set out in Article 61(2) of Regulation No 6/2002 and, in particular, that it was vitiated by a defective statement of reasons.

71. The General Court's assessment is very contradictory in that regard.

72. ESS complained specifically that the Third Board of Appeal of EUIPO had failed to state reasons for its decision and had not taken into account the arguments put forward by ESS concerning the relevance, for the purposes of assessing the novelty of the contested design, of the use for which the product in which the earlier design is incorporated is intended, thereby rendering that decision incomprehensible. [18]

73. The General Court categorically rejected the plea alleging a failure to state reasons for the decision at issue and held, in paragraph 100 of the judgment under appeal, that the decision at issue 'does contain adequate reasoning in that regard, since paragraph 31 of that decision states that it concerns a "shower drain"'.

74. However, in the subsequent paragraphs, namely paragraphs 101 to 133 of that judgment, the General Court not only conducts a detailed examination of the relevance of that factor in the light of the arguments discussed and the evidence presented by the parties during the proceedings, and therefore in the place of the Third Board of Appeal of EUIPO, but also concludes that that factor is relevant for the purposes of assessing the individual character of the contested design.

75. That contradiction in the General Court's analysis is indisputably a result of the inadequacy of the statement of reasons for the decision at issue, which was not penalised as such by the General Court.

76. In my view, the General Court should have confined itself to finding that there had been a failure to state reasons for the decision at issue, and should not have prejudged the Third Board of Appeal's assessment of the arguments discussed before it by the parties. [19]

77. The role of the General Court is to satisfy itself that decisions of the EUIPO Boards of Appeal state the reasons on which they are based, in accordance with Article 62 of Regulation No 6/2002, since the obligation to state reasons is an essential procedural requirement, as the General Court rightly points out in paragraph 98 of the judgment under appeal. The Court of Justice, which provides the final tier of the judicial review procedure, must therefore be in a position to establish the treatment which the EUIPO Board of Appeal gave to the arguments put forward by parties and, where appropriate, the Board's reasons for rejecting those arguments.

78. Despite the fact that, in the present case, the third and final stage of the action has been reached, [20] it should be noted that the reasons why the Third Board of Appeal of EUIPO rejected the parties' arguments concerning the relevance, for the purposes of assessing the novelty of a design, of the intended use of the product in which the earlier design is incorporated, are still unknown.

18 See paragraphs 93 and 96 of the judgment under appeal.

19 Indeed, the General Court did take that approach when considering Group Nivelles' claim for alteration (paragraph 91 of the judgment under appeal).

20 An initial action was brought against the decision of the Invalidity Division before the Third Board of Appeal of EUIPO, the decision adopted by the EUIPO was challenged before the General Court, and the General Court's judgment is now under appeal.

79. In view of the lack of precision in the wording of the decision at issue, the General Court could not, therefore, carry out such an examination without first having annulled that decision for failure to state reasons.

80. By acting in place of the Third Board of Appeal of EUIPO in carrying out the analysis referred to in paragraphs 112 to 133, the General Court, in my view, exceeded the limits of its power to review the legality of decisions of the EUIPO Boards of Appeal as provided for in Article 61(2) of Regulation No 6/2002, thus exceeding its powers when examining the incidental plea raised by ESS.

81. Consequently, I take the view that the judgment under appeal should be set aside in part, in so far as the General Court, in paragraphs 112 to 133 of that judgment, assessed whether the identification of the product in which the earlier design is incorporated is relevant for the purposes of assessing the novelty or individual character of the contested design. [21]

82. In those circumstances, I propose that the Court should not examine EUIPO's third ground of appeal (C-405/15 P) or ESS' first ground of appeal (C-361/15 P), since they were directed against the General Court's assessment referred to in paragraphs 112 to 133 of the judgment under appeal.

VIII – The appeal brought by EUIPO in Case C-405/15 P

83. EUIPO raises three grounds in support of its appeal.

84. The first ground of appeal alleges an infringement by the General Court of Article 63(1) of Regulation No 6/2002 and raises the issue of the burden of proof and the taking of evidence in proceedings for a declaration of invalidity of a registered design.

85. The second ground of appeal alleges an infringement by the General Court of Article 5 of Regulation No 6/2002 read in conjunction with Article 25(1)(b) of that regulation. EUIPO criticises the General Court's assessments of the detailed rules for examining the novelty of the contested design.

86. Although they are based on very different legal provisions, the arguments put forward by EUIPO in support of those two grounds of appeal overlap and refer to paragraphs in the judgment under appeal which must be read and interpreted together. I shall therefore consider the first two grounds of appeal together.

87. Finally, the third ground of appeal alleges that the General Court infringed Articles 6 and 7 of Regulation No 6/2002, read in conjunction with Article 25(1)(b) of that regulation. EUIPO disputes, on this occasion, the reasoning adopted by the General Court as regards the relevance, for the purposes of assessing the individual character of the contested design, of the identification of the product to which an earlier design applies or in which an earlier design is incorporated.

88. In so far as that ground of appeal is directed against grounds of the judgment which I propose should be annulled because the General Court exceeded the limits of its power of review, I shall suggest that the Court should not examine it.

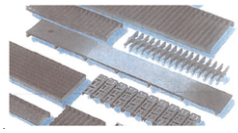
21 In its case-law, the Court has limited the scope of the General Court's review of the legality of decisions of EUIPO Boards of Appeal in industrial design matters to an examination of manifest errors of assessment where EUIPO is called upon to perform highly technical assessments, justifying that EUIPO be afforded some latitude (judgment of 18 October 2012, *Neuman and Galdeano del Sel* v *Baena Grup* (C-101/11 P and C-102/11 P, EU:C:2012:641, paragraphs 41 and 42 and the case-law cited)).

A – The first ground of appeal, alleging that the General Court infringed Article 63(1) of Regulation No 6/2002 and the second ground of appeal, alleging that the General Court infringed Article 5 of that regulation on the novelty of a Community design read in conjunction with Article 25(1)(b) of that regulation

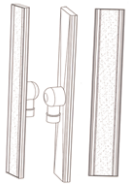
89. Before I begin my analysis of those grounds of appeal, it should be noted that the dispute which is now before the Court arose as a result of the failure properly to identify the earlier design claimed in the context of the invalidity proceedings, since Group Nivelles did not produce before the departments of EUIPO any images representing the whole of the drainage device for liquid waste available from Blücher. [22]

90. It is therefore important to bear in mind the context within which the departments of EUIPO assessed the novelty of the contested design and the way in which their assessment was carried out.

91. In its application for a declaration of invalidity, the applicant reproduced the part of the design which it considered to be visible during normal use, namely, the cover plate, represented in the Blücher catalogues as follows:



92. The Invalidity Division held that the only visible feature of the contested design, after installation, was the cover plate, represented as follows:



93. It found that that cover plate was identical to the plate represented in the earlier design and, on that basis, granted I-Drain's application for a declaration of invalidity.

94. The Third Board of Appeal of EUIPO held that other elements of the shower drain represented in the contested design remain visible after installation. It therefore compared the contested design, composed not only of a rectangular cover plate but also of the elongated slots on either side of the cover plate and the outer edges of the shower drain, with only the cover plate reproduced in the earlier design, thus concluding that the two designs were not identical and annulling the decision of the Invalidity Division.

95. Group Nivelles then produced a new document before the General Court, on page 76 of Annex A.9 of its application initiating the proceedings, showing a complete image of the drainage device for liquid waste available from Blücher. The General Court rightly held that document to be inadmissible.

22 It is clear from paragraph 68 and 76 of the judgment under appeal, which are not disputed by EUIPO, that ESS included a complete image of that device in the observations it submitted to the Invalidity Division. Group Nivelles submitted that image to the General Court only in annex to the application initiating the proceedings, and the General Court rightly held that it was inadmissible (see paragraphs 21 to 24 of the judgment under appeal).

96. In the observations it submitted to the General Court, EUIPO then claimed that Group Nivelles had failed to demonstrate the existence of a design possessing all the features of, and disclosed earlier than, the contested design.

97. In examining that argument, the General Court found as follows in paragraphs 77 to 79 of the judgment under appeal:

'77. In any event, … where a design consists of several elements, it must be regarded as having been made available to the public, within the meaning of Article 5(1) of Regulation No 6/2002, when all the elements [have been] made available to the public and it [has been] clearly [indicated] that those elements were intended to be combined to constitute a specific product, thus enabling the shape and features of that design to be identified.

78. In other words, it cannot be accepted that a design is novel, for the purposes of Article 5 of Regulation No 6/2002, where it consists only of a combination of designs that have already been made available to the public and in respect of which it has already been stated that they were intended to be used together.

79. In the present case that means that, since, for the reasons set out …, it was clear from the Blücher catalogues that the cover plate shown in the centre of the illustration … was intended to be combined with collectors and siphons available from Blücher which also appeared in those catalogues, in order to make up a complete drainage device for liquid waste, it was necessary for [EUIPO], when assessing the novelty of the contested design, to compare it, inter alia, with a drain for liquid waste comprising the cover plate in question combined with the other elements of a drainage device for liquid waste available from Blücher, although no picture of such a combination appears in those catalogues'.

98. In support of its first ground of appeal, EUIPO submits that, in paragraph 79 of the judgment under appeal, the General Court infringed Article 63(1) of Regulation No 6/2002 and, in particular, the principles governing the burden of proof and the taking of evidence in proceedings for a declaration of invalidity of a registered design, in requiring EUIPO to reconstruct the earlier design on the basis of the various catalogue extracts annexed to the application for a declaration of invalidity.

99. In support of its second ground of appeal, EUIPO pleads that, in paragraphs 77 and 78 of the judgment under appeal, the General Court infringed the principles governing the assessment of the novelty of a Community design referred to in Article 5 of Regulation No 6/2002 in holding that EUIPO was required to combine the various components of a design which had been made available separately.

100. These grounds of appeal must be examined together in so far as they both raise the question of the legality of that requirement in the light of the substantive and procedural provisions of Regulation No 6/2002.

101. Moreover, although the first ground of appeal seeks to call into question the reasoning adopted by the General Court in paragraph 79 of the judgment under appeal and the second seeks to dispute the assessments made by the General Court in paragraphs 77 and 78 of that judgment, those paragraphs must be examined together.

102. Paragraphs 78 and 79 of the judgment under appeal must be read and interpreted in the light of the principle identified by the General Court in paragraph 77 of that judgment. That is very clear, first, from the expression 'in other words' used by the General Court at the beginning of paragraph 78 of that judgment, and, secondly, from the words 'in the present case that means that' which it uses in paragraph 79 of the judgment under appeal, since the General Court thus draws its conclusion in the present case from the principle which it has already identified.

1. Arguments of the parties

(a) The first ground of appeal

103. EUIPO disputes, in essence, the way in which the General Court treated the evidence which the applicant produced in support of its application for a declaration of invalidity and the conclusions drawn by the General Court, in paragraph 79 of the judgment under appeal, as to EUIPO's obligations in terms of the taking of the evidence produced by the invalidity applicant.

104. EUIPO claims that the General Court infringed Article 63(1) of Regulation No 6/2002 in holding, in paragraphs 74 and 79 of the judgment under appeal, that the earlier design relied on in support of the application for a declaration of invalidity was not composed only of the cover plate which formed part of the earlier design but of the whole drainage device for liquid waste.

105. The General Court thus took the place of the invalidity applicant in identifying which of the earlier designs reproduced in the Blücher catalogues were relevant for the purposes of assessing the merits of the application for a declaration of invalidity.

106. In so doing, the General Court disregarded, first, the competences conferred on EUIPO in the context of the examination of an application for a declaration of invalidity, referred to in Article 63(1) of Regulation No 6/2002 and, secondly, the requirements that the invalidity applicant must fulfil when seeking to prove the existence of an earlier design which is identical or produces a similar overall impression, referred to in Article 28(1)(b)(v) and (vi) of the implementing regulation.

107. EUIPO submits that, under that provision, and in accordance with the principles laid down by the Court of Justice in paragraph 25 of the judgment of 19 June 2014 in *Karen Millen Fashions*,[23] the invalidity applicant is required to identify precisely which earlier designs, among the documentary evidence it has submitted, are relevant for the purposes of the invalidity proceedings. Therefore it is not for the General Court to take the place of the invalidity applicant in terms of the production of evidence.

108. First, it cannot base its decision on evidence which neither party submitted or on an earlier design not explicitly relied on by the invalidity applicant, which is what has occurred in the present case.

109. Secondly, it is not for the General Court to find out which earlier design, among all those represented in the documents produced by the applicant, might be relevant, since such an approach favours one party over the other and infringes the rights of the defence.

110. Thirdly, even if a design which is identical to the contested design is reproduced in the documents submitted by the invalidity applicant, the General Court cannot base its decision on that earlier design of its own motion if the applicant has based its line of argument on other designs.

111. In the present case, neither the application for a declaration of invalidity nor the observations submitted by Group Nivelles to the Invalidity Division and the Third Board of Appeal of EUIPO demonstrate that that undertaking had clearly identified and indicated, for the purposes of Article 28(1)(b)(v) of the implementing regulation, the whole of the liquid waste drainage device as being the earlier design relied on in support of its application for a declaration of invalidity. Therefore, the Invalidity Division's comparison between the contested design and the earlier design was limited to a comparison of the cover plate in each design, with no consideration given to the other features that the Third Board of Appeal of EUIPO subsequently found to be relevant for the purposes of that comparison, such as the shape of the collector and the presence of side slots.

23 C-345/13, EU:C:2014:2013.

112. EUIPO states that it was not until the application initiating the proceedings was brought before the General Court, and therefore out of time, that Group Nivelles referred to the whole drainage device for liquid waste. Consequently, the General Court should have found that, in so doing, the applicant had changed the subject matter of the proceedings before the EUIPO's Board of Appeal within the meaning of Article 135(4) of its Rules of Procedure.

113. In its response, ESS concurs with the arguments put forward by EUIPO.

114. Group Nivelles, on the other hand, considers that EUIPO made an inaccurate assessment of the relevant facts and proposes that the Court reject that ground of appeal as unfounded.

(b) The second ground of appeal

115. EUIPO puts forward two arguments in support of its second ground of appeal.

116. First, EUIPO submits that the reasoning adopted by the General Court in paragraphs 77 and 78 of the judgment under appeal is contrary to Article 5 of Regulation No 6/2002 in so far as the General Court held that EUIPO was required to combine different components of a design which had been made available to the public separately, as was the case in respect of a cover plate and a collector published on different pages of the same catalogue.

117. EUIPO refers again to the judgment of 19 June 2014, *Karen Millen Fashions*,[24] in which the Court of Justice confirms, as regards Article 6 of Regulation No 6/2002 on the assessment of the individual character of a design, that a design must be compared with 'earlier individualised and defined designs, as opposed to an amalgam of specific features or parts of earlier designs'. Such an assessment should apply, by analogy, in the assessment of the novelty of a design, for the purposes of Article 5 of that regulation.

118. The fact that the various components of a design are intended to be used together despite having been disclosed separately does not change that finding. The appearance of the design can be deduced by combining its various components, but that appearance would be hypothetical or, at any rate, subject to significant approximations. Both the legal certainty which the design holder has the right to expect and the concept of identity between two designs, inherent in Article 5 of Regulation No 6/2002, preclude a comparative analysis based on hypotheses or approximations.

119. Secondly, EUIPO claims that the General Court's assessment is, moreover, based on a distortion of the facts.

120. The shape and features of the earlier design could not be identified from the comparison of the illustrations referred to by the General Court, namely those of the cover plate and the collector disclosed in the Blücher catalogues and submitted by Group Nivelles, and that of the drainage system represented in those catalogues and submitted by ESS.

121. ESS considers that the second ground of appeal should be declared well founded.

122. However, Group Nivelles considers that the second ground of appeal should be rejected as unfounded, in view, in particular, of the fact that EUIPO misreads and misinterprets the judgment of 19 June 2014 in *Karen Millen Fashions*,[25] and carries out an inaccurate assessment of the facts.

24 C-345/13, EU:C:2014:2013, paragraph 26.

25 C-345/13, EU:C:2014:2013. See, inter alia, judgment of 19 April 2012, *Artegodan* v *Commission* (C-221/10 P, EU:C:2012:216, paragraph 94 and the case-law cited).

2. Examination

123. For the reasons which I shall now set out, I consider that the General Court did, in fact, commit an error of law in paragraphs 77 to 79 of the judgment under appeal.

124. The General Court cannot, in my view, require the departments of EUIPO to reconstruct the earlier design, for assessment purposes, on the basis of various catalogue extracts submitted in an annex to the application for a declaration of invalidity, since such a requirement is, to my mind, contrary to the terms and scope of Article 3 of Regulation No 6/2002 and can, therefore, neither form part of the assessment of novelty of a design for the purposes of Article 5 of that regulation nor, as such, fall within the competences conferred on the departments of EUIPO by Article 63(1) of that regulation.

125. Under Article 63(1) of Regulation No 6/2002, in proceedings relating to a declaration of invalidity, the examination carried out by the departments of EUIPO is to be restricted to the facts, evidence and arguments provided by the parties and the relief sought.

126. Under that provision, earlier designs other than those specifically referred to by the applicant are not to be taken into account by EUIPO.[26] Accordingly, EUIPO considers that it is not required to determine through assumptions and deductions which of the earlier designs among those represented in an applicant's documentary evidence may be relevant where the applicant does not provide further clarifications in that regard.[27]

127. It must be borne in mind that, in the context of an application for a declaration of invalidity and in accordance with Article 52(2) of Regulation No 6/2002[28] and Article 28(1)(b) of the implementing regulation, it is, first and foremost, for the party opposing the registration to prove the existence and disclosure of an earlier design which is identical or produces a similar overall impression.

128. In invalidity proceedings, the holder of the earlier design must therefore demonstrate, first, that that design is identical or produces a similar overall impression to the contested design and, secondly, that it has been made available to the public.

129. Any form of evidence is admissible and is a matter for the discretion of the applicant.[29]

130. Under Article 28(1)(b)(v) and (vi) of the implementing regulation, an application for a declaration of invalidity, where it is based on the lack of novelty of the contested design, is to contain the indication and the reproduction of the earlier design, documentary evidence of the previous disclosure of the earlier design and an indication of the facts, evidence and arguments submitted in support of the application.

26 See the EUIPO's *Guidelines for examination of registered Community designs — Examination of design invalidity applications* of 23 March 2016, fifth paragraph of section 5.5.1.6, page 34, available on the EUIPO website at the following address: https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_2_2016/examination_of_design_invalidity_applications_en.pdf. 'The EUIPO Guidelines'.

27 Accordingly, in its decision of 4 October 2006 on an application for a declaration of invalidity of registered Community design No 000320809-0001 representing a radiator, the Invalidity Division did not take into account various radiator designs represented in a catalogue since the applicant did not specify which of the numerous designs represented was to be taken as the earlier design (paragraph 10).

28 According to that provision, the reasons for the application must be stated.

29 See, in that regard, judgment of 9 March 2012, *Coverpla* v *OHIM — Heinz-Glas (Phial)* (T-450/08, not published, EU:T:2012:117, paragraphs 21 to 25). The General Court has confirmed that approach in recent judgments: judgments of 7 November 2013, *Budziewska* v *OHIM — Puma (Bounding feline)* (T-666/11, not published, EU:T:2013:584, paragraph 24), of 15 October 2015, *Promarc Technics* v *OHIM — PIS (Part of door)* (T-251/14, not published, EU:T:2015:780, paragraph 31), and of 14 July 2016, *Thun 1794* v *EUIPO — Adekor (Decorative graphical symbols)* (T-420/15, not published, EU:T:2016:410, paragraphs 26 and 27). The EUIPO Guidelines refer to that case-law in the second paragraph of section 5.5.1.6, p. 34.

131. The form for applying for a declaration of invalidity contains a specific section for that purpose. [30]

132. Under Article 30(1) of the implementing regulation, if those requirements are not met, the application must be rejected as inadmissible; nevertheless, the departments of EUIPO may call upon the applicant to remedy the deficiencies before giving a decision on the application.

133. The implementing regulation and the EUIPO Guidelines [31] give no further indications as to the evidence to be lodged by the invalidity applicant to prove the disclosure of an earlier design which is identical or produces a similar overall impression to the contested design. [32]

134. In the present case, it has been established that the invalidity applicant did not duly identify or reproduce the earlier design in its entirety, either in the application for a declaration of invalidity or in the course of the proceedings before the departments of EUIPO. The applicant reproduced only the part of the design which it considered to be visible during normal use, namely the cover plate.

135. In such circumstances, can the General Court require EUIPO to remedy that deficiency by reconstructing, for assessment purposes, the earlier design based on the various extracts from the Blücher catalogues annexed to the application for a declaration of invalidity, 'although no picture of such a combination [appeared] in [the documents submitted]'? [33]

136. I would say that it cannot.

137. First, such a requirement is contrary to the terms and scope of Article 3 of Regulation No 6/2002 read in conjunction with Article 28(1)(b)(v) of the implementing regulation.

138. As set out in Article 3(1) of Regulation No 6/2002, 'design' means '*the appearance* of the whole or a part of a product resulting from the features of, in particular, the *lines*, *contours*, *colours*, *shape*, *texture* and/or *materials* of the product itself and/or its *ornamentation*'. [34]

139. That provision therefore reflects the principle that a design right is a right of ownership of '*the appearance*' of a product, which must be distinguished from a patent right, which is a right of ownership of an invention.

140. It should be borne in mind that designs have an aesthetic function and that their purpose is to ornament the object to which they apply, to give it a distinct and recognisable appearance which, owing to its lines, contours, shapes or its particular graphic design, is unique to it. [35]

141. The specific characteristics referred to in Article 3 of Regulation No 6/2002 are therefore features which are visible to the eye. [36]

30 See the form entitled 'Application for a declaration of invalidity of a registered Community design', available on the EUIPO website at the following address: https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/forms_filings/all_downloadable_forms/invalidity_rcd_en.pdf and the explanatory notes on that form, in particular sections 2.6 and 3, p. 4 and 5.

31 See the first and second paragraphs of section 3.9.2 of the EUIPO Guidelines, p. 12.

32 The General Court drew the same conclusion in the context of trade mark law in the judgment of 20 April 2005, *Atomic Austria* v *OHIM — Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)* (T-318/03, EU:T:2005:136, paragraph 39), as regards the interpretation of Article 76(1) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) and Rule 16(2) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1) the normative content of which is, in essence, the same as that of Article 63(1) of Regulation No 6/2002 and Article 28(1)(b) of the implementing regulation.

33 Paragraph 79 of the judgment under appeal.

34 Emphasis added.

35 See Greffe, F., and Greffe, P., *Traité des dessins et modèles*, 9th edition, LexisNexis, Paris, 2014, paragraphs 87 and 88, p. 40.

36 See Raynard, J., Py, E., and Tréfigny, P., *Droit de la propriété industrielle*, 5th edition, LexisNexis, Paris, 2016, paragraph 525, p. 304.

142. By requiring, under Article 28(1)(b)(v) of the implementing regulation, 'the indication and the reproduction of the prior designs', the legislature requires the invalidity applicant to reproduce a specific, individualised, defined and identified design (to adopt the expression used in paragraph 25 of the judgment of 19 June 2014 in *Karen Millen Fashions*).[37] In that judgment, as regards the interpretation of Article 6 of Regulation No 6/2002, the Court of Justice held that a comparison which entails the assessment of the individual character of a design must be based on 'earlier individualised and defined designs, as opposed to an amalgam of specific features or parts of earlier designs'.[38]

143. Those requirements are essential for the purposes of assessing the merits of an application for a declaration of invalidity.

144. From the reproduction of the earlier design, it must be possible to determine the scope of the earlier right claimed and, similarly, the scope of the rights which the holder of the contested design can legitimately claim.

145. Unlike in patent claims, the scope of those rights is determined by reference to the design reproduced in the application for a declaration of invalidity and not by any accompanying description or text, which is optional and devoid of any legal value. The protection afforded to a design concerns the design as reproduced, and the accompanying text merely provides additional information.[39] The reproduction of the earlier design must therefore suffice in itself.

146. Moreover, the respondent should be able to identify from that reproduction which ornamental or aesthetic elements of the earlier design have been imitated and, consequently, to challenge the substance of the case on the basis that the contested design is original.

147. Finally, that reproduction must enable the departments of EUIPO to identify the earlier design precisely and with certainty so that they may, in accordance with Articles 5 to 7 of Regulation No 6/2002, assess the novelty and individual character of the contested design and carry out a comparison of the designs at issue as part of that assessment. It is clearly necessary for the earlier design to be specific and defined in order for it to be possible to examine whether the contested design does in fact lack novelty or individual character.

148. To meet those objectives, it is therefore essential to have available an image of the earlier design, since it is that image which reflects the very nature of the object protected by Regulation No 6/2002 and the reason for which that protection is given to it.

149. That image must show the appearance of the product in which the design is incorporated as a definitive whole which is recognisable by its lines, contours, colours, shape, texture or even its ornamentation or its materials, as provided for in Article 3 of that regulation.

150. Design law does not therefore protect an idea or a design that is close to what has been created or is the result of a reconstruction, because, in such circumstances, no one manages to perceive the appearance of the product in the definitive and recognisable form which is unique to it. That, moreover, is the reason why, under Article 4 of the aforementioned regulation, only the visible features of designs may be protected.

37 C-345/13, EU:C:2014:2013. In that paragraph, the Court held that 'the assessment as to whether a design has individual character [within the meaning of Article 6 of Regulation No 6/2002] must be conducted in relation to one or more specific, individualised, defined and identified designs from among all the designs which have been made available to the public previously'.

38 Judgment of 19 June 2014, *Karen Millen Fashions* (C-345/13, EU:C:2014:2013, paragraph 26).

39 See Passa, J., *Droit de la propriété industrielle, Volume 1: Marques et autres signes distinctifs, dessins et modèles*, Librairie Générale de Droit et de Jurisprudence, Paris, 2006, paragraph 752, p. 710.

151. This precludes, therefore, any attempt at reconstructing the earlier design, especially when no image of such a combination was included in the evidence produced.

152. Such a reconstruction would be flawed since it would necessarily be subject to approximations, contrary not only to Article 3 of Regulation No 6/2002, but also to the requirements for assessing the novelty of the design for the purposes of Article 5 of that regulation.

153. In the present cases, for example, it is clear from paragraphs 64 and 65 of the judgment under appeal, which are not disputed by the parties, that the illustrations produced by the applicant in annex to its application for a declaration of invalidity represented different types of cover plate, of various shapes and sizes, which could be combined with collectors and siphons to make up a complete drainage device for liquid waste.

154. How is it possible to carry out the comparison of the designs, which is a necessary part of the examination of the merits of the application for invalidity, if the appearance of the product and, in particular, its lines, contours, colours and shape, are not clearly recognisable and identifiable?

155. If EUIPO were to reconstruct the design, as required by the General Court, the resulting designs could, in my view, present differences which are not necessarily insignificant.

156. Such a reconstruction does not, therefore, guarantee a proper examination of the merits of the application for invalidity in so far as it does not reflect the appearance of the product for the purposes of Article 3 of Regulation No 6/2002 and thus does not enable EUIPO duly to compare the designs at issue as required under Article 5 of that regulation.

157. If the General Court held, in the judgment of 9 March 2012 in *Coverpla* v *OHIM — Heinz-Glas (Phial)*,[40] that the disclosure of an earlier design cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence that the earlier design has in fact been disclosed to the market,[41] that principle must apply *a fortiori* to the reproduction of that design.

158. In that regard, the EUIPO Guidelines state that, where the representation submitted in annex to the application for a declaration of invalidity fails adequately to represent the earlier design, thereby rendering any comparison with the contested design impossible, this does not amount to disclosure for the purposes of Article 7(1) of Regulation No 6/2002.[42]

159. The principle identified by the General Court in paragraph 79 of the judgment under appeal is actually based more on patent law than on design law,[43] as the General Court's approach seeks to grant exclusive rights to a type of liquid waste drainage system whose appearance may vary.

40 T-450/08, not published, EU:T:2012:117, see, in particular, paragraphs 21 to 25.

41 See paragraph 24 of that judgment and the third paragraph of section 5.5.1.6, p. 34, of the EUIPO Guidelines. See, by analogy, judgment of 7 June 2005, *Lidl Stiftung* v *OHIM — REWE-Zentral (Salvita)* (T-303/03, EU:T:2005:200, paragraph 38 and the case-law cited).

42 See the sixth paragraph of section 5.5.1.6 of the EUIPO Guidelines, p. 34. On that subject, it is useful to refer to the decision of the Third Board of Appeal of EUIPO of 10 March 2008 in Case R 586/2007-3, 'Barbecues', and in particular to the following paragraphs:

'23. The second objection concerns the quality of the picture of a Cinders barbecue as represented (identically) in the two magazines and in the promotional Cinders Barbecues brochures ...

24. That picture represents a barbecue whose cooking deck is entirely covered with meat, yet the Invalidity Division was capable of perceiving "four separate grills fields". The picture has become blurry as a result of excessive zooming *so that the exact configuration of the barbecue is not easily seen*, yet the Invalidity Division noticed "characteristically shaped end plates" (without elaborating further). *The Board is not convinced that the picture — being the only pertinent piece of evidence of divulgation — supports these findings, let alone permits a reliable comparison with the contested design for the purpose of assessing the overall impression they produce on the informed user.*

...26. *It follows that this picture, which fails to adequately represent the earlier design, thereby rendering any comparison with the contested design impossible, does not amount to divulgation for the purpose of Article 7(1) CDR*' (emphasis added).

43 The description provided in patent applications contains, inter alia, a disclosure of the invention as claimed, a description of any drawings, a detailed description of at least one way of carrying out the invention, using examples, and an indication of the way in which the invention is capable of being applied in industry.

160. This is contrary to the terms and scope of Article 3 of Regulation No 6/2002.

161. Consequently, the obligation imposed by the General Court in paragraph 79 of the judgment under appeal, which is based on the considerations it set out in paragraphs 77 and 78 of that judgment, cannot form part of the assessment that the departments of EUIPO must carry out under Articles 5 and 63(1) of that regulation.

162. However, that does not mean that the departments of EUIPO must be passive in situations such as that at issue, where the invalidity applicant has reproduced only the part of the design which it considers to be visible during normal use.

163. Article 65(1) of Regulation No 6/2002 on the taking of evidence '*in any proceedings before [EUIPO]*'[44] sets out a non-exhaustive list of means of giving or obtaining evidence.[45]

164. Despite the restrictions referred to in Article 63(1) of that regulation, in invalidity proceedings, the departments of EUIPO can therefore examine the case and, accordingly, hear the parties or witnesses, request information or the production of documents and items of evidence, or even request opinions by experts.

165. In the present cases, it is clear from paragraph 68 of the judgment under appeal, which is not disputed by the parties, that a reproduction of a design representing the whole of the liquid waste drainage device available from Blücher was included in an annex to the observations which ESS submitted to the Invalidity Division. The purpose of that document was to demonstrate the industrial use of that liquid waste drainage device.

166. The departments of EUIPO did, therefore, have a reproduction of the whole of the liquid waste drainage device offered by that company.

167. The Third Board of Appeal, in the course of its examination of the case, and taking into account the fact that it:

– had reached the conclusion that the Invalidity Division had been wrong to compare only the cover plate in the contested design with only the cover plate reproduced by the applicant, and

– had therefore declared for the purposes of that comparison that the contested design is composed of a cover plate but also of the elongated slots on either side of the cover plate and the outer edges of the shower drain,

could, as rightly pointed out by the General Court in paragraph 79 of the judgment under appeal, easily perceive, based on the extracts of the Blücher catalogues produced by Group Nivelles, that the cover plate reproduced by Group Nivelles, like the cover plate in the contested design, was intended to be combined with collectors and siphons.

168. Therefore, the Third Board of Appeal of EUIPO could either:

– require Group Nivelles to provide additional reproductions of the earlier design as incorporated in a complete drainage device for liquid waste. Indeed, Group Nivelles had informed the Third Board of Appeal of EUIPO that it could provide samples of the products represented in documents other

44 Emphasis added.

45 The same as the list which, in trade mark law, is set out in Article 76(1) of Regulation No 40/94.

than those already produced if the Board were to hold a hearing. In that regard, the Board decided that a hearing was not required, as it already had in its possession all the elements necessary to give a decision;[46]

– or refer to the reproduction of the design representing the whole of the liquid waste drainage device available from Blücher, submitted by ESS, if necessary by reopening the proceedings in order to guarantee respect for the rights of the defence of the parties to the invalidity proceedings and the right to a fair procedure.

169. I do not think that those actions went beyond the powers conferred on it by Article 63(1) of Regulation No 6/2002.

170. On the contrary, in the proceedings at issue, the Third Board of Appeal of EUIPO did not hesitate to exercise the decision-making powers conferred on it by Article 63(2) of that regulation, in examining all the additional facts, evidence and arguments provided by both parties, even those not submitted in due time, in order to complete any facts, evidence or arguments already submitted by those parties in the invalidity proceedings.[47]

171. Moreover, those means of taking evidence are perfectly consistent with those referred to in Article 65(1) of that regulation.

172. In that regard, it should be noted that the rules on the competence of EUIPO are interpreted very dynamically in the case-law. I am referring, in particular, to the General Court's interpretation of Articles 74 and 76 of Regulation No 40/94. The wording of those two provisions, which govern the competence of EUIPO in the context of opposition proceedings against an EU trade mark, is identical to the wording of the provisions governing the competence of EUIPO in the context of an application for a declaration of invalidity of a Community design.

173. Accordingly, in judgment of 20 April 2005 in *Atomic Austria* v *OHIM — Fabricas Agrupadas de Muñecas de Onil (ATOMIC BLITZ)*[48] relating to opposition proceedings against the registration of a Community trade mark, the General Court held that EUIPO cannot avoid conducting a comprehensive assessment of the facts and documents presented to it by arguing that it is for the opponent, on his own initiative, to provide EUIPO with the detailed information and supporting evidence on which his opposition is based.[49] The restriction of the factual basis of the examination by EUIPO and the principle that the parties take the initiative in pursuing, and delimiting the subject matter of, an action did not, therefore, preclude EUIPO from taking into consideration, in addition to the facts expressly put forward by Group Nivelles, all the information provided by the parties.

174. In view of the above, although it is regrettable that the Third Board of Appeal of EUIPO did not adopt the means for taking evidence necessary in order to obtain a reproduction of the whole liquid waste drainage device available from Blücher, the fact remains that, contrary to the General Court's finding in paragraph 79 of the judgment under appeal, it was not for EUIPO to remedy that deficiency by reconstructing, for assessment purposes, the earlier design on the basis of the various Blücher catalogue extracts annexed to the application for a declaration of invalidity.

46 Paragraphs 18 to 24 of the decision at issue.

47 See paragraphs 20 to 24 of the decision at issue.

48 T-318/03, EU:T:2005:136.

49 See paragraph 38 of that judgment.

175. In the light of the foregoing considerations, I take the view that the General Court erred in law in paragraphs 77 to 79 of the judgment under appeal in requiring EUIPO to reconstruct, for assessment purposes, the earlier design on the basis of the various Blücher catalogue extracts annexed to the application for a declaration of invalidity, and in playing down, in that assessment, the importance of having available an image of the earlier design claimed.

176. Taking into account that conclusion, it is not necessary, in my view, to examine the argument alleging a distortion of the facts which was put forward by EUIPO in support of its second ground of appeal.

177. However, even if the General Court's reasoning is vitiated by a breach of EU law, I do not think that that finding could lead to the judgment under appeal being set aside.

178. The General Court's conclusion as to the legality of the decision at issue is validly based on other, principal, grounds, separately set out in paragraphs 60 to 70 of the judgment under appeal. [50]

179. It is those grounds, which are indeed not disputed by the parties, that form the basis of the operative part of the judgment under appeal.

180. Accordingly, the General Court rightly found, in paragraphs 60 and 61 of that judgment, that the Third Board of Appeal of EUIPO had in fact erred in its assessment of the novelty of the contested design in comparing all its visible features with a single feature of the earlier design, so that, in the decision at issue, it did not draw the appropriate conclusions from the error which it found had been committed by the Invalidity Division.

181. In that regard, it is entirely accurate, as the General Court held in paragraph 62 of that judgment, that 'assessment of the novelty of the contested design required a comparison between the latter's visible features after installation and the visible features after installation of the earlier design, of which the abovementioned cover plate was one'.

182. The General Court was also right to find, in paragraph 62 of that judgment that 'examination of the evidence produced by the parties before [EUIPO] *could only lead to the conclusion* that the cover plate shown in the centre of the illustration [attached in annex to the application for a declaration of invalidity] was only part of a drainage device for liquid waste'. [51] The General Court's analysis, in paragraphs 63 to 69 of that judgment, of the evidence submitted by the parties to the departments of EUIPO is convincing and I fully concur with the General Court's point of view that, in the light of that evidence, EUIPO had no alternative but to find that the invalidity applicant had reproduced in its application for a declaration of invalidity only one part of the liquid waste drainage device under consideration.

183. Those grounds of the judgment are sufficient in themselves to support the General Court's conclusion that the Third Board of Appeal of EUIPO did in fact commit an error in its assessment of the novelty of the contested design, justifying the annulment of the decision at issue.

184. As is very clear from paragraphs 71 and 86 of that judgment, those grounds of the judgment have no bearing on the considerations which the General Court set out in paragraphs 72 to 85 of the judgment under appeal in response to the arguments put forward by the EUIPO and ESS or, in particular, on the reasoning which it followed in paragraphs 77 to 79 of that judgment. [52]

50 See, by analogy, judgment of 10 July 2014, *Nikolaou* v *Court of Auditors* (C-220/13 P, EU:C:2014:2057, paragraph 38).

51 Emphasis added.

52 In that connection, see point 45 of this Opinion.

185. In those circumstances, even if the examination of the two grounds of appeal raised by EUIPO has disclosed an error of law on the part of the General Court, that finding should not, in my opinion, lead to that judgment being set aside.

B – The third ground of appeal, alleging that the General Court infringed Articles 6 and 7 of Regulation No 6/2002 read in conjunction with Article 25(1)(b) of that regulation

186. As I have stated in point 88 of this Opinion, inasmuch as the third ground of appeal is directed at grounds which I propose should be set aside because the General Court went beyond the limits of its power of review, it is not necessary to examine this ground of appeal.

187. In the light of all the above considerations, I note that it is settled case-law that, if the grounds of a judgment of the General Court disclose an infringement of EU law but its operative part is shown to be well founded on other legal grounds, the appeal must be dismissed. [53]

188. Consequently, I propose that the Court dismiss the appeal brought by EUIPO and order it to pay the costs under Article 138(1) of the Rules of Procedure of the Court of Justice.

IX – The appeal brought by ESS in Case C-361/15 P

189. ESS raises two grounds in support of its appeal.

190. By the first ground of appeal, ESS criticises the General Court's assessment of whether the intended use of the product in which the earlier design is incorporated is relevant for the purposes of assessing the novelty and individual character of the contested design. That first ground of appeal is divided into three parts, in which ESS disputes the considerations set out by the General Court in paragraphs 115 to 123 and paragraph 133 of the judgment under appeal in the light of Articles 5, 6 and 7(1) and Articles 10, 19 and 36(6) of Regulation No 6/2002.

191. By the second ground of appeal, which relates to the infringement of Article 61 of that regulation, ESS claims that the General Court exceeded the limits of its power of review in paragraph 137 of the judgment under appeal.

A – The first ground of appeal, alleging that the General Court infringed Articles 5 to 7(1) and Articles 10, 19 and 36(6) of Regulation No 6/2002

192. The first ground of appeal seeks to challenge an assessment made by the General Court which, in my view, exceeded the limits of its power of review.

193. For the reasons I have set out in points 64 à 82 of the present Opinion, there is thus no need to examine this ground of appeal.

53 See, inter alia, judgment of 19 April 2012, *Artegodan* v *Commission* (C-221/10 P, EU:C:2012:216, paragraph 94 and the case-law cited).

B – The second ground of appeal, alleging that the General Court exceeded the limits of its power of review

1. Arguments of the parties

194. By its second ground of appeal, ESS claims that the General Court exceeded the limits of its power of review under Article 61 of Regulation No 6/2002 in stating in the final sentence of paragraph 137 of the judgment under appeal that 'contrary to what the intervener seems to presume, [the fact that the cover plates are suitable for industrial use] does not mean that they cannot be used also in other places, inter alia in a shower, where they would normally bear less significant loads'.

195. According to ESS, the Third Board of Appeal of EUIPO did not give a decision on the load classes (or their significance) referred to in the Blücher catalogues, or on the relevance of the load classes for the purposes of assessing the novelty or individual character of the contested design. ESS adds that the final sentence of paragraph 137 of the judgment under appeal was nugatory for the purposes of arriving at its conclusion.

196. Group Nivelles and EUIPO consider that the second ground of appeal should be declared to be unfounded, because the General Court did not substitute its own assessment for that of the Third Board of Appeal of EUIPO.

2. Examination

197. I propose that the Court reject at the outset this ground of appeal as ineffective.

198. As a preliminary point, it should be noted that in paragraph 138 of the judgment under appeal, the General Court concluded that the Third Board of Appeal of EUIPO was wrong to describe the cover plate shown in the centre of the illustration annexed to the application for a declaration of invalidity as a 'shower drain', in so far as there was 'nothing in the file' to indicate that that plate was intended, exclusively or mainly, for use as a component of a shower drain.

199. As is clear from the wording of paragraph 138 of the judgment under appeal, that conclusion is based on an assessment of the evidence submitted to the departments of EUIPO which is set out in paragraphs 135 to 137 of the judgment under appeal. The final sentence of paragraph 137 of that judgment is, nevertheless, has a different aspect, as is shown by the use of the adverb 'however', inasmuch as the General Court does not examine the contents of the Blücher catalogues at all, but makes a superfluous assessment.

200. That assessment does not in any way support the conclusion which the General Court draws in paragraph 138 of the judgment under appeal; that is indeed made expressly clear from its use there of the words 'the fact remains that...', and which, furthermore, ESS expressly acknowledges when it states that that assessment was 'irrelevant'. [54]

201. The second ground of appeal, alleging that the General Court exceeded the limits of its power of judicial review must therefore be rejected.

202. In the light of all the foregoing considerations, I propose, therefore, that the Court dismiss the appeal brought by ESS and order the latter to pay the costs, under Article 138(1) of the Rules of Procedure of the Court of Justice.

54 See paragraph 57 of the appeal.

X – Conclusion

203. In the light of the foregoing considerations, I propose that the Court:

(1) Set aside in part the judgment of the General Court of the European Union of 13 May 2015 in *Group Nivelles* v *OHIM — Easy Sanitary Solutions (Shower drainage channel)* (T-15/13, EU:T:2015:281) in so far as, in paragraphs 112 to 133 of that judgment, the General Court assessed whether the identification of the product in which the earlier design, relied on in support of the application for a declaration of invalidity, is incorporated is relevant for the purposes of assessing the novelty or individual character of the contested design, thus going beyond the limits of its power to review the legality of decisions of the Boards of Appeal of the European Union Intellectual Property Office (EUIPO), provided for in Article 61(2) of Regulation No 6/2002;

(2) Dismiss the appeals;

(3) Order Easy Sanitary Solutions BV to pay the costs in Case C-361/15 P;

(4) Order EUIPO to pay the costs in Case C-405/15 P, with the United Kingdom, as intervener in that case, bearing its own costs.