

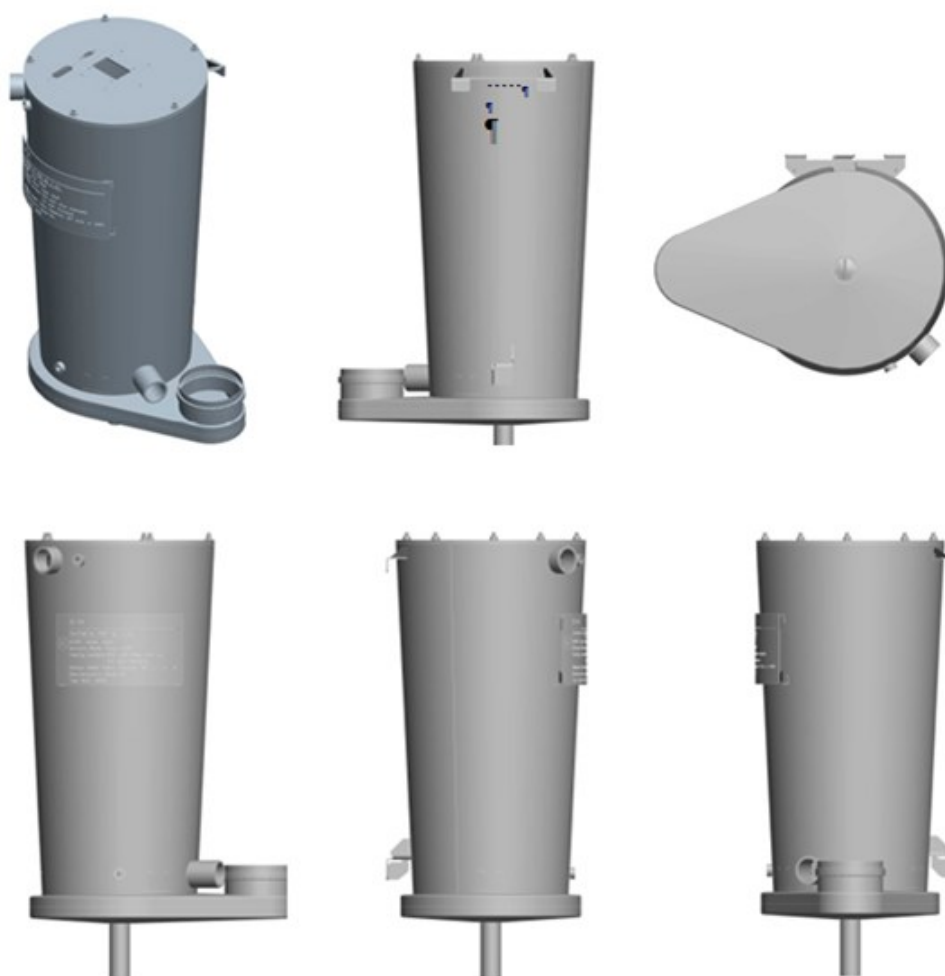
**General Court confirms that RCDs for heat exchangers are invisible parts of complex product**  
European Union - NJORD

**Design  
Cancellation  
International procedures**

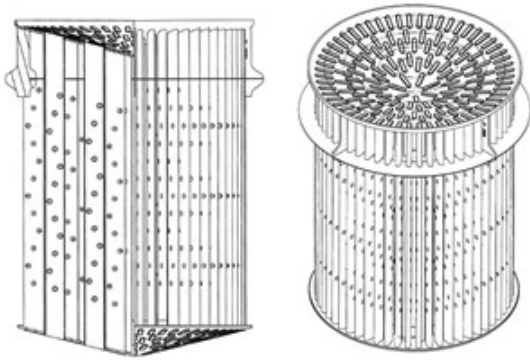
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In *Aic SA v Office for Harmonisation in the Internal Market (OHIM)* (Cases [T-615/13](#), [T-616/13](#) and [T-617/13](#)), the General Court has upheld decisions of the Third Board of Appeal of OHIM in which the latter had invalidated three registered Community designs (RCDs) on the basis that they were non-visible components of complex products registered in contravention of Article 4(2) of the [Community Designs Regulation](#) (6/2002).

In 2009 *Aic SA*, the RCD holder, registered three Community designs for a “heat exchanger”:



It also registered two very similar “heat exchanger inserts”, one of which is shown below:



In 2011 [ACV Manufacturing](#) filed three applications for a declaration of invalidity of the designs on the basis of Article 25(1)(b) of the regulation, read in conjunction with Articles 4(1), 4(2), 5, 6, 8(1) and 8(2). ACV claimed that the designs in question should not be protected because they were not visible and lacked novelty and individual character, and because their technical function and incorporation in another product excluded such protection. In particular, ACV argued that the heat exchanger inserts, and the heat exchangers themselves, were not visible during the normal use by the end user of the products in which they were inserted (ie, boilers), and that they had no use as separate component parts.

The Cancellation Division of OHIM upheld all three applications for a declaration of invalidity under Article 4 (2), finding as follows:

- Even though there was a theoretical possibility that the heat exchanger and the inserts could be used outside of a boiler, the only pieces of evidence provided by the RCD holder were catalogues with boilers containing the heat exchangers. Thus, it could only be concluded that they were component parts of a complex product, namely a boiler.
- The 'end user' was defined as a person using the boiler into which the heat exchanger was incorporated.
- Considering the documents provided, the objects registered under the RCD were not visible during normal use by the end user, who would have to dismantle the boiler in order to see the heat exchangers and their inserts.
- Hence, the RCDs were a non-visible part of a complex product, and were not protected.

The RCD holder appealed the three decisions, but the Third Board of Appeal of OHIM dismissed the appeals in their entirety. The board held as follows:

- As regards the definition of 'normal use by the end user', the 'end user' was a person buying a boiler for domestic use, thus excluding professionals in building or maintenance companies. The normal use of the heat exchangers and their inserts coincided with that of the end product which includes them, namely a household boiler.
- As regards the definition of 'heat exchanger' and 'heat exchanger inserts' and the visibility requirement, having defined those devices *in abstracto*, the Board of Appeal found that, *in concreto* and according to the documents submitted by the parties, they both formed part of a boiler which, for reasons of safety and insulation, was constructed as a closed system and thus would not leave the devices accessible and visible to the end user. It further stated that the fact that those devices can be sold separately from a boiler was irrelevant for the purposes of Article 4(2).
- The Cancellation Division had rightly held that the contested RCDs were invalid under Article 25(1)(b), in conjunction with Article 4(2), and that there was no need to examine further grounds of invalidity even if they had been invoked by the RCD holder.

The RCD holder lodged a further appeal to the General Court, claiming that the Board of Appeal had allegedly found that the appearance of a heat exchanger could not be separated from its performance, and also that the board relied solely on evidence submitted by the applicant for cancellation and on presumptions in order to hold that a heat exchanger was necessarily incorporated into a boiler. In the case

of the heat exchanger inserts, the RCD holder also submitted that the board had not taken into account that the bottom of the heat exchanger had a characteristic conical shape which, as a result, required the pipe bundles in the heat exchanger insert to have a specific shape.

For the second time, the appeal was rejected. The General Court held as follows:

- The argument that the heat exchange inserts had a specific shape was ineffective, as it fell within the scope of Article 8 of the regulation (concerning technical functions) and could not be used to assess the visibility of the inserts.
- Under Article 63(1) of the regulation, and in accordance with settled Community trademark case law applied *mutatis mutandis* to Community designs, a Board of Appeal, when hearing an appeal against a decision of OHIM on a declaration of invalidity, may base its decision only on the facts and evidence submitted by the parties. Thus, it was for the parties before the Board of Appeal to adduce evidence to support their claims. The evidence adduced by the RCD holder consisted of models of heat exchangers other than the contested designs, whereas the applicant's evidence submitted to OHIM made it possible to understand how the heat exchanger and the inserts covered by the contested designs were used. In conclusion, the Board of Appeal could not be criticised for relying on the applicant's evidence in order to conclude that the contested designs concerned parts intended to be incorporated in a complex product, namely a household boiler.
- Following the same reasoning, the court also found that the applicant had not provided specific evidence to prove its claim that the lower part of the heat exchanger insert of the contested design would remain visible during its normal use and to contradict OHIM's findings.
- Further, while OHIM must take into account decisions already taken in respect to similar applications, the examination of a particular design application depends on specific criteria, which are applicable to the factual circumstances of a particular case and which purpose is to ascertain whether the design at issue is caught by a ground of refusal or invalidity. In the present case, none of the decisions submitted as evidence by the RCD holder were binding on OHIM in this particular case, as they did not fulfil these specific criteria.

Accordingly, the General Court upheld the Board of Appeal's decisions and dismissed the actions in their entirety.

Article 4(2) of the regulation is designed to avoid the grant of exclusive rights in "must match" parts, typically spare parts of automobiles, which are not visible to the end user. A lenient General Court could have made a compromise here and found on the one hand that the heat exchangers themselves were visible in other contexts besides boilers, but on the other hand, that the heat exchanger inserts (which were *inserted*) were not visible. However, all instances were sceptical of the RCD holder's claims that the heat exchanger in question could be used in conjunction with goods other than enclosed boilers, and all instances found such use to be not visible. The burden of proof must be considered high in this regard.

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