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General Court considers several issues concerning disclosure of earlier designs

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- Disclosure cannot be based on probabilities and presumptions, but must be demonstrated by objective and concrete facts
- Apparition on the Internet can be considered as a publication and used to prove disclosure to the public
- Information obtained via the Wayback Machine is relevant to prove disclosure

On 20 October 2021 the General Court issued its decision in [General court JMS Sports sp z oo v European Union Intellectual Property Office](#) (EUIPO) (Case T-823/19), which concerned, among other things, the issue of the disclosure of an earlier design.

Background

The claimant, JMS Sports, had owned a registered Community design representing a spiral hair tie since 24 June 2010:



On January 2017 Inter-Vion SA requested the cancellation of that design on the basis of two previous designs:

- Fancy Fane, which was disclosed on 29 November 2009:





- SwirliDo, which was disclosed on 1 November 2009 on the website 'nouveaucheap.blogspot.com', as well as in a screen capture of the website 'facialwork.com' on 10 July 2009, obtained via the Wayback Machine:





The contested design was cancelled on the ground that it lacked novelty based on the earlier SwirliDo design, which was confirmed by the Board of Appeal of the EUIPO on 13 September 2019. This decision was appealed to the General Court on three different grounds.

General Court decision

First ground of appeal

The first ground alleged infringement of Articles 5(1) and 7(1) of [Regulation 6/2002](#).

The court stated that a design is considered as disclosed once the party claiming disclosure has proven that such disclosure has taken place. This cannot be based on probabilities and presumptions, but must be demonstrated by objective and concrete facts which will be examined in relation to each other. In addition, to assess the veracity and reliability of a document, one must take into consideration its origin, how it was created and by whom. The applicable regulations do not contain additional conditions concerning the filing of evidence. Consequently, the applicant for cancellation is free to choose the evidence of disclosure that it will present to the EUIPO.

The court considered that the Board of Appeal had decided that the earlier SwirliDo design had been disclosed based mainly on screenshots of websites and documents obtained via the Wayback Machine that mentioned the SwirliDo design.

The board had also taken into account a second category of documents, used to prove the authenticity of the screenshots of the site 'nouveaucheap.blogspot' concerning the SwirliDo design:

- articles published on 'nouveaucheap.blogspot';
- a Google search confirming the date of publication on 1 November 2009 of the article "SWIRLIDO OR SWIRLIDON'T?"; and
- a screenshot obtained via the Wayback Machine confirming that 'nouveaucheap.blogspot' was active in 2009.

One of the issues was whether the apparition of a design on the Internet constitutes a 'publication' within the meaning of Article 7 of Regulation 6/2002. The court stated that Article 7 contains only a list of examples of potential disclosures and that a disclosure can take place anywhere. Therefore, an apparition on the Internet can be considered as a publication and used to prove disclosure to the public.

The court then found that the screen captures clearly showed the Fancy Fane et SwirliDo designs (which are identical to the contested design) and included the URL address of the two websites, as well as dates of disclosure to the public which were earlier than the filing date of the contested design. Some additional information, including dated comments by internet users, confirmed those prior dates. It was not disputed that these websites were distinct blogs specialised in beauty accessories.

The disclosure dates were also corroborated by:

- the screenshot of the website 'www.facialwork.com' dated 10 July 2009, obtained via the Wayback Machine, which referred to the SwirliDo hair tie;
- a Google search associating SwirliDo to the year 2009; and
- a search made via the Wayback Machine proving that the site 'nouveaucheap.blogspot' was active in 2009.

All those elements demonstrated that the Fancy Fane et SwirliDo designs, which are identical to the contested design, were disclosed to the public in November 2009 at the latest. The arguments of the claimant, based on EUIPO documents and on the possibility to modify a website or create a fake one, failed to prove the contrary. The court stated that such potential modification was presented as a mere possibility, but was not based on actual evidence of manipulation of the website. In addition, the evidence submitted to demonstrate this argument was judged inadmissible since it was presented for the first time before the court.

The claimant then contested the reliability of the information found on the Wayback Machine. The court stated that the results were not taken into consideration on their own, but in relation to other information which proved that, even if the picture of the product was not visible, the screenshot referred to the SwirliDo product. Therefore, such information was relevant to prove disclosure. The argument based on the lack of credibility of the blog 'faneaccessories.blogspot' was also rejected, since it was based on presumptions and not facts.

Finally, the court mentioned that it was not claimed that the disclosure could not have become known by the specialised circles in the concerned sector in the normal course of business. This is unusual since the court answered an argument which had not been raised. However, the importance of this case lies in the way in which evidence can be supplied and weighed by the court, and in the necessity to rely on facts rather than presumptions.

The first ground was therefore rejected.

Second ground of appeal

The second ground concerned the issue of the burden of proof.

The court stressed that the applicant for cancellation has the burden of proving prior disclosure based on objective facts. The authenticity of screenshots can be called into question if facts concretely suggesting manipulation can be invoked. Here, the claimant did not even indicate circumstances which may have led to believe that a manipulation had occurred. If the claimant's argument were to be upheld, it would then be sufficient to argue, based on general and abstract affirmations, that a website may have been manipulated. This ground of appeal was thus rejected too.

Third ground of appeal

Finally, the claimant alleged infringement of the principle of equality of arms, which is a corollary of the due process principle and is applicable by analogy to *inter partes* proceedings before the EUIPO.

The court considered that this claim was a repetition of the second ground and that nothing new had been added. This ground was thus also rejected and the board's decision was confirmed.

Richard Milchior

Herald

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