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Social media posts as evidence of disclosure to public

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In a decision by the Third Board of Appeal (BoA) of the EU Intellectual Property Office (EUIPO), the BoA recognised that third-party social media posts can constitute a disclosure to the public, with the implication of the destruction of the novelty of the design or, as in this case, the individual character. This practice gives an opportunity to conveniently find and use content of social media accounts to prove early disclosure of a design in an invalidity action against a registered community design (RCD).

Facts

An RCD for a type of shoes was contested through an application of invalidity. The invalidity application was based on lack of novelty and individual character. Supporting its claims, the applicant presented three social media posts displaying the shoes that dated back approximately one-and-a-half years before the RCD's filing date. The applicant also referred to several news articles that reported on the social media posts. The invalidation applicant claimed that these articles, in conjunction or as separate pieces of evidence, were valid proof to invalidate the RCD, since they proved that the RCD had been disclosed prior to the grace period of 12 months.

The Invalidity Division of the EUIPO declared the contested RCD to be invalid. The design owner appealed the decision, requesting that the decision to invalidate the RCD be set aside.

Decision

The main question for the BoA to decide upon was whether:

- the design had been disclosed:
  - prior to the 12-month grace period;
  - to the circles specialised in the sector concerned; and
  - within the Community; and
- the disclosure thus resulted in the RCD's invalidity.

First, the BoA concluded that a social media post can constitute a "publication" in accordance with the law. The design owner did not dispute this. Given that the posts had numerous comments and over 300,000 likes, the BoA also confirmed that they had been made available to the public. Due to their popularity, the posts had been covered in several news articles presented to the BoA by the invalidity applicant. The articles displayed a clear and unobscured photo of the shoe, making the appearance of the design discernible. The BoA confirmed that the news articles constituted disclosures in themselves. After reviewing all the evidence, the BoA concluded that the invalidity applicant had provided solid and objective evidence that the design had been sufficiently disclosed to the public prior to the 12-month grace period.

To dispute the outcome of sufficient disclosure, the owner argued that the materials could have been manipulated. The BoA rejected that line of defence, holding that while there was an abstract possibility that the materials could have been manipulated, a mere statement in this regard was not sufficient to undermine the credibility of the evidence. The design owner had provided no reason as to why the dates would have been edited or how the social media comments and likes could theoretically have been manipulated.

Additionally, the design owner argued that the disclosure was not known in the circle of specialists in the sector. The BoA found that the specialists could search the internet, and nothing indicated that the articles were hard to find. Consequently, the BoA found that the design owner had not proven this line of defence either.

After a comparison between the two shoes, the BoA found them similar enough for the prior design to destroy the individual character of the RCD. Hence, it dismissed the appeal in its entirety.

Comment

This case provides several interesting topics for future consideration:

- The BoA's reasoning regarding the social media posts is indicative of the conditions of such materials to be considered publicly available within the meaning of the Community Design Regulation (EC) No. 6/2002.
- The BoA, by its requirement of "clear signs of falsification" for dismissal of evidence, sets a high threshold for such defence.
- The BoA set a low threshhold for content on the internet to become available to the specialised circles.

The case serves as a reminder of the relevance for companies to file for design protection at an early stage once the design is finalised. Companies should also keep to a strict policy about public disclosure of products which could be subject to design protection. Such policy should be communicated to all stakeholders that are exposed to the design.

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