

## **Community design courts and invalidity counterclaims: first experiences**

The Community design regulation empowers the Office to make decisions on the validity of registered designs, upon request of a third party. However, the validity of RCDs can also be challenged by means of invalidity counterclaims before a competent Community design court<sup>1</sup> hearing of an infringement action (Articles 24(1), 84 & 66 CDR). Therefore, both the Office and courts are competent to declare RCDs invalid if need be, under the conditions established by the Regulation.

When this happens, the competent court is bound to inform the Office of the date on which the counterclaim has been filed. The Office must record this fact in the register of Community designs (Article 86(2) CDR).

The reason for this obligation is obvious: since the Register of Community designs is centralised at OHIM, any decision affecting the validity of its registered designs must be reflected therein, particularly since the judgment of such court declaring the RCD invalid shall have in all Member States (not only in the one where the judgment is rendered) the effects established in Article 26 CDR, namely, that the design is deemed not to have had *ex tunc* (as from the outset) any of the effects specified in the Regulation.

Another reason for this duty to inform lies in the fact that, once the validity of a design is challenged before a court, another court hearing another infringement action shall stay proceedings (Article 91(1) CDR). Unless the Office makes public the institution of such counterclaim, the later court (and the parties before it) would not be in a position to find that the design for which enforcement is sought is actually challenged.

The Office proceeds to make public the institution of such invalidity counterclaim by recording it in the Register. Then, the Office's electronic Bulletin publishes its existence under the heading "**Part B.3.1. – Applications for a declaration of invalidity at the Office or applications for a declaration of invalidity pursuant to a counterclaim at the relevant Community Design Court**". The publication of such entry includes: the registration number, the date of the counterclaim and the name of the court, the date when the recordal was entered into the Register and its number, as well as the date of publication of the recordal and the number of the Bulletin<sup>2</sup>. For example<sup>3</sup>,

**11** 000148028-0001

**50** 2 - 21/09/2007 - Juzgado de lo Mercantil nº1 de Alicante

**58** 01/10/2007 - 000204776

**59** 03/10/2007 - 2007/134

When this takes place, the RCD ONLINE database reflects the change of status by signalling that there is an invalidity proceeding pending against the searched design, for example:

Design 

<sup>1</sup> List of courts at <http://oami.europa.eu/pdf/design/cdcourts.pdf>

<sup>2</sup> See "Vademecum to the Community designs Bulletin", at <http://oami.europa.eu/vademecum/rcd/introductionEN.htm>

<sup>3</sup> [http://oami.europa.eu/bulletin/rcd/2007/2007\\_134/000148028\\_0001\\_T67839.htm](http://oami.europa.eu/bulletin/rcd/2007/2007_134/000148028_0001_T67839.htm)

**Filing date:** 17/02/2004  
**Registration date:** 17/02/2004  
**Status:** [Invalidity procedure pending](#) ([Glossary](#))

Until now, few courts have been active in hearing invalidity counterclaims, according to the information received by the Office. Only 32 notifications have been issued by courts, the majority by the Spanish courts based in Alicante:

- the Juzgado de lo mercantil N° 1 de Alicante (“juzgado de marca comunitaria”) has notified counterclaims filed against 3 registered designs;
- the Juzgado de lo mercantil N° 2 de Alicante (“juzgado de marca comunitaria”) has notified counterclaims related to 13 registered designs (most of these claims introduced at the end of September 2007)
- the Tribunal de Grande Instance de Marseille (1<sup>ère</sup> chambre) notified one of the first counterclaims in 2005
- the Landgericht Düsseldorf notified 4 counterclaims
- the Landgericht München I notified 2
- the Arrondissementsrechtbank te 's – Gravenhage (the Hague) notified 6 counterclaims
- the Sąd Okręgowy w Warszawie (Warsaw) notified 3 counterclaims related to two RCDs (two counterclaims referred to the same RCD)

The Office welcomes the initiative of these courts and invites all Community design courts (as well as Community trade marks as regards CTMs) to join in. During the recent symposium for trade mark and design judges held in Alicante and hosted by the Office, the importance for the user community to have access to judgments and decisions from courts dealing with both registered Community trade marks and designs<sup>4</sup> was underlined.

In the end, courts notifying counterclaims and decisions will not only abide with the obligation to inform the Office but will contribute to consolidating the system of the Community design: the way RCDs are enforced and tested before competent courts will determine the added value of RCDs for companies and designers as a means of protecting investments made in design innovation by means of exclusive registration rights.

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<sup>4</sup> <http://oami.europa.eu/en/office/ejs/default.htm>