



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

DESIGNS DEPARTMENT – INVALIDITY DIVISION

**DECISION OF
THE INVALIDITY DIVISION
OF 20/12/06**

**IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY OF A REGISTERED
COMMUNITY DESIGN**

FILE NUMBER	ICD 000002954
COMMUNITY DESIGN	000339312-0003
LANGUAGE OF PROCEEDINGS	English

APPLICANT	Compagnie Gervais Danone (societe anonyme) 126-130, rue Jules Guesde F-92300 Levallois-Perret France
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REPRESENTATIVE OF THE APPLICANT	Kulikowska I Kulikowski Sp.j. Kwiatowa 21/3 02539 Warsaw Poland
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HOLDER	Zygmunt Piotrowski Keniga 4 M. 48 02495 Warsaw Poland
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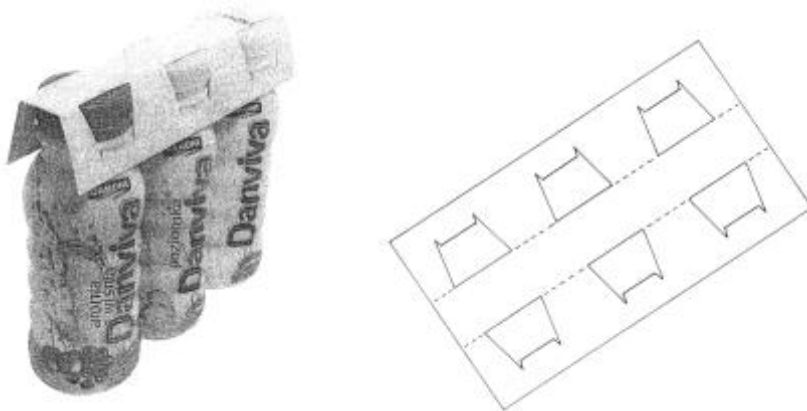
The Invalidity Division,

composed of Martin Schlötelburg (rapporteur), Peter Rodinger (member) and Eva Vyoralova (member) took the following decision on 20/12/06:

- 1. The registered Community design No 000339312-0003 is declared invalid.**
- 2. The Holder shall bear the costs of the Applicant.**

I. FACTS, EVIDENCE AND ARGUMENTS

- (1) The contested Community design No 000339312-0003 (in the following: 'the RCD') has been registered in the name of the Holder with a filing date of 05/05/05. In the RCD, the indication of the product reads "containers" and "packaging". The design is represented in the following two views which are published in the Community Designs Bulletin (http://oami.europa.eu/bulletin/rcd/2005/2005_048/000339312_0003.htm):



- (2) The Applicant filed an application for a declaration of invalidity of the RCD, received on 17/07/06. The fee for the Application was paid by current account.
- (3) Using the Office's form for the Application, the Applicant indicated the grounds of "other(s) according Article 25(1)(c), (d), (e), (f) or (g) CDR¹". In his arguments, the Applicant pointed explicitly to Article 25(1)(e) CDR.
- (4) As evidence, the Applicant provided copies of extracts from ROMARIN (International Trademark Information Database) and the Polish Patent Office regarding different registered trademarks of "DANONE" and "DANVIVA":
- Trademark "DANONE" registered by WIPO on 01/12/95, No IR-649535.
 - Trademark "DANONE" registered by the Polish Patent Office on 22/05/03, No R-144971.
 - Trademark "DANVIVA" registered by the Polish Patent Office on 14/07/03, No Z-267378.

¹ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs

The International trademark registration (in the following: IR) No 649535 was registered on 01/12/95 in the name of the Applicant, designating *inter alias* AT, BX, CZ, DE, ES, HU, IT, PL, SI and SK. The goods of the IR cover the classes 5, 29, 30, 31, 32 and 42 of the Nice Classification. In the extract, the sign is represented as follows:



- (5) In response to the Application, the Holder argues that the RCD consists only of a shape of a cut-out made from a pasteboard sheet without word marks. According to the Holder “the products identified by DANONE or DANVIVA trademarks are not part of the design”. The Holder claims that the Application is to be deemed a misunderstanding.
- (6) For further details of the facts, evidence and arguments submitted by the Applicant and the Holder, reference is made to the documents on file.

II. GROUNDS OF THE DECISION

A. Admissibility

- (7) The indication of the grounds for invalidity on the form of the Office is a statement of the grounds on which the Application is based in the meaning of Art. 28(1)(b)(i) of the CDIR². Furthermore, an Application complies with Art. 28(1)(b)(iii) CDIR, and Art. 28(1)(b)(vi) CDIR, since the attachment contains an indication of the facts, evidence and arguments submitted in support of those grounds. The other requirements of Art. 28(1) CDIR are fulfilled as well. The Application is admissible.

B. Substantiation

B.1 Evidence

- (8) An extract from ROMARIN is sufficient evidence for the IR being a prior right.

B.2 Distinctive Right

- (9) Article 25(1)(e) CDR stipulates that a Community design is to be declared invalid if a distinctive sign is used in a subsequent design, and the Community law or the law of the Member States governing that sign confers on the right holder of the sign the right to prohibit such use.

² Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs

- (10) According to Article 2 of the Directive 89/104/EEC of the Council, of 21 December 1988, a “trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings”. The Directive has been implemented in each of the Member States.
- (11) Consequently, where a sign is registered as a trademark in a Member State and the trademark is in force, it is presumed that it is a “distinctive sing” in the meaning of Article 25(1)(e) CDR.

B.2 Right to Prohibit Use

- (12) The applicant is the owner of an International registration for a figurative mark “DANONE”, made of a verbal element “DANONE”, written in white capital letters on a figurative element which represents a blue hexagon background and a red line underneath, registered for goods in the classes 5, 29, 30, 31, 32 and 42. The IR has effects in various Member States within the European Union.
- (13) According to Article 5 of the Directive 89/104/EEC, the proprietor of a registered trademark shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with the trademark in relation to goods or services which are identical with those for which the trade mark is registered.
- (14) The subject-matter of a Community design is defined by all features shown in all the views of the representation of the design, except for those features which are excluded by a disclaimer. The RCD does not contain any disclaimer. Therefore, the figurative sign “DANONE” is part of the RCD. Incorporation of the figurative sign into the RCD constitutes a use of a sign identical to the IR.
- (15) The use of the sign in the RCD is a use in the course of trade, since the purpose of registering a design is its use for commercial purposes.

C. Conclusion

- (16) The Applicant has provided evidence that he has the right to prohibit the use of the sign in the RCD. Therefore, on request of the Applicant the RCD has to be declared invalid according to Article 25(1)(e) CDR.

III. Costs

- (17) Pursuant to Article 70(1) CDR and Article 79(1) CDIR, the Holder bears the fees and costs of the Applicant.

IV. RIGHT TO APPEAL

- (18) An appeal shall lie from the present decision. Notice of appeal must be filed in writing at the Office within two months after the date of notification of that decision. The notice is deemed to have been filed only when the fee for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed (Art. 57 CDR).

THE INVALIDITY DIVISION

Martin Schlötelburg

Peter Rodinger

Eva Vyoralova