

***GUIDELINES FOR EXAMINATION IN THE
OFFICE FOR HARMONIZATION IN THE
INTERNAL MARKET (TRADE MARKS AND
DESIGNS) ON REGISTERED COMMUNITY
DESIGNS***

REGISTERED COMMUNITY DESIGNS

***EXAMINATION OF DESIGN INVALIDITY
APPLICATIONS***

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1 Purpose

The purpose of these Guidelines is to explain how, in practice, the requirements of the Community Design Regulation¹ (CDR), the Community Design Implementing Regulation² (CDIR), and the Fees Regulation³ (CDFR) are applied by the Invalidation Division of OHIM from the receipt of an application for a declaration of invalidity of a Community design ('application') up to the point of closure of the invalidity proceedings. Their purpose is also to ensure consistency among the decisions taken by the Invalidation Division and to ensure coherent practice in the treatment of the files. These Guidelines are not intended to, and cannot, add to or subtract from the legal contents of the Regulations.

2 Introduction – General Principles Applying to Invalidation Proceedings

2.1 Duty to state reasons

The decisions of the Invalidation Division must state the reasons on which they are based (Article 62 CDR). The reasoning must be logical and it must not disclose internal inconsistencies.

The Invalidation Division must rule on each head of claim submitted by the parties (judgment of 10/06/2008, T-85/07, para. 20). The Invalidation Division is, however, not required to give express reasons for its assessment of the value of each argument and each piece of evidence presented to it, in particular where it considers that the argument or evidence in question is unimportant or irrelevant to the outcome of the dispute (see by analogy judgment of 15/06/2000, C-237/98 P, para. 51). It is sufficient if the Invalidation Division sets out the facts and legal considerations having decisive importance in the context of the decision (judgment of 12/11/2008, T-7/04, para. 81).

Whether the reasoning satisfies those requirements is a question to be assessed with reference not only to its wording, but also to its context and the legal rules governing the matter in question (judgment of 07/02/2007, T-317/05, para. 57).

¹ [Council Regulation \(EC\) No 6/2002 of 12 December 2001 on Community Designs](#), by Council Regulation No 1891/2006 of 18 December 2006 amending Regulations (EC) No 6/2002 and (EC) No 40/94 to give effect to the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs

² [Commission Regulation \(EC\) No 2245/2002 of 21 October 2002 implementing Council Regulation \(EC\) No 6/2001 on Community designs](#), as amended by Commission Regulation (EC) No 876/2007 on 24 July 2007 amending Regulation (EC) No 2245/2002 implementing Council Regulation (EC) No 6/2002 on Community designs following the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs

³ [Commission Regulation \(EC\) No 2246/2002 of 16 December 2002 on the fees](#), as amended by Commission Regulation (EC) No 877/2007 of 24 July 2007 amending Regulation (EC) No 2246/2002 concerning the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) following the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs

2.2 Right to be heard

The decisions of the Invalidation Division will be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments (second sentence of Article 62 CDR).

To that end, the Invalidation Division will invite the parties, as often as necessary, to file observations on communications from the other parties or issued by itself (Article 53(2) CDR).

The right to be heard covers all the factual and legal evidence which form the basis for the act of taking the decision, but it does not apply to the final position which the Invalidation Division intends to adopt (judgment of 20/04/2005, T-273/02, 'CALPICO/CALYPSO', para. 64-65).

The Invalidation Division may base its analysis on facts arising from practical experience generally acquired from the marketing of general consumer goods which are likely to be known by anyone and are, in particular, known by the informed users of those goods; in such a case the Invalidation Division is not obliged to give examples or evidence of such a practical experience.

2.3 Scope of the examination carried out by the Invalidation Division

In invalidation proceedings, the examination carried out by the Invalidation Division is restricted to the facts, evidence and arguments provided by the parties (Article 63(1) CDR). However, the Invalidation Division must weigh the facts, evidence and arguments, adjudicate on their conclusiveness, and thereafter draw legal inferences from them without being bound by the points of agreement between the parties. Alleged facts which are not supported by evidence are not taken into account (decision of the Invalidation Division of 22/04/2008 (ICD 4448)).

Facts, evidence and arguments are three different items not to be confused with each other. For instance, the date of disclosure of a prior design is a fact. Evidence of that fact could be the date of publication of a catalogue showing the prior design together with evidence proving that the catalogue has been made available to the public before the date of filing or the priority date of the contested Community design. The applicant's argument could be that the prior design forms an obstacle to the novelty of the contested Community design given the similar overall impression they produce on the informed user. Whether a Community design lacks novelty or not is not a fact but a legal question to be decided by the Invalidation Division on the basis of the facts, evidence and arguments provided by the parties.

Expert reports or expert opinions and other statements in writing fall within the means of evidence referred to in Article 65(1)(c) and (f) CDR. However, the fact that they are procedurally admissible does not automatically mean that the statement is credible and will serve as proof of the facts to be proven. Rather, such statements must be critically examined as to the accuracy and correctness of the information, as well as whether they come from an independent source and/or are fettered or supported by written information (decision of the Invalidation Division of 22/04/2008 (ICD 4448)).

Moreover, the legal criteria for applying a ground for invalidity are naturally part of the matters of law submitted for examination by the Invalidation Division. A matter of law may

have to be ruled on by the Invalidation Division even when it has not been raised by the parties if it is necessary to resolve that matter in order to ensure a correct application of the CDR. The Invalidation Division will thus examine ex officio such matters of law which can be assessed independently of any factual background for the purpose of allowing or dismissing the parties' arguments, even if they have not put forward a view on those matters (see by analogy judgment of 01/02/2005, T-57/03, para. 21). Such matters of law will include inter alia the definition of the informed user and the degree of freedom of the designer within the meaning of Article 6 CDR.

2.4 Compliance with time limits

The Invalidation Division may disregard facts or evidence which are not submitted in due time by the parties concerned (Article 63(2) CDR).

Parties are reminded that they must file the facts and evidence on which they rely in due time and within the time limits set by the Invalidation Division. Parties which fail to observe the time limits run the risk that the evidence may be disregarded. Parties have no unconditional right to have facts and evidence submitted out of time to be taken into consideration by the Invalidation Division.

Where the Invalidation Division exercises its discretion under Article 63(2) CDR, it must state reasons why the late facts and evidence are admissible or not, taking into consideration whether the material which has been produced late is, on the face of it, likely to be relevant to the outcome of the invalidation proceedings brought before it and, second, whether the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not argue against such matters being taken into account (judgment of 13/03/2007, C-29/05 P, para. 42-44).

3 Filing of an Application

3.1 Form of the application

For filing an application (Article 52 CDR) the Office provides a form (Article 68(1)(f) CDIR) which may be downloaded from the Office's website.

The use of the form is strongly recommended (Article 68(6) CDIR), in order to facilitate the processing of the application and to avoid errors.

The application, including the supporting documents, should be submitted in two sets, in order that one set can be kept in the archive of the Office while the other is sent to the holder without incurring a loss of quality due to copying. If an application is submitted in one set only, the Invalidation Division may invite the applicant to file a second set within a period of one month, or two months if the applicant does not have its domicile or its principal place of business or an establishment within the European Union (Article 57(1) CDIR).

3.2 Scope of the application

In invalidation proceedings, the relief sought by the applicant can only be the declaration of invalidity of the contested Community design, as registered (Article 25 CDR).

Where contested Community designs are part of a multiple registration, each of them must be contested individually and identified by reference to their full registration number (Article 37(4) CDR). A single application (and a common statement of grounds) may concern more than one Community design of a multiple registration. In such a case, the fee for the application must be paid for each contested Community design. However, for the sake of clarity the Office recommends that separate applications be lodged for each contested Community design.

3.3 Language of proceedings

The language used in filing the application for registering the contested Community design (language of filing) is the language of the invalidity proceedings (language of proceedings) provided the language of filing is one of the five languages of the Office (Article 98 CDR; Article 29 CDIR).

If the language of filing is not one of the five languages of the Office, the language of proceedings is the second language indicated in the application for the contested Community design (Article 98(4) CDR; Article 29(1) CDIR).

The application for a declaration of invalidity must be filed in the language of proceedings. Where the application is not filed in the language of proceedings, the Invalidity Division will notify the applicant requesting it to file a translation within a period of two months from the date of receipt of the notification. Where the applicant does not comply with the request, the application is rejected as inadmissible (Article 30(1) CDIR).

The parties to the invalidity proceedings may agree on a different language of proceedings provided it is an official language of the European Union. Information as regards the agreement must reach the Office within a period of two months after the holder has been notified of the application. Where the application was not filed in that language, the applicant must file a translation of the application in that language within one month from the date when the Office has been informed of the agreement (Article 98(5) CDR; Article 29(6) CDIR).

For the linguistic regime applicable to the supporting documents, see paragraph 3.9.2 below.

3.4 Identification of the application

The application must contain an indication of the name and address of the applicant (Article 28(1)(c) CDIR).

Where the information given in the application does not make it possible to identify the applicant unambiguously, and the deficiency is not remedied within two months of the Invalidity Division's request in that regard, the application must be rejected as inadmissible (Article 30(1) CDIR).

3.5 Locus Standi of the applicant

Any natural or legal person, as well as a public authority empowered to do so, may submit an application for a declaration of invalidity of a Community design to the Invalidation Division based on Article 25(1)(a) and (b) CDR (Article 52(1) CDR).

However, where the ground for invalidity is the violation of an earlier right, within the meaning of Article 25(1)(c) to (f) CDR, or an improper use of official emblems, within the meaning of Article 25(1)(g) CDR, the admissibility of an application for a declaration of invalidity requires the applicant to be entitled to the earlier right or to be concerned by the use of the official emblem, as the case may be (Article 52(1) CDR).

For the substantiation of the applicant's entitlement, see paragraph 3.9.2 below.

3.6 Representation of the application

3.6.1 When representation is mandatory

As a matter of principle, the rules governing representation in Community trade mark proceedings apply *mutatis mutandis* to invalidity proceedings for Community designs (see The Guidelines, Part A, General Rules, Section 5, Professional Representation).

Persons having their domicile or their principal place of business or a real and effective industrial or commercial establishment in the European Union are not required to be represented in any proceedings before the Office.

Where the applicant does not have its domicile or its principal place of business or a real and effective industrial or commercial establishment in the European Union, it must be represented by a representative, otherwise the applicant will be requested to appoint a representative within a time limit of two months. Where the applicant does not comply with the request, the application is rejected as inadmissible (Article 77(2) CDR; Articles 30(1) and 28(1)(c) CDR).

In examining whether an applicant has a real and effective industrial or commercial establishment in the European Union, the Invalidation Division follows the guidance of the Court of Justice of 22/11/1978, C-33/78, 'Somafer SA', para. 12 ('The concept of branch, agency or other establishment implies a place of business which has the appearance of permanency, such as the extension of a parent body, has a management and is materially equipped to negotiate business with third parties'). Proof that an applicant has a real and effective industrial or commercial establishment in the European Union may consist inter alia of articles of incorporation, annual reports, statements in writing, and other business documents.

3.6.2 Who may represent

Only a legal practitioner or a professional representative who fulfills the requirements of Article 78(1) CDR can represent third parties before the Office.

A natural or legal person whose domicile, principal place of business, or real and effective industrial or commercial establishment is in the Community may be represented before the Office by an employee. Employees of such a legal person may also represent another legal person having neither its domicile nor its principal place of

business nor a real and effective industrial or commercial establishment within the European Union, provided there exist economic connections between the two legal persons (Article 77(3) CDR).

3.7 Identification of the contested Community design

An application for a declaration of invalidity must contain the registration number of the contested Community design and the name and address of its holder, as entered in the register (Article 28(1)(a) CDIR).

Where the information given by the applicant does not make it possible to identify the contested Community design unambiguously, the applicant will be requested to supply such information within a period of two months. If the applicant does not comply with this request, the application will be rejected as inadmissible (Article 30(1) CDIR).

3.8 Lapsed registrations

A Community design may be declared invalid even after the Community design has lapsed or has been surrendered (Article 24(2) CDR).

Where the contested Community design has lapsed or has been surrendered on or before the date of filing of the application, the applicant will be requested to submit evidence, within a period of two months, that it has a legal interest in the declaration of invalidity. Where the applicant does not comply with the request, the application is rejected as inadmissible (Article 30(1) CDIR) (decision of the Invalidity Division of 16/06/2011 (ICD 8231)).

For instance, legal interest is established where the applicant proves that the holder of the contested Community design has taken steps with the view to invoke rights under the contested Community design against it.

Where the contested Community design has lapsed or has been surrendered in the course of the invalidity proceedings, the applicant will be asked to confirm whether it maintains its application within a period of two months and, if so, to submit reasons in support of its request to obtain a decision on the merits of the case.

3.9 Statement of grounds, facts, evidence and arguments

The application must include an indication of the grounds on which the application is based (Article 52(2) CDR; Article 28(1)(b)(i) CDIR) together with a reasoned statement stating the facts, evidence and arguments in support of those grounds (Article 28(1)(b)(vi) CDIR).

3.9.1 Statement of grounds

Where the applicant uses the form provided by the Office (Article 68(1)(f) CDIR), the indication of the grounds relied on is made by ticking one or several boxes in the field 'Grounds'. The Invalidity Division will examine an application in the light of all grounds

put forward in the reasoned statement of grounds, even if the corresponding boxes in the form used to lodge the action were not ticked.

Where the applicant does not use the form provided by the Office, an indication of the relevant sub-section of Article 25(1) CDR, such as 'ground of Article 25(1)(a) CDR', is sufficient to establish admissibility of the application in respect to the statement of grounds.

Where the application does not make it possible to unambiguously identify the ground(s) on which the application is based, the applicant will be requested to provide further specifications in this respect within a period of two months. Where the applicant does not comply with the request, the application will be rejected as inadmissible (Article 30(1) CDIR).

Grounds for invalidity other than those specifically relied on in the application will be considered inadmissible when subsequently put forward before the Invalidity Division.

The Office strongly recommends that all grounds for invalidity be put forward in one single application. Where separate applications are lodged against the same contested Community design and based on different grounds, the Invalidity Division may deal with them in one set of proceedings. The Invalidity Division may subsequently decide to no longer deal with them in this way (Article 32(1) CDIR).

3.9.2 Facts, evidence and arguments

The applicant must indicate the facts, evidence and arguments in support of the ground(s) on which the application is based (Article 28(1)(b)(vi) CDIR).

The arguments will be set out either in the corresponding box in the form provided by the Office (Article 68(1)(f) CDIR) or in the reasoned statement attached to the application.

Where the applicant claims that the contested Community design lacks novelty or individual character (Article 25(1)(b) CDR), the application must contain a representation of the prior design(s) that could form an obstacle to the novelty or individual character of the contested Community design, as well as documents proving the disclosure of the prior design(s) (Article 7 CDR; Article 28(1)(b)(v) CDIR).

Where the applicant claims that the holder is not entitled to the contested Community design (Article 25(1)(c) CDR), the application must contain particulars showing that the applicant is entitled to the contested Community design by virtue of a court decision (Article 28(1)(c)(iii) CDIR).

Where the applicant claims that the contested Community design is in conflict with a prior design (Article 25(1)(d) CDR), the application must contain a representation and particulars identifying the prior design. Furthermore, the application must contain evidence proving that the applicant is the holder of the prior design as a ground for invalidity (Article 28(1)(b)(ii) CDIR).

Where the applicant claims that the contested Community design violates an earlier right, namely that it makes unauthorised use of a distinctive sign (Article 25(1)(e) CDR) or a work protected by copyright in a Member State (Article 25(1)(f) CDR), the

application must contain a representation and particulars identifying the distinctive sign or the work protected by copyright.

Furthermore, the application must contain evidence proving that the applicant is the holder of the earlier right in question (Article 28(1)(b)(iii) CDR). Where the earlier right is *unregistered*, this condition will be considered to be complied with, for the purpose of examining the admissibility of the application, where the applicant submits evidence that the earlier distinctive sign or the earlier work protected by copyright law has been used or disclosed, as the case may be, under the applicant's name before the date of filing or the priority date of the Community design (see paragraphs 5.7.3 and 5.8.1 below for the substantiation of the proprietorship of the earlier right relied on under Article 25(1)(e) and (f) CDR).

Where the applicant claims that the contested Community design makes improper use of any of the items listed in Article 6*ter* of the Paris Convention or of badges, emblems and escutcheons other than those covered by Article 6*ter* and which are of particular interest in a Member State (Article 25(1)(g) CDR), the application must contain a representation and particulars of the relevant item and particulars showing that the application is filed by the person or entity concerned by the improper use (Article 28(1)(b)(iv) CDR).

Where such indications, as required above, are missing and the deficiency is not remedied by the applicant within a period of two months following a request of the Invalidation Division, the application will be rejected as inadmissible (Article 30(1) CDR).

Where the evidence in support of the application is not filed in the language of proceedings, the applicant shall on its own motion submit a translation of that evidence into that language within two months of the filing of such evidence (Article 29(5) CDR). The question of whether certain parts of the supporting documents may be considered irrelevant for the application, and therefore not translated, is a matter for the discretion of the applicant. In cases where a translation is not filed, the Invalidation Division will disregard the text portions of the evidence which are not translated and base its decision solely on the evidence before it which has been translated into the language of proceedings (Article 31(2) CDR).

Documents in support of an application should be listed in a schedule of annexes appended to the application itself. As best practice, the schedule of annexes should indicate, for each document annexed, the number of the annex (Annex A.1, A.2...), a short description of the document (e.g. 'letter') followed by its date, the author(s) and the number of pages, and the page reference and paragraph number in the pleading where the document is mentioned and its relevance is described.

The documents annexed to a pleading must be paginated. This is to ensure that all pages of the annexes have been duly scanned and communicated to the other parties.

3.9.3 Admissibility in respect of one of the grounds relied on

An application based on more than one ground of invalidity is admissible if the requirements regarding admissibility are satisfied for at least one of these grounds.

3.10 Signing the application

The application for a declaration of invalidity must be signed by the applicant or its representative if it has one (Article 65(1) CDIR).

Where the signature is missing, the Invalidity Division will request the applicant to remedy the deficiency within two months. If the applicant does not comply with the request, the application will be rejected as inadmissible (Article 30(1) CDIR).

3.11 Means of filing

An application for a declaration of invalidity may be filed with the Office by post, personal delivery, or telecopier/fax (Article 65 CDIR). Electronic filing of applications will be allowed by a subsequent decision of the President once the technical means are available.

Where a communication received by fax is incomplete or illegible, or where the Invalidity Division has reasonable doubts as to the accuracy of the transmission, the Invalidity Division will inform the sender accordingly and will call upon him/her, within a time limit to be specified by the Invalidity Division, to retransmit the original by fax or to submit the original. Where that request is complied with within the time limit specified, the date of the receipt of the retransmission or of the original shall be deemed to be the date of the receipt of the original communication. Where the request is not complied with within the time limit specified, the communication shall be deemed not to have been received (Article 66(2) CDIR).

Transmission by fax is not recommended for applications for a declaration of invalidity, in particular where lack of novelty and/or lack of individual character are claimed, because the quality of the representation of the prior design(s) may be deteriorated by fax transmission and colour information will be lost.

Where an application is transmitted by fax, the Office recommends that the applicant submits two sets of the original within one month from the date of transmission of the fax. The Invalidity Division will then forward one set to the holder. Where the applicant does not subsequently submit original documents after a fax transmission, the Invalidity Division will proceed with the documents before it.

It is the applicant's responsibility to ensure that the features of earlier designs or other rights, as they appear in the fax received by the Invalidity Division, are sufficiently visible and identifiable in order for the Invalidity Division to make its decision. An application will be dismissed as unsubstantiated if the faxed evidence of the prior art, or of the earlier rights, without being totally illegible, is not of a sufficient quality allowing all the details to be discerned with a view to a comparison with the contested Community design (decision of 10/03/2008, R 586/2007-3 – 'Barbecues', para. 23-26).

3.12 Payment of fee

The application for a declaration of invalidity will be deemed not to have been filed until the fee has been paid in full (Article 52(2) CDR; Articles 28(2) and 30(2) CDIR).

The methods of payment are via transfer to a bank account held by the Office (Article 5(1) CDFR) or, for current account holders, via current account. In the case of

payment via a current account, the fee will be debited automatically from the current account of the applicant upon receipt of the application. The date on which the amount of the payment is actually entered in the bank account of the Office will be considered to be the date of payment (Article 7(1) CDFR).

See The Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges for further reference.

Payment cannot be made by cheque.

Where the Invalidation Division finds that the fee has not been paid, it will notify the applicant requesting him/her to pay the fee within a period of two months after receipt of the notification. If the applicant does not comply with the request, the application is deemed not to have been filed and the applicant is informed accordingly. If the required fee is paid after the expiry of the time limit specified, it will be refunded to the applicant (Article 30(2) CDR).

The date of payment of the fee determines the date of filing of the application of a declaration of invalidity (Article 52(2) CDR; Article 30(2) CDR).

3.13 Treating deficiencies

Where the Invalidation Division finds the application inadmissible and the deficiency is not remedied within the specified time limit, the Invalidation Division will issue a decision rejecting the application as inadmissible (Article 30(1) CDR). The fee will not be refunded.

3.14 Communication to the holder

The communication of an application for a declaration of invalidity to the RCD holder takes place only after this application was found admissible (Article 31(1) CDR). This communication constitutes as such a decision on the admissibility, rather than a simple measure of organisation of procedure. This decision can be appealed together with the final decision (Article 55(2) CDR).

The decision on the admissibility may, however, be withdrawn, in accordance with the general principles of administrative and procedural law, if irregularities are detected ex officio by the Office, within a reasonable time, or by the RCD holder in its first observations (Article 31(1) CDR), and if the applicant for invalidity fails to remedy such irregularities within the time limit prescribed by the Office (Article 30 CDR) (see Article 68 CDR and, by analogy, judgment of 18/10/2012, C-402/11 P, REDTUBE / REDTUBE, para. 59).

Where the Invalidation Division does not reject the application as inadmissible, the application is communicated to the holder and a time limit of two months for submitting observations in response to the application is notified (see below under paragraph 4.1.1 Observations by the holder).

3.15 Participation of an alleged infringer

As long as no final decision has been taken by the Invalidation Division, any third party who proves that proceedings for infringement based on the contested Community design have been instituted against him may join as a party in the invalidation proceedings (Article 54 CDR; Article 33 CDIR).

The alleged infringer must file its request to be joined as a party within three months of the date on which the infringement proceedings were instituted. Unless proof is submitted by the holder that another date should be retained according to the national law in question, the Invalidation Division will assume that proceedings are 'instituted' on the date of service of the action to the alleged infringer. The alleged infringer must submit evidence in respect of the date of service of the action.

Any third party who proves that (i) the right holder of the Community design has requested that it cease an alleged infringement of the design and that (ii) the third party in question has instituted proceedings for a court ruling that it is not infringing the registered Community design (if actions for declaration of non-infringement of Community designs are permitted under national law) may also join as a party in the invalidation proceedings (Article 54 and 81(b) CDR).

The request to be joined as a party must be filed in a written reasoned statement and it will not be deemed to have been filed until the invalidation fee has been paid. The rules explained above at paragraphs 3.1 to 3.13 will apply to the alleged infringer (Article 54(2) CDR; Article 33 CDIR).

4 Adversarial Stage of the Proceedings

4.1 Exchange of communications

4.1.1 Observations by the holder

4.1.1.1 Generalities

The holder's observations will be communicated to the applicant without delay (Article 31(3) CDIR).

Documents in support of observations should be listed in a schedule of annexes (see paragraph 3.1.9.2 above).

The holder should submit its observations (including the supporting documents) in two sets, so that one set can be kept in the archive of the Office and the other set can be sent to the applicant. This is done to avoid a loss of quality in the observations material due to copying by the Office. Where the observations are submitted in one set only, the Invalidation Division may invite the holder to file a second set within a period of one month, or two months if the applicant does not have its domicile or its principal place of business or an establishment within the European Union (Article 57(1) CDIR).

Where the holder files no observations within the two-month time limit, the Invalidation Division will notify the parties that the written part of the procedure is closed and that it will take a decision on the merits on the basis of the evidence before it (Article 31(2) CDIR).

4.1.1.2 Request for proof of use of an earlier trade mark

A request for proof of use of an earlier trade mark during the period of five years preceding the date of the application for a declaration of invalidity may be submitted by the holder if the following cumulative conditions are complied with:

- the application is based on Article 25(1)(e) CDR;
- the earlier distinctive sign is a (Community, international or national) trade mark having effect in the European Union which, on the date of the application for a declaration of invalidity, has been registered for not less than five years;
- the request for proof of use is submitted together with the holder's first submission in response to the application (judgment of 12/05/2010, T-148/08, 'Instrument for writing', para.66-72. See also decision of 09/08/2011, R 1838/2010-3 – 'Instrument for writing').

'The date of the completion of the registration procedure' (Article 10(1) of Directive 2008/95/EC) that serves to calculate the starting point for the obligation of use for national and international registrations is determined by each Member State according to their own procedural rules (judgment of 14/06/2007, C-246/05, 'LE CHEF DE CUISINE', para. 26-28). As regards Community trade marks, that date is the date of registration (Article 15(1) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, hereafter 'CTMR') as published in the Community Trade Marks Bulletin (Rule 23(5) of Commission Regulation 2868/95 implementing the CTMR, hereafter 'CTMIR'). As regards international registrations designating the European Union, the relevant date is that of the second publication pursuant to Articles 152(2) and 160 CTMR.

4.1.2 Translation of the holder's observations

Where the language of proceedings is not the language of filing of the contested Community design, the holder may submit its observations in the language of filing (Article 98(4) CDR; Article 29(2) CDIR). The Invalidity Division will arrange to have those observations translated into the language of proceedings, free of charge, and will communicate the translation to the applicant without delay.

4.1.3 Scope of defence

The holder's observations must include an indication regarding the extent to which it defends the contested Community design. Where the holder does not give such an indication, it is assumed that it seeks maintenance of the Community design in the form as originally registered, i.e. in its entirety.

Where the holder requests to maintain the Community design in an amended form, its request has to include the amended form. The amended form must comply with the requirements for protection, and the identity of the Community design must be retained. 'Maintenance' in an amended form may include registration accompanied by a partial disclaimer by the holder or entry in the register of a court decision or a decision by the Invalidity Division declaring the partial invalidity of the Community design (Article 25(6) CDR) (see paragraph 4.9).

The request to maintain the contested Community design in amended form must be submitted during the invalidity proceedings and before the end of the written procedure. The applicant will be given the opportunity to comment on whether the Community design in its amended form complies with the requirements for protection and whether the identity of the Community design is retained. The decision on the maintenance of the Community design in an amended form will be included in the decision on the merits terminating the invalidity proceedings.

4.1.4 Reply by the applicant

4.1.4.1 Generalities

Where the parties' submissions allow the Invalidity Division to base its decision on the evidence before it, the Invalidity Division will notify the parties that the written phase of the proceedings is closed.

However, the applicant will be allowed to reply to the holder's observations within a time limit of two months (Article 53(2) CDR; Article 31(3) CDIR) in the following circumstances:

- where the holder's observations contain new facts, evidence and arguments which are *prima facie* relevant for a decision on the merits; or
- where the holder requests to maintain the Community design in an amended form; or
- where the holder requested proof of use of the earlier trade mark relied on under Article 25(1)(e) CDR.

Any reply of the applicant will be communicated to the holder (Article 31(4) CDIR). Where the applicant's reply is considered admissible, the holder will be invited to submit a rejoinder (Article 53(2) CDR).

Where the applicant does not reply within the specified time limit, the Invalidity Division will notify the parties that the written phase of the proceedings is closed and that it will take a decision on the merits on the basis of the evidence before it (Article 31(2) CDIR).

The subject matter of the proceedings must be defined in the application (see paragraphs 2.1.9.1 and 2.1.9.2 above). Reliance on additional earlier designs and/or rights is inadmissible when submitted at the belated procedural stage of the reply if the effect is to alter the subject matter of the proceedings (decision of 22/10/2009, R 690/2007-3 – 'Chaff cutters', para. 44 et seq.). The admissibility of additional facts, evidence and arguments relating to earlier designs and/or rights already referred to in the application is subject to the discretionary powers conferred on the Invalidity Division under Article 63(2) CDR (see paragraph 2.4 above).

The applicant should submit its reply in two sets, so that one set can be kept in the archive of the Office and the other set can be sent to the holder. This is done to avoid a loss of quality due to copying. If a reply was submitted in one set only, the Invalidity Division may invite the applicant to file a second set within a period of one month, or two months if the applicant does not have its domicile or its principal place of business or an establishment within the European Union (Article 57(1) CDIR).

4.1.4.2 Translation of the applicant's reply

Any reply of the applicant must be in the language of proceedings. Where the applicant has been invited to reply and its reply is not in the language of proceedings, the applicant must submit, on its own motion, a translation of its reply within one month of the date of the submission of the original reply (Article 81(1) CDIR). The Invalidation Division will not remind the applicant of its duty in this respect. Where the applicant submits the translation on time, it will be communicated to the holder. Where the applicant does not submit the translation on time, its reply will be deemed not to have been filed.

4.1.4.3 Submission of evidence of use of an earlier trade mark

Where the holder is requested to submit evidence of use of its earlier trade mark, it shall submit such evidence (i) in connection with the goods or services in respect of which this trade mark is registered, and which the applicant cites as justification for its application and (ii) in respect of the period of five years preceding the date of the application for a declaration of invalidity, unless there are proper reasons for non-use. Such reasons for non-use must be substantiated.

Evidence of use of an earlier mark must fulfil *all* the cumulative conditions imposed by Rule 22(3) CTMR, that is, indications concerning the *place, time, extent* and *nature* of use of the earlier trade mark for the goods and services for which it is registered and on which the application is based.

Use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered is admissible (Article 5(C)2 of the Paris Convention).

Where the language of the documents submitted by the applicant is not the language of the proceedings, the Invalidation Division may require that a translation be supplied in that language, within one month, or two months if the holder does not have its domicile or its principal place of business or an establishment within the European Union (Articles 81(2) and 57(1) CDIR).

In the absence of proof of genuine use of the earlier trade mark (unless there are proper reasons for non-use), or in the absence of a translation if so required by the Invalidation Division, the application for a declaration of invalidity will be rejected to the extent that it was based on Article 25(1)(e) CDR. If the earlier trade mark has been used in relation to only a part of the goods or services for which it is registered, it will, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect of only that part of the goods or services (see by analogy Articles 57(2) and (3) CTMR).

When examining the evidence of use, the Invalidation Division will apply the principles explained in The Guidelines, Part C, Opposition, Section 6, Proof of Use.

4.1.5 End of exchange of observations

Where the parties' observations do not contain new facts, evidence or arguments which are *prima facie* relevant for a decision on the merits, the Invalidation Division will

inform both parties that the written proceedings are closed and that a decision will be taken on the basis of the evidence before it (Article 53(2) CDR).

Facts, evidence or arguments submitted after notification to the parties that the written phase of the procedure is closed will be considered inadmissible, save in exceptional circumstances, e.g. where the evidence was unavailable at an earlier stage or where a fact came to light in the course of the proceedings (Article 63(2) CDR, see paragraph 2.4 above).

4.1.6 Extension of time-limits and suspension

4.1.6.1 Extension of time-limits

Requests for an extension of a time limit by any of the parties have to be made before its expiry (Article 57(1) CDIR).

As a general rule, a first request for extension of a time limit will be granted. Further extensions will not automatically be granted. In particular, the Invalidation Division may make the extension of a time limit subject to the agreement of the other party or parties to the proceedings (Article 57(2) CDIR).

Reasons in support of any further request for extension must be submitted to the Invalidation Division. The request for an extension of the time limit must indicate the reasons why the *parties* cannot meet the deadline. The obstacles faced by the parties' *representatives* do not justify an extension (see, by analogy, order of 05/03/2009, C-90/08 P, 'CORPO LIVRE/LIVRE', para. 20-23).

The extension will not result in a time limit longer than 6 months (Article 57(1) CDIR). Both parties are informed about any extension.

4.1.6.2 Suspension

The Invalidation Division will suspend the proceedings on its own motion after hearing the parties, unless there are special grounds for continuing the proceedings, where it has been brought to the attention of the Invalidation Division that the validity of the contested Community design is already in issue on account of a counterclaim before a competent national court and the national court does not stay its proceedings (Article 91(2) CDR).

The Invalidation Division may suspend the proceedings where it is appropriate in the circumstances, in particular:

- where the request for a declaration of invalidity is based on an earlier design or trade mark for which the registration process is pending, until a final decision is taken in those proceedings (Article 25(1)(d) and (e) CDR);
- where the request for a declaration of invalidity is based on an earlier design or trade mark, the validity of which is challenged in administrative or in court proceedings, until a final decision is taken in those proceedings;
- where the Invalidation Division receives a joint request for suspension signed by both parties with a view to reaching an amicable settlement (Article 31(5) CDIR);

- where a number of applications for a declaration of invalidity have been filed relating to the same Community design, and where a preliminary examination reveals that the Community design may be invalid on the basis of one of these applications. The Invalidity Division will deal with this application first and it may suspend the other invalidity proceedings (Article 32(2) CDR).

The Invalidity Division has broad discretionary powers when deciding on the appropriateness of the suspension. The decision on the suspension must take into account the balance between the parties' respective interests, including the applicant's interest to obtain a decision within a reasonable period of time (see by analogy, judgment of 16/05/11, T-145/08, 'Atlas', para. 68-77).

The Invalidity Division will notify the parties of its decision to grant a suspension. Where a suspension is granted for a determined period, the Invalidity Division will indicate in its communication the date of resumption of the proceedings. The proceedings will resume the day after the expiry of the suspension.

Where a suspension is granted for an undetermined period, the invalidity proceedings will be resumed when the parties inform the invalidity Division that the event which justified the stay occurred, or cease to exist, as the case may be. The date of resumption will be indicated in the communication of the Invalidity Division or, in the absence of such indication, on the day following the date of that communication.

Where a time limit was running at the time of the suspension, the party concerned will be given two months from the date of resumption of the proceedings to submit its observations.

Where the suspension was requested jointly by the parties, the period will always be one year regardless of the period requested by the parties. Any party can bring an end to the suspension ('opting out'). It is immaterial whether the other party disagrees with this or has consented to it.

If one of the parties opts out, the suspension will end two weeks after informing the parties thereof. The proceedings will resume the day after. Where a time limit was running at the time of the suspension, the party concerned will be given two months from the date of resumption of the proceedings to submit its observations.

4.1.7 Taking of evidence

The parties may submit evidence in the form of documents and items of evidence, opinions by experts and witnesses, and/or statements in writing, sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up (Article 65(1) CDR).

Where a party offers evidence in the form of witness statements or expert opinions, the Invalidity Division will invite the party to provide the statement of the witness or the opinion of the expert in writing, except where a hearing is considered expedient (Article 65 CDR; Articles 43 and 46 CDR).

4.1.8 Oral proceedings

Oral proceedings will be held at the request of the Invalidation Division or of any of the parties (Article 64 CDR; Articles 38(1) and 42 CDIR).

Where a party requests that they be held, the Invalidation Division enjoys broad discretionary powers as to whether oral proceedings are really necessary. A hearing will not be held when the Invalidation Division has before it all the information needed as a basis for the operative part of the decision on invalidity (decision of 13/05/2008, R 135/2007-3 – ‘Automatic machines for games’, para. 14).

Where the Invalidation Division has decided to hold oral proceedings and to summon the parties, the period of notice may not be less than one month unless the parties agree to a shorter period.

Since the purpose of any oral proceedings is to clarify all points remaining to be settled before a decision on the merits is taken, it is appropriate that the Invalidation Division, in its summons, should draw the attention of the parties to the points which in its opinion need to be discussed. In so far as the Invalidation Division considers that certain matters require it, and to facilitate the hearing, it may invite the parties to submit written observations or to produce evidence prior to the oral hearing. The period fixed by the Invalidation Division for the receipt of such observations will take account of the fact that these must reach the Invalidation Division within a reasonable period of time to enable them to be submitted to the other parties.

The parties may likewise produce evidence in support of their arguments on their own initiative. However, should such evidence have been produced at an earlier stage of the proceedings, the Invalidation Division will be the sole judge of the admissibility of these items of evidence, complying with the principle of hearing both parties where appropriate.

Oral proceedings, including delivery of the decision, are public, provided the contested Community design has been published, unless the admission of the public could entail a serious and unjustified disadvantage, in particular for a party to the proceedings. The parties are informed accordingly in the summons.

The parties shall be provided with a copy of the minutes which contain the essentials of the oral proceedings and the relevant statements made by the parties (Article 46 CDIR).

4.2 Examination

4.2.1 Commencement of examination

The Invalidation Division begins with the examination of the application as soon as the parties are informed that the written phase of the procedure is closed and that no further observations shall be submitted (Article 53 CDR).

4.2.2 Examination of the grounds for invalidity

The grounds for declaring a Community design invalid are exhaustively listed in Article 25 CDR. An application for a declaration of invalidity based on a ground other

than those listed in the CDR (e.g. a claim that the holder was acting in bad faith when applying for the registered Community design) will be rejected as inadmissible as far as the ground in question is concerned (judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', para. 30-31).

More than one ground may be relied on in the application without entailing additional fees. Where the applicant uses the form supplied by the Office, it must tick the box corresponding to the ground(s) on which the application is based.

Each ground must be supported by its own set of facts, evidence and arguments.

Article 25(1)(b) CDR includes several grounds, namely the ground of failure to meet the requirements of Article 4 CDR (novelty, individual character and visibility of component parts of complex products), the grounds of Article 8(1) and (2) CDR (functionality and designs of interconnections), and the ground of Article 9 CDR (contrariety to public policy or morality).

Where the 'Grounds' box in the application form corresponding to Article 25(1)(b) CDR is ticked, the Invalidation Division will determine which specific ground(s) are relied on by the applicant from the facts, evidence and arguments referred to in the reasoned statement of grounds, and will limit the scope of its examination of the application accordingly (decision of 17/04/2008, R 976/2007-3 – 'Radiators for heating', para. 26).

The same applies to the 'Grounds' box in the application form corresponding to Article 25(1)(c), (d), (e), (f) or (g) CDR.

The Invalidation Division must examine an application in the light of all grounds put forward in the original statement of grounds, even if the corresponding boxes in the application form were not ticked. Therefore, where the applicant indicated in the statement of grounds that the contested Community design was 'not novel', that indication constitutes a valid statement of grounds even if the 'Grounds' box concerning the requirements of Articles 4 to 9 CDR was not ticked (decision of 02/08/2007, R 1456/06-3 – 'Saucepan handle', para. 10).

Where an applicant expressly challenges the novelty of a Community design and provides evidence of an earlier disclosure, it is assumed that it seeks a declaration of invalidity on the ground of Article 25(1)(b) CDR in conjunction with Article 4 CDR. Therefore, the Invalidation Division will also examine the individual character of the contested Community design (decision of 22/11/2006, R 196/2006-3 – 'Underwater motive device').

The applicant cannot raise new grounds for invalidity after the date of filing of the application. However, the applicant may file another application for a declaration of invalidity based on different grounds.

Where the application can be upheld on the basis of one of several grounds put forward by the applicant, the Invalidation Division will not take a decision on the others (decision of 15/12/2004 – ICD 321). Where an application can be upheld on account of the existence of one of the earlier designs or rights relied on by the applicant, the remaining earlier designs or rights will not be examined (see by analogy judgment of 16/09/2004, T-342/02, 'MGM/M.G.M.' and order of 11/05/2006, T-194/05, 'TELETECH INTERNATIONAL/TELETECH ET AL').

5 The Different Grounds for Invalidation

5.1 Not a design

According to Article 25(1)(a) CDR, a Community design may be declared invalid if the design does not correspond to the definition under Article 3(a) CDR. This would be the case where the views of the Community design are inconsistent and represent different products, or where the graphical representation consists of mere representations of nature (landscapes, fruits, animals etc.) which are not products within the meaning of Article 3(1)(b) CDR.

5.2 Lack of entitlement

According to Article 25(1)(c) CDR, a Community design may be declared invalid if, by virtue of a court decision, the right holder is not entitled to the Community design under Article 14 CDR.

It is clear from the words ‘by virtue of a court decision’ in Article 25(1)(c) CDR that the Invalidation Division has no jurisdiction to determine who is entitled to a Community design under Article 14 CDR. Such jurisdiction belongs to any national court which is competent under Articles 27, 79(1) and (4) CDR in conjunction with Article 93 CDR. In the absence of a court decision the Invalidation Division cannot declare the contested Community design invalid under Article 25(1)(c) CDR (decision of 11/02/2008, R 64/2007-3 – ‘Loudspeaker’, para. 15).

Article 15(1) CDR, which deals with claims to become recognised as the legitimate holder of the Community design, is also irrelevant in relation to the ground of Article 25(1)(c) CDR.

Such a claim falls within the category of ‘actions relating to Community designs other than those referred to in Article 81 CDR’ and therefore lies within the jurisdiction of a national court under Article 93(1) CDR rather than within the competence of the Invalidation Division. This is confirmed by the wording of Article 27(3) CDR, which refers to such a claim being ‘brought before a court’.

5.3 Technical function

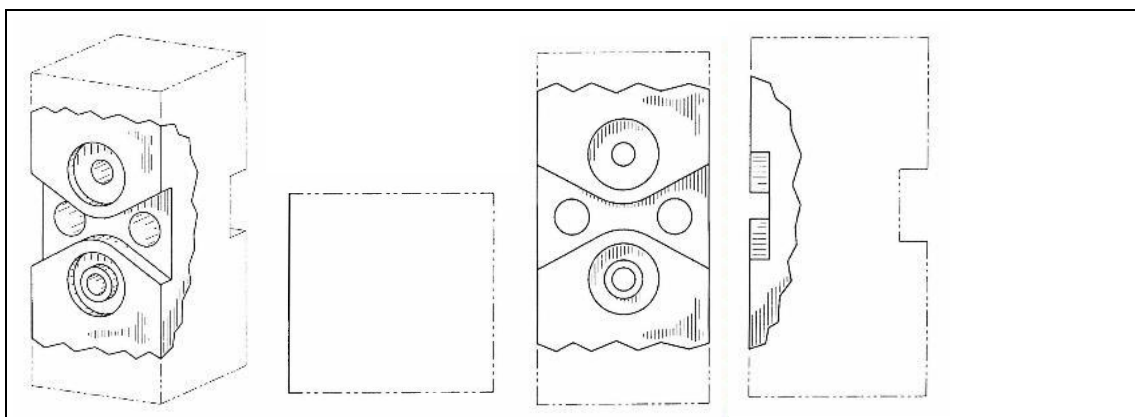
Article 8(1) CDR provides that ‘a Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function’.

5.3.1 Rationale

‘Article 8(1) CDR denies protection to those features of a product’s appearance that were chosen exclusively for the purpose of allowing a product to perform its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product’s visual appearance’, as was held by the 3rd Board of Appeal (decision of 22/10/2009, R 690/2007-3 – ‘Chaff cutters’, para. 35 et seq.).

The fact that a particular feature of a product’s appearance is denied protection by Article 8(1) CDR does not mean that the whole design must be declared invalid,

pursuant to Article 25(1)(b) CDR. The design as a whole will be invalid only if *all the essential features* of the appearance of the product in question were solely dictated by its technical function (decision of 29/04/2010, R 211/2008-3 – ‘Fluid distribution equipment’, para. 36).



Community design No 232996-0008 for ‘Fluid distribution equipment’ (3rd Board of Appeal, decision of 29/04/2010, R 211/2008-3)

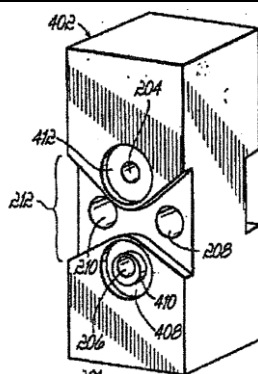


FIG. 4

Drawing taken from the earlier European patent application (EP 1 568 418 A2) in respect of a ‘method and system for supporting and/or aligning components of a liquid dispensing system’

5.3.2 Examination

In order to determine whether the essential features of the appearance of the product into which the contested Community design will be incorporated are solely dictated by the technical function of the product, it is first necessary to determine what the technical function of that product is. The relevant indication in the application for registration of the design (Article 36(2) CDR) should be taken into account, but also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function (see by analogy, judgment of 18/03/2010, T-9/07, ‘Representation of a circular promotional item’, para. 56).

Whether Article 8(1) CDR applies must be assessed objectively, not in the perception of the informed user who may have limited knowledge of technical matters.

The technical functionality of the features of a design may be assessed, inter alia, by taking account of the documents relating to patents describing the functional elements of the shape concerned.

Depending on the case, and in particular in view of its degree of difficulty, the Invalidation Division may appoint an expert (Article 65(3) CDR and Article 44 CDIR).

5.3.3 Alternative shapes

Article 8(1) CDR does not require that a given feature must be the only means by which the product's technical function can be achieved. Article 8(1) CDR applies where the need to achieve the product's technical function was the only relevant factor when the feature in question was selected (decision of 22/10/2009, R 690/2007-3 – 'Chaff cutters', para. 31-32).

The examination of Article 8(1) CDR must be carried out by analysing the Community design, and not designs consisting of other shapes.

5.4 Designs of interconnections

Features of a Community design are excluded from protection if they must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against another product so that either product may perform its function. If Article 8(2) CDR applies to all the essential features of the Community design, the latter must be declared invalid (decision of 20/11/2007, ICD 2970).

Proof that a Community design may be objected to based on Article 8(2) CDR rests on the applicant. The applicant must substantiate the existence of the product whose form and dimensions dictate those of the Community design and submit facts, evidence and arguments demonstrating the functions performed by this product and by this Community design individually and/or in combination.

As an exception, Article 8(2) CDR does not apply to a Community design which serves the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system (Article 8(3) CDR). Proof that the Community design serves such a purpose rests on the holder.

5.5 Lack of novelty and individual character

5.5.1 Disclosure of prior design

5.5.1.1 General principles

Challenging the validity of a Community design on account of its lack of novelty or of individual character requires proof that an earlier design which is identical or which produces a similar overall impression has been made available to the public before the date of filing the application for registration or, if a priority is claimed, the date of priority (Articles 5 and 6 CDR).

The public in question is made up of the members of the circles specialised in the sector concerned, operating within the European Union (Article 7(1) CDR).

For the purpose of Article 7 CDR, a 'design' means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours,

colours, shape, texture and/or materials of the product itself and/or its ornamentation (Article 3(a) CDR). Whether or not an earlier 'design' within the meaning of Article 3(a) CDR enjoys legal protection (as a design, as a trade mark, as a copyrighted work, as a utility model or otherwise) is immaterial.

It is assumed that a design which has been made available to the public anywhere in the world and at any point in time, as a result of publication following registration or otherwise, exhibition, use in trade or otherwise, has been disclosed for the purpose of applying Articles 5 and 6 CDR (Article 7(1) CDR).

However, acts of disclosure of an earlier design will not be taken into consideration where the holder submits convincing facts, evidence and arguments in support of the view that these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Union (Article 7(1) CDR; Article 63(1) CDR) (decision of 22/03/2012, R 1482/2009-3 – 'Insulation blocks', para. 38).

Other exceptions will be addressed at paragraphs 5.5.1.7 to 5.5.1.8 below.

5.5.1.2 Official publications

Publication of an earlier design in the bulletin of any industrial property office worldwide constitutes disclosure and it is only ('except') where this publication cannot reasonably become known to the professionals of the sector concerned within the European Union that the said rule is affected by an exception. Therefore, once proof of publication has been provided by the applicant, disclosure is assumed to have taken place and, considering the globalisation of the markets, it is incumbent on the holder to provide facts, arguments or evidence to the contrary, namely that publication of the earlier design could not reasonably have become known to the circles specialised in the sector concerned, operating within the European Union (decision of 27/10/2009, R 1267/2008-3 – 'Watches', para. 35 et seq; decision of 07/07/2008, R 1516/2007-3 – 'Cans', para. 9).

Publications in trademark and patent bulletins could equally have become known in the normal course of business to the circles in the sector concerned operating within the European Union. Therefore, where the appearance of a product has been applied for and published as a trademark, it is to be considered as a disclosure of a 'design' for the purpose of Article 7 CDR (judgment of 16/12/2010, T-513/09, 'Seated figure', para. 20). The same applies where the representations contained in a patent application show the appearance of an industrial or handicraft item (decision of 22/03/2010, R 417/2009-3 – 'Drinking straws', para. 21). However, the presence of a document kept by a patent and trade mark office, which is available to the public only by means of an application for inspection of files, cannot be considered to have become known in the normal course of business to the specialised circles in the sector concerned and therefore does not prove the disclosure a prior design in the meaning of Article 7 CDR (decision of 22/03/2012, R 1482/2009-3 – 'Insulation blocks', paras. 39, 43).

In order to substantiate the disclosure, a registration certificate must specify the date of publication independently of the date of filing or the date of registration. It is, however, enough that the date of publication can be identified by the mention of an INID code ('Internationally agreed Numbers for the Identification of (bibliographic) Data' as standardized by WIPO Standard ST.9. See decision of the Invalidation Division of 14/11/2006 (ICD 2061)).

5.5.1.3 Exhibitions and use in trade

Disclosure of a design at an international exhibition anywhere in the world is an event which may become known in the normal course of business to the circles in the sector concerned, operating within the European Union, except where evidence to the contrary is provided (decision of 26/03/2010, R 9/2008-3 – ‘Footwear’, para. 73-82; decision of 01/06/2012, R 1622/2010-3 – ‘Lamps’, para. 24).

Use in trade is another example given in Article 7(1) CDR as a means for disclosure of a design, irrespective of whether this use is made within or outside the EU (decision of 26/03/2010, R 9/2008-3 – ‘Footwear’, para. 63-71).

Disclosure of a design can be the result of use in trade even where there is no proof on file that the products in which the earlier design is incorporated have actually been put on the market in Europe. It suffices that the goods have been offered for sale in distributed catalogues (decision of 22/10/2007, R 1401/2006-3 – ‘Ornamentation’, para. 25) or imported from a third country to the European Union (judgment of 14/06/2011, T-68/10, ‘Watch attached to a lanyard’, para. 31-32) or have been the object of an act of purchase between two European operators (judgment of 09/03/2012, T-450/08, ‘Bottle’, para. 30-45).

It is enough that the disclosure took place at a point in time which can be identified with reasonable certainty prior to the filing date or priority date of the contested Community design even if the exact date of disclosure is unknown (judgment of 14/06/2011, T-68/10, ‘Watch attached to a lanyard’, para. 31-32).

5.5.1.4 Disclosures derived from the internet

As a matter of principle, disclosures derived from the internet form part of the prior art. Information disclosed on the internet or in online databases is considered to be publicly available as of the date the information was posted. Internet websites often contain highly relevant information. Certain information may even be available only on the internet from such websites. This includes, for example, online publications of design registrations by industrial property offices.

The nature of the internet can make it difficult to establish the actual date on which information was in fact made available to the public. For instance, not all web pages mention when they were published. In addition, websites are easily updated, yet most do not provide any archive of previously displayed material, nor do they display records which enable members of the public to establish precisely what was published and when.

In this context, the date of disclosure on the internet will be considered reliable in particular where:

- the web site provides timestamp information relating to the history of modifications applied to a file or web page (for example, as available for Wikipedia or as automatically appended to content, e.g. forum messages and blogs); or
- indexing dates are given to the web page by search engines (e.g. from the Google cache); or

- a screenshot of a webpage bears a given date; or
- information relating to the updates of a web page is available from an internet archiving service.

Neither restricting access to a limited circle of people (e.g. by password protection) nor requiring payment for access (analogous to purchasing a book or subscribing to a journal) prevent a web page from forming part of the state of the art. It is sufficient if the web page is available without any bar of confidentiality and the accessibility requirements can reasonably be met by the European professionals of the circles concerned.

5.5.1.5 Statements in writing, sworn or affirmed (affidavits)

As a matter of principle, affidavits in themselves are not sufficient to prove a fact such as the disclosure of an earlier design. They may, however, corroborate and/or clarify the accuracy of additional documents (decision of 14/10/2009, R 316/2008-3 – ‘Fireplaces’, para. 22. See by analogy judgment of 13/05/2009, T-183/08, ‘SCHUHPARK/SCHUHPARK’, para. 43).

In order to assess the evidential value of an affidavit, regard should be had first and foremost to the credibility of the account it contains. It is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on its face, the document appears sound and reliable (judgment of 09/03/2012, T-450/08, ‘Bottle’, para. 39-40).

Affidavits and other documentary evidence originating from parties having an interest in having the Community design being declared invalid have a lower probative value compared to documents having a neutral source (judgment of 14/06/2011, T-68/10, ‘Watch attached to a lanyard’, para. 33-36).

5.5.1.6 Insufficient disclosure

The issue of the disclosure of the prior design is preliminary to that of whether the two designs produce the same overall impression on the informed user. If the prior design has not been made available to the public or it has been made so but in a manner inconsistent with the requirements of Article 7(1) CDR, then there is sufficient reason for rejecting the application to the extent that it is based on Articles 5 and 6 CDR (decision of 10/03/2008, R 586/2007-3 – ‘Barbecues’, para. 22 et seq).

Since neither the CDR nor the CDIR provides for any specific form of evidence required for establishing disclosure, the evidence in support of disclosure is a matter for the discretion of the applicant. The Invalidity Division will carry out an overall assessment of such evidence by taking account of all the relevant factors in the particular case. Disclosure cannot be proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient disclosure of the earlier design (judgment of 09/03/2012, T-450/08, ‘Bottle’, para. 21-24).

A global examination of the items of evidence implies that these items must be assessed in the light of each other. Even if some items of evidence are not conclusive

of disclosure in themselves, they may contribute to establishing the disclosure when examined in combination with other items (judgment of 09/03/2012, T-450/08, 'Bottle', para. 25 and 30-45).

The Invalidity Division is not required to determine through assumptions and deductions which earlier designs among those represented in the applicant's documentary evidence may be relevant where the applicant does not provide further specifications in this respect (see paragraph 3.1.9.2 above). Earlier designs other than those specifically cited as relevant prior art by the applicant will therefore be disregarded (decision of 04/10/2006 (ICD 2228)).

Where the representation of the prior design fails to adequately represent it, thereby rendering any comparison with the contested design impossible, this does not amount to disclosure for the purpose of Article 7(1) CDR (decision of 10/03/2008, 'Barbecues', R 586/2007-3, para. 22 et seq).

5.5.1.7 Disclosure to a third person under explicit or implicit conditions of confidentiality

Disclosure of the Community design to a third person under explicit or implicit conditions of confidentiality shall not be deemed to have been made available to the public (Article 7(1) CDR).

Therefore, disclosure of a design to a third party in the context of commercial negotiations is ineffective if the parties concerned agreed that the information exchanged should remain secret (decision of 20/06/05 (ICD 172) para. 22).

5.5.1.8 Disclosure within the priority period

An application for a Community design may claim the priority of one or more previous applications for the same design or utility model in or for any State party to the Paris Convention, or to the Agreement establishing the World Trade Organisation (Article 41 CDR; Article 8 CDR). The right of priority is six months from the date of filing of the first application.

The effect of the right of priority shall be that the date of priority will count as the date of filing of the application for a registered Community design for the purpose of Articles 5, 6, 7, 22, 25(1)(d) and 50(1) CDR (Article 43 CDR).

A priority claim relating to the 'same design or utility model' requires identity with the corresponding Community design without addition or suppression of features. A priority claim is however valid if the Community design and the previous application differ only in immaterial details.

When examining an application for a Community design, the Office does not verify whether this application concerns the 'same design or utility model' whose priority is claimed.

The examination of a priority claim will, however, be carried out by the Office if the applicant challenges its validity or if the holder challenges the effects of the disclosure of a design, for the purpose of Articles 5, 6 and 7 CDR, where this disclosure occurred within the priority period.

Where the validity of the priority claim is determinative of the outcome of the application, the Office may either take position on the validity of this claim in the decision on the merits of the case, or stay the proceedings on its own motion to allow the holder to remedy possible deficiencies within a given time limit (Article 45(2)(d) CDR; Article 1(1)(f), 10(3)(c)(7) and (8) CDR).

The invalidity proceedings are resumed once the deficiencies are remedied or a final decision is taken on the loss of the right of priority (Article 46(1)(4) CDR) (see paragraph 4.1.6.2 above for the resumption of the proceedings).

5.5.1.9 Grace period

Article 7(2) CDR provides for a 'grace period' of 12 months preceding the date of filing or the priority date of the contested Community design. Disclosure of the Community design within such period will not be taken into consideration if it was made by the designer or its successor in title.

As a matter of principle, the holder must establish that it is either the creator of the design upon which the application is based or the successor in title to that creator, failing which Article 7(2) CDR cannot apply (judgment of 14/06/2011, T-68/10, 'Watch attached to a lanyard', para. 26-29).

However, acts of disclosure made by a third person as a result of information provided or action taken by the designer or its successor in title are also covered by Article 7(2) CDR. This can be so where a third party made public a design copied from a design which was previously disclosed within the grace period by the holder itself (decision of 02/05/2011, R 658/2010-3 – 'Lighting devices', para. 37-39).

The exception provided at Article 7(2) CDR may apply even where the previously disclosed design is not strictly *identical* to the contested Community design, within the meaning of Article 5 CDR. This is so because the Article 7(2) CDR also provides for immunity against the loss of *individual character* pursuant to Article 6 CDR (decision of 02/05/2011, R 658/2010-3 – 'Lighting devices', para. 40).

The 'grace period' also applies where the disclosure of a design is the result of an abuse in relation to the designer or its successor in title (Article 7(3) CDR). Whether the disclosure is the result of fraudulent or dishonest behaviour will be assessed on a case-by-case basis on the basis of the facts, arguments and evidence submitted by the parties (decision of 25/07/2009, R 0552/2008-3 – 'MP3 player recorder', para. 24 to 27).

5.5.2 Assessment of novelty and individual character

A design will be protected as a Community design to the extent that it is new and has individual character (Article 4(1), 5 and 6 CDR). The novelty and individual character of a Community design must be examined on its date of filing or, as the case may be, on its date of priority, in the light of the relevant prior art. The relevant prior art is made up of the earlier designs whose disclosure, according to Article 7 CDR, was substantiated by the applicant (Article 63 CDR).

5.5.2.1 Common principles

Global comparison

The Community design must be compared with each and every earlier design relied on by the applicant, individually. Novelty and individual character of a Community design cannot be defeated by combining earlier designs or parts of earlier designs (judgment of 22/06/2010, T-153/08, 'Communication equipment', para. 23-24).

A combination of already disclosed features is, therefore, eligible to protection as a Community design provided this combination, as a whole, is novel and has individual character.

As a matter of principle, all the features of a Community design must be taken into consideration when examining its novelty and individual character. There are, however, a number of exceptions to this general principle.

Features dictated by a function and features of interconnection

Features which are solely dictated by a technical function and features which must necessarily be reproduced in their exact form and dimensions in order to allow interconnection with another product cannot contribute to the novelty and individual character of a Community design. Such features must therefore be disregarded when comparing the Community design with the relevant prior art (Article 8 CDR, see paragraph 5.3.1 above).

The visibility requirement

Features of a Community design applied to, or incorporated in a 'component part of a complex product', will be disregarded if they are invisible during normal use of the complex product in question (Article 4(2) CDR).

'Complex product' means a product which is composed of multiple components which can be replaced, permitting disassembly and re-assembly of the product (Article 3(c) CDR). For instance, the visibility requirement does not apply to a Community design representing the appearance of a garbage container as a whole since garbage containers may be complex products as such, but not component parts of complex products (decision of 23/06/2008 (ICD 4919)).

'Normal use' means use by the end user, excluding maintenance, servicing or repair work (Article 4(3) CDR). 'Normal use' is the use made in accordance with the purpose for which the complex product is intended.

For instance, for safety reasons, an electrical connector is a component part which is normally incorporated in a casing in order to be shielded from any contact with potential users when a complex product, such as a train or electric vehicle, is in operation. The fact that such a component part of a complex product can theoretically be made visible when inserted in a transparent casing or cover constitutes a purely hypothetical and random criterion which must be disregarded (decision of 03/08/2009, R 1052/2008-3 – 'Electrical contactors', paras 42-53).

Where none of the features of a Community design applied to a component part (e.g. a sealing ring) is visible during normal use of the complex product (e.g. a heat pump system), this Community design will be invalidated as a whole (decision of 10/03/2008 (ICD 4380)).

However, Article 4(2) CDR does not require a component part to be clearly visible in its entirety at every moment of the use of the complex product. It is sufficient if the whole of the component can be seen some of the time in such a way that all its essential features can be apprehended (decision of 22/10/2009, R 0690/2007-3 – ‘Chaff cutters’, para. 21).

Where the features of a Community design applied to a component part (e.g. an internal combustion engine) are only partially visible during normal use of the complex product (e.g. a lawnmower), the comparison with the relevant prior art must be limited to the visible parts. ‘During the normal use of a lawnmower, it is placed on the ground and the user stands behind the lawnmower. Thus, the user, standing behind the lawnmower sees the engine from the top and therefore sees principally the upper side of the engine. It follows that the upper side of the engine determines the overall impression produced by the engine’ (judgment of 09/09/2011, T-10/08, ‘Engine’, para. 20-22).

Clearly discernible features

Features of the Community design which are not clearly discernible in its graphical representation cannot contribute to its novelty or its individual character (Directive 98/71/EC of the European Parliament and the Council of 13 October 1998 on the legal protection of designs, Recital 11). Likewise, features of the prior design which are not of a sufficient quality allowing all the details to be discerned in the representation of the prior design cannot be taken in consideration for the purpose of Articles 5 and 6 CDR (decision of 10/03/2008, R 586/2007-3, ‘Barbecues’, para. 23-26).

Features of a prior design can be supplemented by additional features which were made available to the public in different ways, for instance, first, by the publication of a registration and, second, by the presentation to the public of a product incorporating the registered design in catalogues. These representations must however relate to one and the same earlier design (judgment of 22/06/2010, T-153/08, ‘Communication equipment’, para. 25-30).

Disclaimed features

Features of a Community design which are disclaimed are disregarded for the purposes of comparing the designs. This applies to the features of a Community design represented with dotted lines, boundaries or colouring or in any other manner making clear that protection is not sought in respect of such features (judgment of 14/06/2011, T-68/10, ‘Watch attached to a lanyard’, para. 59-64).

In contrast, disclaimed features of an earlier registered design are taken into account when assessing the novelty and individual character of a contested Community design. In the context of Articles 5 and 6 CDR, it is immaterial whether the holder of the earlier registered design can claim protection in respect of such disclaimed features, provided they have been disclosed together with the earlier design as a whole.

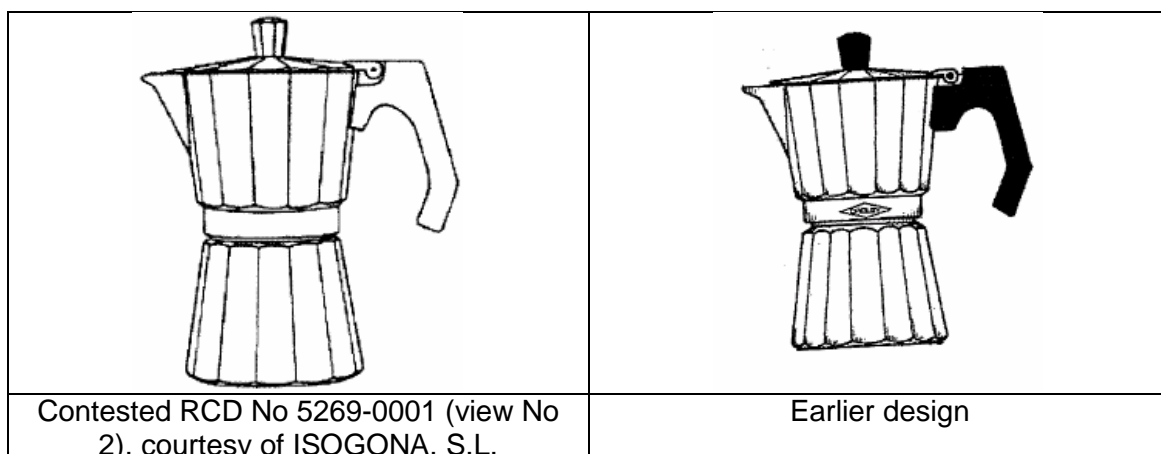
5.5.2.2 Novelty

A Community design will be considered to be new if it is not predated by an identical design disclosed pursuant to Article 7 CDR. Designs shall be deemed to be identical if their features differ only in immaterial details (Article 5(2) CDR).

There is identity between the Community design and an earlier design where the latter discloses each and every element constituting the former. The framework of the comparison is limited to the features making up the Community design. It is therefore irrelevant whether the earlier design discloses additional features. A Community design cannot be new if it is included in a more complex earlier design (decision of 25/10/11, R 978/2010-3 – ‘Part of a sanitary napkin’, para. 20-21).

However, the additional or differentiating features of the Community design may be relevant to decide whether this Community design is new, unless such elements are so insignificant that they may pass unnoticed.

An example of an immaterial detail is a slight variation in the shade of the colour pattern of the compared designs (decision of 28/07/09, R 0921/2008-3 – ‘Nail files’, para. 25). Another illustration is the display, in one of the two compared designs, of a label which is so small in size that it is not perceived as a relevant feature (decision of 08/11/2006, R 0216/2005-3 – ‘Cafetera’, para. 23-26), as in the following example:



5.5.2.3 Individual character

A design will be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing the application for registration or, if a priority is claimed, the date of priority (Article 6(1) CDR).

In assessing individual character, the degree of freedom of the designer in developing the design will be taken into consideration (Article 6(2) CDR).

The informed user

The concept of 'informed user' lies somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge, and the sectorial expert, who is an expert with detailed technical expertise. Without being a designer or a technical expert, informed users are aware of the various designs which exist in the sector concerned, they possess a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of their interest in the products concerned, they show a relatively high degree of attention when they use them (judgment of 20/10/2011, C-281/10 P, 'Representation of a circular promotional item', para. 53 and 59).

The informed user is neither a designer nor a technical expert. Therefore, an informed user is a person having some awareness of the existing designs in the sector concerned, without necessarily knowing which aspects of that product are dictated by technical function (judgment of 22/06/2010, T-153/08, 'Communication equipment', para. 47-48).

The informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated (judgment of 09/09/2011, T-10/08, 'Engine', para. 25-27).

However, depending on the nature of the product in which the Community design is incorporated (e.g. promotional items), the concept of informed user may include, firstly, a professional who acquires such products in order to distribute them to the final users and, secondly, those final users themselves (judgment of 20/10/2011, C-281/10 P, 'Representation of a circular promotional item', para. 54). The fact that one of the two groups of informed users perceives the designs at issue as producing the same overall impression is sufficient for a finding that the contested design lacks individual character (judgment of 14/06/2011, T-68/10, 'Watch attached to a lanyard', para. 56).

When the nature of the product in which the compared designs makes it possible, the overall impression left by these designs will be assessed on the assumption that the informed user can make a direct comparison between them (judgment of 18/10/2012, joint cases C-101/11P and C-102/11P, 'Lutins', paras. 54 and 55).

The overall impression

Unless the compared designs include functional or invisible or disclaimed features (see paragraph 5.5.2.1 above), the two designs must be compared globally. That does not mean, however, that the same weight should be given to all the features of the compared designs.

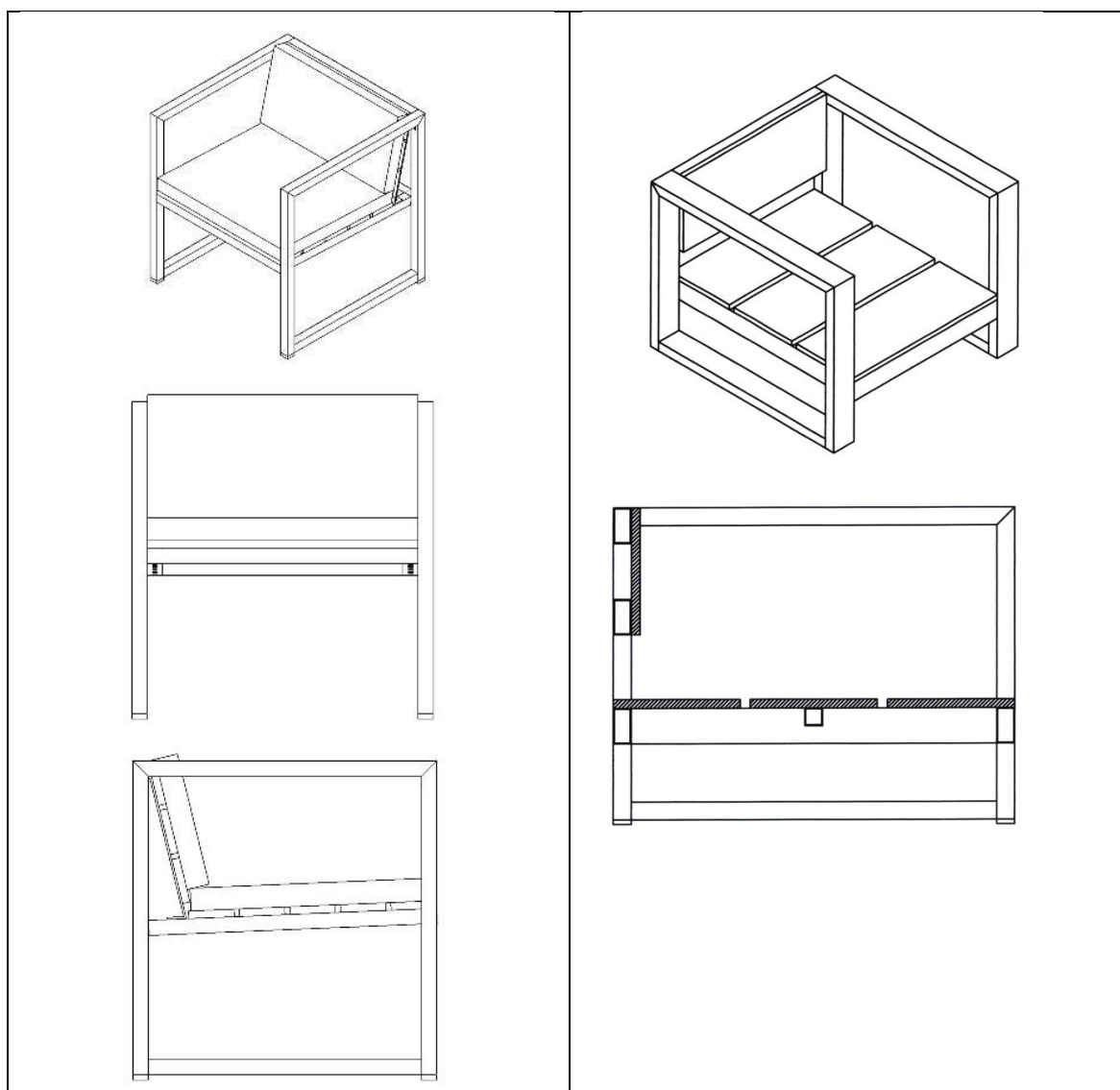
First, the informed user uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended. The relative weight to give to the features of the compared designs may therefore depend on how that product is used. In particular, the role played by some features may be less important depending on their reduced visibility when the product is in use (judgment of 22/06/2010, T-153/08, 'Communication equipment', para. 64-66 and 72).

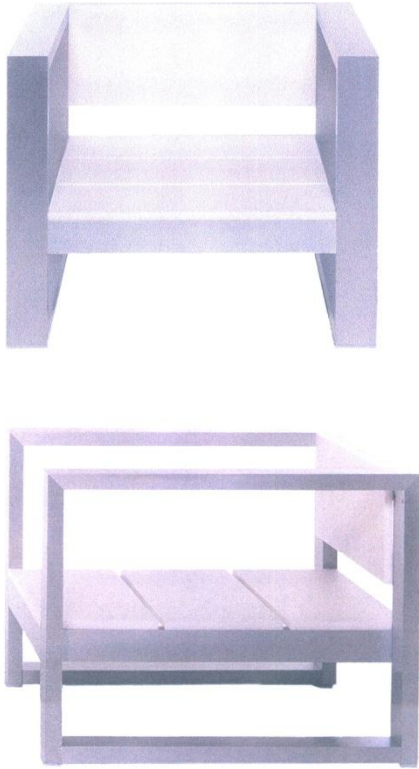
Second, when appraising the overall impression caused by two designs, the informed user will only give minor importance to features that are totally banal and common to the type of product in issue and will concentrate on features that are arbitrary or

different from the norm (judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', para. 77; decision of 28/11/06, R 1310/2005-3 – 'Galletas', para. 13; decision of 30/07/2009, R 1734/2008-3 – 'Forks', para. 26 et seq).

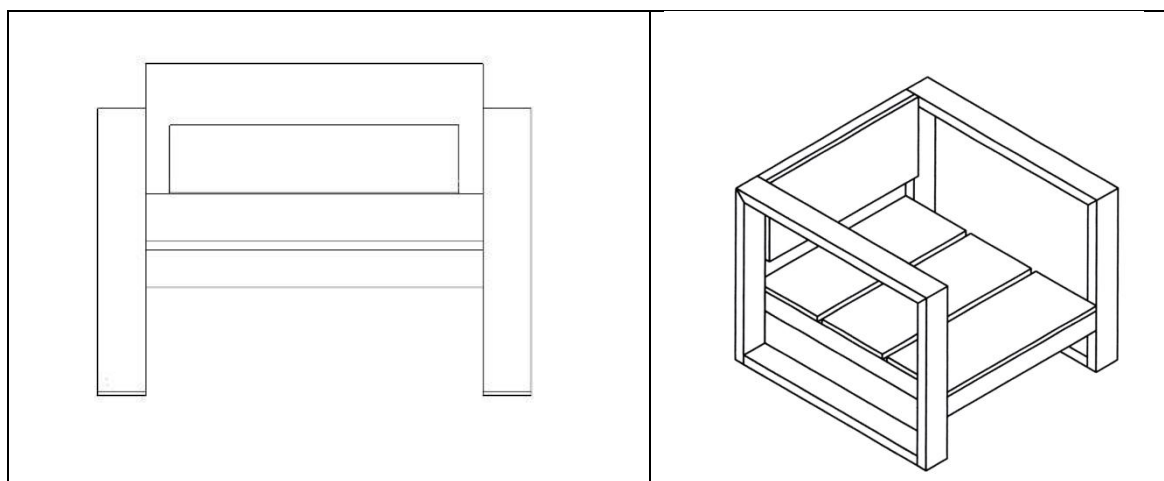
Third, similarities affecting features in respect of which the designer enjoyed a limited degree of freedom will have only minor importance in the overall impression produced by those designs on the informed user (judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', para. 72).

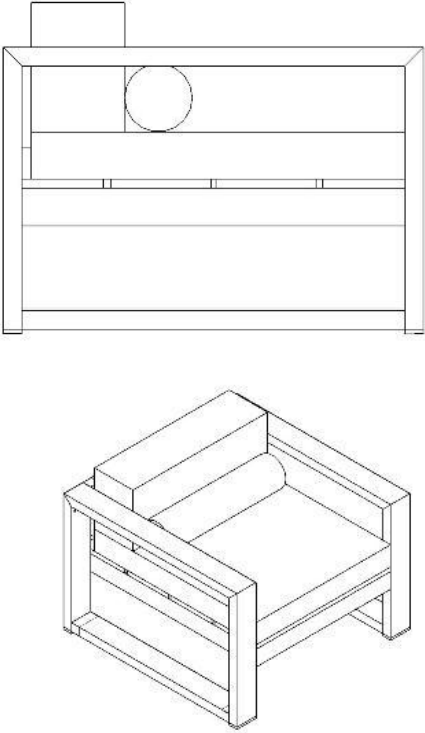
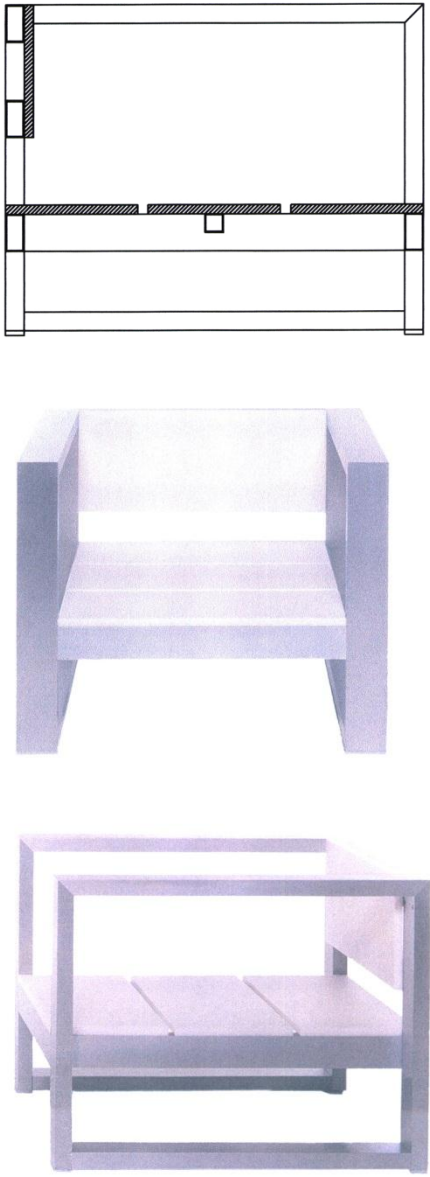
As illustration, it was held that the RCD No 1512633-0001 created an overall impression which is different from that produced by the earlier design (RCD No 52113-0001). In an area in which the designer's degree of freedom in developing his design is not limited by any technical or legal restraints, the Board of Appeal found that the differentiating features of the two below designs prevailed over their common points. In particular, the fact that the armchair of the prior design has a rectangular rather than square shape, that its seat is placed lower and that the arms are broader, was considered decisive in support of the conclusion that the contested RCD had individual character (decision of 25/05/12, R 970/2011-3 – 'Armchairs', para. 28):



	
<p>Contested RCD No 1512633-0001, courtesy of Sachi Premium – Outdoor Furniture, Lda.</p>	<p>Earlier RCD No 52113-0001, courtesy of Mr Esteve Cambra (Designer: Mr Jose Ramón Esteve Cambra)</p>

By contrast, the Board of Appeal found that the RCD No 1512633-0003 lacked individual character in respect of the same earlier design. It was held that the differentiating features between the designs, including the presence in the contested RCD of three cushions, were outweighed by their common characteristics (the rectangular shape, the flat back and seat, the seats are positioned below the mid-section of the armchairs' structure etc.) (decision of 27/04/12, R 969/2011-3 – 'Armchairs', para. 29-30)



	
<p>Contested RCD No 1512633-0003, courtesy of Sachi Premium – Outdoor Furniture, Lda.</p>	<p>Earlier RCD No 52113-0001, courtesy of Mr Esteve Cambra (Designer: Mr Jose Ramón Esteve Cambra)</p>

The degree of freedom of the designer

The designer's degree of freedom depends on the nature and intended purpose of the product in which the design will be incorporated, as well as on the industrial sector to which this product belongs. The Invalidity Division will take into account the indication of the products in which the design is intended to be incorporated or to which it is intended to be applied (Article 36(2) CDR), but also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function (judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', para. 56).

The designer's degree of freedom in developing its design is established, *inter alia*, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned. The more the designer's freedom in developing the Community design is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user (judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', para. 67 and 72; Judgment of 09/09/2011, T-10/08, 'Engine', para. 33).

The fact that the intended purpose of a given product requires the presence of certain features may not imply a restricted degree of freedom of the designer where the parties submit evidence that there are possibilities of variations in the positioning of such features and in the general appearance of the product itself (judgment of 14/06/2011, T-68/10, 'Watch attached to a lanyard', para. 69; judgment of 06/10/2011, T-246/10, 'BRAKE', para. 21-22; judgment of 09/09/2011, T-10/08, 'Engine', para. 37).

The degree of freedom of the design is not affected by the fact that similar designs co-exist on the market and form a 'general trend' or co-exist on the registers of Industrial Property Offices (judgment of 22/06/2010, T-153/08, 'Communications Equipment', para. 58; decision of 01/06/2012, R 0089/2011-3 – 'Corkscrews', para. 27).

5.6 Conflict with a prior design right

Pursuant to Article 25(1)(d) CDR, a Community design will be declared invalid if it is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date:

1. by a registered Community design or an application for such a design; or
2. by a registered design right of a Member State or by an application for such a right; or
3. by a design right registered under the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 02/07/1999, hereinafter referred to as 'the Geneva Act', which was approved by Council Decision 954/2006 and which has effect in the Community, or by an application for such a right.

Article 25(1)(d) CDR must be interpreted as meaning that a Community design is in conflict with a prior design when, taking into consideration the freedom of the designer in developing the Community design, that design does not produce on the informed user a different overall impression from that produced by the prior design relied on (judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', para. 52).

When dealing with an application based on Article 25(1)(d) CDR, the Invalidity Division will therefore apply the same test as for the assessment of individual character under Article 25(1)(b) read in combination with Article 6 CDR.

The Invalidation Division will assume that the prior design is valid unless the holder submits proof that a decision that has become final declared the prior design invalid before the adoption of the decision (see by analogy, judgment of 29/03/2011, C-96/09P, 'BUD / bud', para. 94-95) (see above under paragraph 4.1.6.2 Suspension).

5.7 Use of an earlier distinctive sign

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

5.7.1 Distinctive sign

The notion of 'distinctive sign' encompasses registered trade marks as well as all signs which could be relied on in the context of Article 8(4) CTMR (see The Manual, Part C, Opposition, Section 4, 'Article 8(4) CTMR', paragraph 3.1 Types of rights falling under Article 8(4) CTMR).

5.7.2 Use in a subsequent design

The notion of 'use in a subsequent design' does not necessarily presuppose a full and detailed reproduction of the earlier distinctive sign in a subsequent Community design. Even though the Community design may lack certain features of the earlier distinctive sign or may have different additional features, this may constitute 'use' of that sign, particularly where the omitted or added features are of secondary importance and are unlikely to be noticed by the relevant public. It is enough that the Community design and the earlier distinctive sign be similar (judgment of 12/05/2010, T-148/08, 'Instrument for writing', para. 50-52; decision of 09/08/11, R 1838/2010-3 – 'Instrument for writing', para. 43).

Where a Community design includes a distinctive sign without any disclaimer making clear that protection is not sought in respect of such feature, it will be considered that the Community design makes use of the earlier distinctive sign even if the latter is represented in only one of the views (decision of 18/09/07, R 137/2007-3 – 'Containers', para. 20).

5.7.3 Substantiation of the application under Article 25(1)(e) CDR (earlier distinctive signs)

Apart from the elements required under Article 28 CDR for admissibility purposes (see paragraph 3.9.2 above), an application must contain:

- particulars establishing the content of the law of the national law of which the applicant is seeking application including, where necessary, court decisions and/or academic writings (the principles established in The Manual, Part C, Opposition, Section 4, 'Article 8(4) CTMR', paragraph 4 Evidence and Standard of Proof will apply). Where an application for invalidity is based on the rights held on an earlier Community trade mark, the submission of the law and case-law relating to

Community trade marks is not a requirement for the substantiation of this earlier right; and

- where the earlier distinctive sign is unregistered, particulars showing that rights have been acquired on this unregistered distinctive sign pursuant to the law relied on, as a result of use or otherwise, before the filing date or the priority date of the Community design (see, by analogy, judgment of 18/01/12, T-304/09, 'BASMALI' para. 22); and
- particulars showing that the applicant satisfies the necessary conditions, in accordance with that law, in order to be able to have the use of a Community design prohibited by virtue of its earlier right (see by analogy, judgment of 05/07/11, C-263/09 P, 'ELIO FIORUCCI', para. 50).

The applicant must establish only that it has available a right to prohibit use of the subsequent Community design and that it cannot be required to establish that that right has been used, in other words that the applicant has actually been able to prohibit such use (see by analogy, judgment of 05/07/11, C-263/09 P, 'ELIO FIORUCCI' para. 191).

5.7.4 Examination by the Invalidation Division

Where the national provision relied on by the applicant represents the transposition of a corresponding provision of Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks (codified version), the former will be interpreted in the light of the case-law relating to the interpretation of the latter (judgment of 12/05/2010, T-148/08, 'Instrument for writing', para. 96).

Furthermore, where the national provision relied on represents the transposition of Article 5(1) and (2) of Directive 2008/95/EC, the Invalidation Division will apply the principles established in The Guidelines, Part C, Opposition, Sections 2 and 5, since Article 5(1) and (2) of Directive 2008/95/EC is identical in substance to Article 8(1) and (5) CTMR.

For the purpose of applying these provisions, the Invalidation Division will assume that the contested Community design will be perceived by the relevant public as a sign capable of being used 'for' or 'in relation to' goods or services (judgment of 12/05/2010, T-148/08, 'Instrument for writing', para. 107; decision of 09/08/11, R 1838/2010-3 – 'Instrument for writing', para. 46; decision of 26/10/11, R 2179/2010-3 – 'Cleaning device', para. 18).

The Invalidation Division will also assume that the earlier distinctive sign is valid unless the holder submits proof that a decision that has become final declared this earlier distinctive sign invalid before the adoption of the decision (see by analogy, judgment of 29/03/2011, C-96/09P, 'BUD / bud', para. 94-95) (see above under paragraph 4.1.6.2 Suspension).

As distinctive signs are protected in respect of certain goods or services, the Invalidation Division will examine in respect of which goods the contested Community design is intended to be used (judgment of 12/05/2010, T-148/08, 'Instrument for writing', para. 108). For the purpose of determining whether these goods and services are identical or similar, the Invalidation Division will take into account the indication of the products in which the design is intended to be incorporated or to which it is intended to be applied (Article 36(2) CDR), and also, where necessary, the design itself, in so far

as it makes clear the nature of the product, its intended purpose or its function (judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', para. 56; decision of 07/11/11, R 1148/2010-3 – 'Packaging', para. 34-37). The assessment of the similarity of the goods will be made on the basis of the principles defined in The Guidelines, Part C, Opposition, Section 2, Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services).

Where the Community design is intended to be incorporated in two-dimensional 'logos', the Invalidation Division will consider that such logos may be applied to an infinite range of products and services, including the products and services in respect of which the earlier distinctive sign is protected (decision of 03/05/07, R 609/2006-3 – 'logo MIDAS', para. 27).

5.8 Unauthorised use of a work protected under the copyright law of a Member State

A Community design will be declared invalid if it constitutes an unauthorised use of a work protected under the copyright law of a Member State.

5.8.1 Substantiation of the application under Article 25(1)(f) CDR (earlier copyright)

Apart from the elements required under Article 28 CDIR for admissibility purposes (see paragraph 3.9.2 above), an application must contain:

- particulars establishing the content of the national law of which the applicant is seeking application including, where necessary, court decisions and/or academic writings (see, by analogy, judgment of 05/07/2011, C-263/09 P, 'ELIO FIORUCCI', para. 50; decision of 11/02/08, R 64/2007-3 – 'Loudspeakers', para. 20); and
- particulars showing that rights have been acquired on the work pursuant to the copyright law relied on, to the benefit of the author or its successors in title, before the filing date or the priority date of the Community design (see, by analogy, judgment of 18/01/12, T-304/09, 'BASMALI', para. 22); and
- particulars showing that the applicant satisfies the necessary conditions, in accordance with that law, in order to be able to have the Community design invalidated or its use prohibited by virtue of its earlier right.

5.8.2 Examination by the Invalidation Division

Given that copyright protection may not, according to the national law relied on, depend on the publication or disclosure of the work, the Invalidation Division will only declare a Community design invalid under Article 25(1)(f) CDR in the clearest of cases.

In particular, it would not be appropriate to use Article 25(1)(f) CDR when the applicant's essential argument is that the Community design was created, not by the registered holder, but by the applicant or by an employee of the applicant (decision of 11/02/08, R 64/2007-3 – 'Loudspeakers', para. 20). Article 25(1)(f) CDR cannot be

used as a means to circumvent the exclusive competence of national courts regarding the entitlement to the Community design (Article 15 and 25(1)(c) CDR).

5.9 Partial invalidity

According to Article 25(6) CDR, a registered Community design which has been declared invalid pursuant to any of the grounds under Article 25(1)(b), (e), (f) or (g) CDR may be maintained in an amended form, if in that form it complies with the requirements for protection and the identity of the design is retained.

The request for maintenance in an amended form of a registered Community design must be made by the holder before the end of the written procedure. The request must include the amended form. The proposed amended form may consist of an amended representation of the Community design from which some features are removed or making clear by means inter alia of dotted lines or colouring that protection is not sought in respect of such features. The amended representation may include a partial disclaimer not exceeding 100 words (Article 25(6) CDR; Article 18(2) CDR).

The applicant will be given an opportunity to comment on whether the Community design in its amended form complies with the requirements for protection and whether the identity of the design is retained (see paragraph 4.1.4.1 above).

The identity of the Community design must be retained. Maintenance in an amended form will therefore be limited to cases in which the features removed or disclaimed do not contribute to the novelty or individual character of a Community design, in particular:

- where the Community design is incorporated in a product which constitutes a component part of a complex product and the removed or disclaimed features are invisible during normal use of this complex product (Article 4(2) CDR); or
- where the removed or disclaimed features are dictated by a function or by interconnection purposes (Article 8(1) and (2) CDR); or
- where the removed or disclaimed features are so insignificant in view of their size or importance that they are likely to pass unnoticed in the perception of the informed user.

The decision to maintain the Community design in an amended form will be included in the decision on the merits terminating the invalidity proceedings.

5.10 Grounds of invalidity which become applicable merely because of the accession of a new Member State

See The Manual, Examination of Applications for Registered Community Designs, paragraph XII.4.

6 Termination of the Proceedings

6.1 Termination of proceedings without decision on the merits

The invalidity proceedings are terminated without a decision on the merits, where:

1. the applicant withdraws its application as a result of amicable settlement or otherwise; or
2. the holder surrenders the Community design in its entirety and the applicant did not request the Office to adopt a decision on the merits of the case (Article 24(2) CDR; see paragraph 3.8); or
3. the contested Community design has lapsed and the applicant did not request the Office to adopt a decision on the merits of the case (Article 24(2) CDR; see paragraph 3.8); or
4. the Invalidity Division suspended a number of applications for a declaration of invalidity, relating to the same registered Community design. These applications shall be deemed to be disposed of once a decision declaring the invalidity of the Community design has become final (Article 32(3) CDIR).

The Invalidity Division informs the parties that the proceedings are terminated without decision on the merits.

6.2 Decision on costs

6.2.1 Cases where a decision on costs must be taken

If a decision on the merits of the case is taken, the decision on apportionment of costs is given at the end of the decision (Article 79(1) CDIR).

In all other cases where the Invalidity Division closes the case without a decision on the merits, a separate decision on costs is issued on request of any of the parties. In such a case, the Invalidity Division informs both parties when it will render a decision on costs. The parties may submit arguments on the apportionment of the costs.

6.2.2 Cases where a decision on costs is not to be taken

6.2.2.1 Agreement on costs

Whenever the parties inform the Invalidity Division that they have settled the invalidity proceedings with an agreement that includes the costs, the Invalidity Division will not issue a decision on costs (Article 70(5) CDR).

If no indication is given as to whether the parties have agreed on the costs, the Invalidity Division will take a decision on costs, together with the confirmation of the withdrawal of the application. If the parties inform the Invalidity Division that they had reached an agreement on costs after the withdrawal of the application, the already issued decision on costs will not be revised by the Invalidity Division. It is, however, left

to the parties to respect the agreement and not to enforce the Invalidation Division's decision on costs.

6.2.2.2 Apportionment of costs

The general rule is that the losing party, or the party who terminates the proceedings by surrendering the Community design or by maintaining it in an amended form or by withdrawing the application, shall bear the fees incurred by the other party as well as all costs incurred by it essential to the proceedings (Article 70(1) and (3) CDR).

If both parties lose in part, a 'different apportionment' has to be decided (Article 70(2) CDR). As a general rule, it is equitable that each party bears its own costs.

Where a number of applications for a declaration of invalidity, relating to the same registered Community design, have been suspended, they are deemed to be disposed of once a decision declaring the invalidity of the Community design has become final. Each applicant whose application is deemed to have been disposed of will bear its own costs (Article 70(4) CDR). In addition, the Office will refund 50% of the invalidity fee (Article 32(4) CDIR).

6.2.2.3 Fixing of costs

Recoverable costs regarding representation and fees

Where the costs are limited to representation costs and the application fee, the decision fixing the amount of costs will be included in the decision on the apportionment of the costs.

The amount to which the winning party is entitled to claim is mentioned at Article 70(1) CDR and Article 79(6) and (7) CDIR.

As regards fees, the recoverable amount is limited to the invalidity fee of EUR 350 if the applicant wins.

As regards representation costs, the recoverable amount is limited to EUR 400. This applies both to the applicant and the holder, under the condition that it was represented in the invalidity proceedings by a professional representative within the meaning of Article 77 CDR. The winning party who is no longer represented by a professional representative at the time of taking a decision is also entitled to an award of costs regardless of the stage of the proceedings when professional representation ceased. This is without prejudice to the need to appoint a professional representative where it is mandatory. The amount to be borne by the losing party is always fixed in Euro, regardless of the currency in which the winning party had to pay its representative.

Representation costs for employees, even from another company with economic connections, are not recoverable.

Other recoverable costs

Where the costs include expenses in relation to an oral hearing or the taking of evidence, the registry of the Invalidation Division will, on request, fix the amount of the

costs to be paid (Article 70(6) CDR). A bill of costs, with supporting evidence, shall be attached to the request for the fixing of costs (Article 79(3) CDIR).

The amount of recoverable costs may be reviewed by a decision of the Invalidation Division on a reasoned request filed within one month of the date of notification of the awarding of costs (Article 70(6) CDR; Article 79(4) CDIR).

Fixing of costs after remittance of the case to the Invalidation Division for further prosecution

When the invalidation decision has been annulled, wholly or partly, and the case is remitted by the Boards of Appeal, the situation will be as follows:

- the first decision (which was appealed) has not become final, even not as regards apportionment or fixing of costs;
- as regards the costs of the invalidation proceedings, one single decision on the apportionment and on the fixing of costs must be taken for the invalidation procedure as a whole;
- as regards the costs of the appeal procedure, it has to be ascertained whether the Boards adjudicated on them. The notion of 'winning party' has to be applied to the outcome of the appeal proceedings with the result that the decision can be different for the two instances. The amount of reimbursable representation costs for the appeal procedure is EUR 500, which apply in addition to the representation costs for the invalidation proceedings.

6.3 Correction of mistakes and entry in the register

In decisions of the Invalidation Division, only linguistic errors, errors of transcription and obvious mistakes may be corrected. They will be corrected by the Invalidation Division, acting of its own motion or at the request of an interested party (Article 39 CDIR).

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6.3.2 Entry into the register

The date and content of the decision on the application or any other termination of proceedings will be entered into the Register once it is final (Article 53(3) CDR, Article 69(3)(q) CDIR).

7 Appeal

7.1 Right to appeal

Any party to invalidity proceedings has the right to appeal against a decision which affects this party adversely. A decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal. Any written communication of such a decision will include a notice that the decision may be appealed within two months from the date of receipt of the notification of the decision. Appeals have suspensive effect (Article 55 CDR).

7.2 Revision

Revision can be granted where an appeal has been lodged against a decision for which the Boards of Appeal are competent pursuant to Article 55 CDR.

If the division or instance of the Office whose decision is appealed considers the appeal to be admissible and well founded, it shall rectify its decision. This shall not apply where the appellant is opposed by other parties to the proceedings (Article 58(1) CDR).

If the decision is not rectified within one month after receipt of the statement of grounds of the appeal, the appeal will be remitted to the Boards of Appeal without delay, and without comment as to its merits (Article 58(2) CDR).

The purpose of revision is to avoid that the Boards of Appeal are seized with appeals against decisions with regard to which the need of rectification has been recognised by the Invalidation Division. However, the purpose of revision is not to remove mistakes in decisions of the Invalidation Division without changing the outcome of a case, but to grant the appellant the relief it seeks.

The principles applying to revision in respect of decisions adopted by the Opposition Division apply *mutatis mutandis* to the decisions adopted by the Invalidation Division (see The Manual, Part A, General Rules, Section 7, Revision).