

GUIDELINES FOR THE PROCEEDINGS RELATING TO A DECLARATION OF INVALIDITY OF A REGISTERED COMMUNITY DESIGN

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1) INTRODUCTION.

1.1. Purposes of the Guidelines

The purpose of the Invalidity Guidelines is to explain how, in practice, the requirements of the Regulation on the Community Design¹ (CDR), the Implementing Regulation² (CDIR) and the Fees Regulation³ (CDFR) will be applied by the Office in the examination of an application for a declaration of invalidity of a registered Community design. The Guidelines assist the members of the Invalidity Division to consistently apply the Regulations to the invalidity proceedings and serve as a guide to the parties concerned. The Guidelines are general in character and cannot be expected to cover all possible situations. These Guidelines will be adapted where necessary to reflect the results of actual experience with invalidity proceedings.

1.2. Structure of the Guidelines

These Guidelines are structured to follow the sequence of the invalidity proceedings from the receipt of the application for a declaration of invalidity up to the issue of the decision. The

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

² Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No. 6/2001 on Community designs

³ Commission Regulation (EC) No 2246/2002 of 16 December 2002 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs

General Principles (see section 2) should be kept in mind throughout the whole invalidity process.

2) GENERAL PRINCIPLES

2.1. Unitary Character (Art. 1(3) CDR)

The CDR grants the holder a uniform protection with unitary effect throughout the entire territory of the Community. A Community design can only be registered, transferred or surrendered with respect to the whole Community. Consequently, the effect of a declaration of invalidity of a Community design extends to the whole Community.

2.2. The Invalidity Division (Art. 105 CDR)

The Invalidity Division takes decisions on behalf of the Office in proceedings for declarations of invalidity of registered Community designs. It consists of three members, at least one of them is legally qualified.

One of the members of the Invalidity Division is the rapporteur of the case. He/she will handle the procedural aspects of the proceedings and draft the decision.

2.3. Grounds for Invalidity (Art. 25(1) CDR)

The grounds for declaring a registered Community design invalid are listed in Article 25(1) CDR. An application for a declaration of invalidity based on a ground other than those of Article 25(1) CDR must be rejected as inadmissible.

Each of the paragraphs (a) through (g) of Article 25(1) CDR forms a separate ground for invalidity. More than one ground may be stated in the application without entailing additional fees. Where the applicant uses the form supplied by the Office, he/she must tick the box corresponding to the ground(s) on which the application is based.

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

2.4. Scope of the application (Art. 52 CDR)

In invalidity proceedings, the relief sought by the applicant can only be the invalidity of the contested Community design as registered.

Registered Community designs must be contested individually, even if they are contained in a multiple application. Where more than one design of a multiple registration is contested, the applicant must file a separate application for a declaration of invalidity for each contested Community design of the multiple registration and pay the fee.

2.5. Examination of facts (Art. 63 CDR)

In invalidity proceedings, the examination performed by the Invalidity Division is restricted to the facts, evidence and arguments provided by the parties. However, the Invalidity Division must carry out the legal evaluation of those facts, evidence and arguments.

2.6. Time Limits and Suspension (Art. 91(2) CDR; Art. 31(5), 32, 56, 57 CDIR)

Requests for an extension of a time limit have to be made before its expiry and reasons have to be given, e.g. where a party needs more time to gather evidence

The proceedings will be suspended on request of both parties for reasons of finding a friendly settlement.

The proceedings may be suspended on request of any of the parties where the application for a declaration of invalidity is based on an earlier right and where the validity of the earlier right is contested.

The Invalidity Division shall 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 Invalidity Division that 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.

Where a number of applications for a declaration of invalidity have been filed relating to the same Community design and if a preliminary examination of one application reveals that the contested Community design may be invalid, the Invalidity Division will deal with that application and suspend the proceedings for the others the applicants for which will be informed accordingly.

2.7. Decisions (Art. 62 CDR; Art. 38 CDIR)

A decision of the Invalidity Division may be based only on reasons or evidence on which the parties have had an opportunity to comment. The reasons are stated in the decision.

2.8. Appeal (Art. 55 CDR)

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 suspensory effect.

3. FILING OF THE APPLICATION

3.1. Application form (Art. 68(1)(f) CDIR)

The Office provides an application form. The form may be downloaded from the Office's website <http://oami.eu.int>. The use of the form is strongly recommended.

The application should be submitted in two sets, in order that one set can be sent to the holder without incurring a loss of quality of the material due to copying. If an application was submitted in one set only, the Invalidity Division may invite the applicant to file a second one within a period of two months.

3.2. Means of Filing (Art. 65, 66(2) CDIR)

Applications for a declaration of invalidity may be filed with the Office by post, special delivery service, personal delivery, or telecopier (fax). Electronic filing of applications will be allowed by a subsequent decision of the President once the technical means are available.

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 is claimed, because the required reproduction of the prior design(s) may be deteriorated by fax transmission.

Where an application is transmitted by fax, the applicant may submit the original in two copies and the Invalidity Division will forward one of the copies to the holder. Where the applicant does not submit the original and the Invalidity Division considers the documents transmitted by fax to be of insufficient quality, it will invite the applicant to submit the original within a period of one month.

3.3. Payment of fee (Art. 52(2) CDR; Art. 28(2), 30(2) CDIR)

The application for a declaration of invalidity will not be deemed to have been filed until the fee has been paid in full.

The preferred method of payment is via current account. Where the applicant or the representative holds a current account with the Office, the fee will be debited automatically from the current account upon receipt of the application, unless instruction is given to the contrary.

Other methods of payment are by cheque or by bank transfer to the account of the Office, or in cash or by credit card at the premises of the Office.

In case of payment by transfer to a bank account held by the Office, 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. In case of remittance of a cheque, the date on which

the cheque is received by the Office will be considered to be the date of payment, provided that the cheque is met.

Where the Office 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.

The date of payment determines the date of filing of the application of a declaration of invalidity.

4) ADMISSIBILITY

4.1. Language of Proceedings (Art. 98(4)(5) CDR; Art. 29(5)(6), 30(1) CDIR)

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. 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 contested Community design.

The application for a declaration of invalidity must be filed in the language of invalidity proceedings. Where the application is not filed in the language of proceedings, the Invalidity Division will notify the applicant requesting him/her 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.

The parties to invalidity proceedings may agree on a different official language of the Community to be the language of proceedings within a period of two months of receipt by the holder of the design of the communication of the application for invalidity. Where the application was not filed in that language, a translation of the application in that language must be filed by the applicant within one month from the date when the Office has been informed of the agreement.

4.2. Identification of the applicant (Art. 28(1)(c), 30(1) CDIR)

An application for a declaration of invalidity must contain an indication of the name and address of the applicant.

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, the application must be rejected as inadmissible.

4.3. Representation of the applicant (Art. 77, 78 CDR; Art. 28(1)(c)(ii), 30(1) CDIR)

Where the applicant does not have his/her domicile or his/her principal place of business or a real and effective industrial or commercial establishment in the Community, he/she 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.

4.4. Identification of the contested Community design (Art. 24(2) CDR; Art. 28(1)(a), 30(1) CDIR)

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.

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. Where the applicant does not comply with the request, the application is rejected as inadmissible.

4.5. Lapsed registration

Where the contested Community design has lapsed or has been surrendered at the date of filing of the application, the applicant will be requested to submit evidence within a period of two months that he/she has a legal interest in the declaration of invalidity. Where the applicant does not comply with the request, the application is rejected as inadmissible.

In particular, legal interest is established where the applicant proves that the holder of the contested Community design has taken steps with the view to invoke against him/her rights under the contested Community design.

4.6. Statement of grounds (Art. 25(1) CDR; Art. 28(1)(b)(i), 30(1) CDIR)

The application must contain a statement of the ground(s) on which the application is based. An indication of the relevant section of Art. 25(1) CDR such as “ground of Art. 25(1)a CDR” is sufficient. Where the applicant uses the form provided by the Office, it is sufficient for a statement of the ground to tick one box in the field “Grounds”. Where the application does not make it possible to identify unambiguously the ground(s) on which the application is based, the applicant will be requested to submit a statement of grounds within a period of two months. Where the applicant does not comply with the request, the application must be rejected as inadmissible.

4.7. Facts, evidence and arguments (Art. 52(2) CDR; Art. 28(1), 29(5), 30(1) CDIR)

The applicant must indicate the facts, evidence and arguments in support of the ground(s) on which the application is based.

Where the applicant claims that the contested Community design lacks novelty or individual character (Art. 25(1)(b) CDR), the application must contain an indication and a reproduction 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 earlier disclosure of those prior designs.

Where the applicant claims that the holder is not entitled to the contested Community design (Art. 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.

Where the applicant claims that the contested Community design is in conflict with prior design right(s) (Art. 25(1)(d) CDR), the application must contain a representation and particulars identifying the prior design(s) on which the application for a declaration of invalidity is based and showing that the applicant is entitled to invoke the prior design right(s) as a ground for invalidity.

Where the applicant claims that the contested Community design makes unauthorised use of a distinctive sign (Art. 25(1)(e) CDR) or work protected by copyright (Art. 25(1)(f) CDR), the application must contain a representation and particulars identifying the distinctive sign or the work protected by copyright and particulars showing that the applicant is the holder of the earlier right.

Where the applicant claims that the contested Community design makes improper use of any of an item listed in Art. 6ter of the Paris Convention or of badges, emblems and escutcheons other than those covered by said Art. 6ter and which are of particular interest in a Member State (Art. 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.

Where the required indications of the facts, evidence and arguments are missing and the deficiency is not remedied by the applicant within a period of two months from being so requested by the Invalidity Division, the application is rejected as inadmissible (see section 4.9.).

Where the evidence in support of the application is not filed in the language of proceedings, the applicant must file a translation of that evidence into that language within two months of the filing of such evidence. Where the translation is not filed, the Invalidity Division will disregard the evidence.

4.8. Signing the application

The application for a declaration of invalidity must be signed by the applicant or his/her representative, if any.

Where the signature is missing, the Invalidity Division will request the applicant to remedy that deficiency within two months. If the applicant does not comply with the request, the application is rejected as inadmissible.

4.9. Treating deficiencies (Art. 30 CDIR)

Where the Invalidity Division finds the application inadmissible and the deficiency is not remedied, the Invalidity Division will issue a decision rejecting the application as inadmissible. The fee is not refunded.

4.10. Communication to the holder (Art. 53(2) CDR; Art. 28(3), 31(1), 69(3)(p) CDIR)

Where the Invalidity Division finds that the application is admissible, the application is communicated to the holder and a time limit of two months for submitting observations in response to the application is established. Requests for an extension of a time limit have to be made before its expiry and reasons have to be given. The applicant is informed accordingly and the date of filing of the application is entered into the Register.

Where the Invalidity Division finds that the application is inadmissible, the Office informs the holder that an application for declaration of invalidity has been filed and that the application has been rejected as inadmissible.

5) EXCHANGE OF COMMUNICATIONS

5.1. Observations by the holder (Art. 31(2) CDIR)

The holder's observations will be communicated to the applicant without delay.

The holder should submit his/her observations in two sets, in order that one set can be sent to the applicant without incurring a loss of quality due to copying.

Where the holder files no observations within two months, the Invalidity Division will take a decision on the merits on the basis of the evidence before it.

5.2. Translation of the holder's observations (Art. 98(4) CDR; Art. 29(2) CDIR)

Where the language of proceedings is not the language of filing of the contested Community design the holder may submit his/her observations in the language of filing. The Office will arrange to have those observations translated into the language of proceedings and communicate the translation to the applicant without delay.

5.3. Scope of defence (Art. 25(6), 53(2) CDR)

The observations of the holder must include an indication as to what extent he/she defends the contested Community design. Where the holder does not give such an indication, it is assumed that he/she 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, his/her request has to include the amended form.

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

5.4. Reply by the applicant (Art. 63(2) CDR; Art. 31(3) CDIR)

Where the holder's observations contain new facts, evidence and arguments or a request to maintain the Community design in amended form, the applicant will be invited to reply to the holder's observation within a time limit of two months. The holder will be informed accordingly.

Any reply of the applicant will be communicated to the holder.

The applicant should submit his/her reply in two sets, in order that one set can be sent to the holder without incurring 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 two months.

5.5. Translation of the applicant's reply (Art 98(4) CDR; Art. 81(1) CDIR)

Any reply of the applicant must be in the language of proceedings. Where the applicant has been invited to reply and his/her reply is not in the language of proceedings, the applicant must submit a translation of his/her reply within one month of the date of the submission of the original reply. Where the applicant submits the translation in time, it will be communicated to the holder. Where the applicant does not submit the translation in time, his/her reply will be deemed not to have been filed.

5.6. End of the exchange of communications (Art. 53(2),63(2) CDR)

Where observations by a party do not contain new facts, evidence or arguments, the Invalidity Division will inform both parties that the written proceedings are closed and that the decision will be taken.

The Office will disregard facts, evidence or arguments which are submitted belatedly by the parties concerned after the closure of the written proceedings.

6) TAKING OF EVIDENCE (Art. 65 CDR; Art. 43, 46 CDIR)

Where a party offers oral evidence from a witness or an expert, 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 necessary by the Invalidity Division. A statement of a witness must be sworn or affirmed or have a similar effect under the law of the State in which the statement is drawn up.

7) ORAL PROCEEDINGS (Art. 64 CDR; Art. 38(1), 42, 46 CDIR)

If the Invalidity Division considers oral proceedings to be expedient, they will be held at the instance of the Invalidity Division or at the request of any of the parties.

Where the Invalidity Division holds oral proceedings, the rapporteur of the case will issue a preliminary view on the merits of the case and draw attention to the points which in his/her opinion need to be discussed in order for a decision to be taken. The preliminary view will be included in the summons to the oral proceedings.

Oral proceedings, including delivery of the decision, are public where 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.

8) EXAMINATION AND DECISION

8.1. Beginning of examination (Art. 53 CDR; Art. 31(5) CDIR)

The Invalidity Division starts the examination of the application as soon as the admissibility of the application is established.

The Invalidity Division may call upon the parties to make a friendly settlement.

8.2. Termination of the proceedings without decision on the merits

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

- (i) the applicant withdraws his/her application, or
- (ii) the holder surrenders the Community design in its entirety and the applicant has no legal interest in the declaration of invalidity of the surrendered Community design, or
- (iii) the contested Community design has lapsed and the applicant has no legal interest in the continuation of the proceedings, or
- (iv) the parties have reached a friendly settlement.

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

8.3. Decision on costs (Art. 70 CDR; Art. 79 CDIR)

A decision on the merits includes a decision on costs, except where the parties agree on the apportionment of the costs.

The losing party will bear the costs.

Where the holder is the losing party he/she has to bear in addition the fee.

Where the registered Community design has been declared invalid, but is maintained in amended form, the holder has to bear the costs.

Where no decision on the merits is taken, a decision on costs will be taken only on request of one or both parties and

- (i) where the applicant withdraws his/her application. The applicant has to bear the costs.
- (ii) where the parties have made a friendly settlement. Both parties will have to bear their own costs and the applicant has to bear the fee, unless agreed otherwise by the parties.
- (iii) where the invalidity proceedings are terminated because the holder has surrendered the Community design in its entirety. The holder has to bear the costs and the fee.

- (iv) where the Community design has lapsed and the applicant does not have a legal interest to continue. Both parties have to bear their own costs and the applicant has to bear the fee.

8.4. Fixing of costs (Art. 70(6) CDR; Art. 79 CDIR)

The Invalidity Division fixes the costs in invalidity proceedings on request of one or both parties. Article 79 CDIR establishes the kind and amount of the costs which the losing party must bear.

8.5. Entry into the Register (Art. 53(3) CDR; Art. 69(3)(q) CDIR)

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.

9) PARTICIPATION OF AN ALLEGED INFRINGER (Art. 54 CDR; Art. 33 CDIR)

As long as no final decision has been taken by the Office, any third party who proves that proceedings for infringement of the same registered Community design have been instituted against him may be joined as a party in the invalidity proceedings.

The alleged infringer must file his request to be joined as a party within three months of the date on which the infringement proceedings were instituted.

The same will apply in respect of any third party who proves that (i) the right holder of the Community design has requested that he ceases an alleged infringement of the design and that (ii) the third party in question has instituted proceedings for a court ruling that he is not infringing the registered Community design.

The request to be joined as a party must be filed in a written reasoned statement.

It will not be deemed to have been filed until the invalidity fee has been paid.