



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

DESIGNS DEPARTMENT- INVALIDITY DIVISION

**DECISION OF  
THE INVALIDITY DIVISION  
OF 01/03/06**

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

<b>FILE NUMBER</b>	ICD 000001501
<b>COMMUNITY DESIGN</b>	000162425-0004
<b>LANGUAGE OF PROCEEDINGS</b>	English
<b>APPLICANT</b>	Hee Jung Kim 7-305 Asia Seonsuchon Apt. 86 Chamsil-dong, Songpa-gu, Seoul Korea
<b>REPRESENTATIVE OF THE APPLICANT</b>	J. Isern Patentes y Marcas, S.L. Avda. Diagonal, 463 Bis, 2a Planta E-08036 Barcelona Spain
<b>HOLDER</b>	Zellweger Analytics Limited Hatch Pond House 4 Stinsford Road Nuffield Estate Poole, Dorset BH17 ORZ United Kingdom
<b>REPRESENTATIVE OF THE HOLDER</b>	Kilburn & Strode 20 Red Lion Street London WC1R 4PJ United Kingdom

The Invalidity Division,

composed of Martin Schlötelburg (rapporteur), Eva Udovc (member) and Eva Vyoralova (member) took the following decision on 01/03/06:

1. **The registered Community design No. 000162425-0004 is declared invalid.**
2. **The Holder shall bear the costs of the Applicant.**

## I. FACTS, EVIDENCE AND ARGUMENTS

- (1) The registered Community design No. 000162425-0004 (hereinafter: “the RCD”) has been registered in the name of the Holder with the date of filing of 02/04/04. In the RCD, the indication of products reads “logos” and the design is represented in the following view (published at [http://oami.eu.int/bulletin/rcd/2004/2004\\_055/000162425\\_0004.htm](http://oami.eu.int/bulletin/rcd/2004/2004_055/000162425_0004.htm)):



- (2) On 12/09/05 the Applicant filed an application for a declaration of invalidity (hereinafter: “the Application”). The fee for the Application was paid by current account with effect of 12/09/05.
- (3) Using the Office’s form for the Application, the Applicant indicated the grounds “other(s) according Article 25(1)(c), (d), (e), (f) or (g) CDR”. In his arguments, the Applicant pointed explicitly to Article 25(1)(e) CDR.
- (4) As evidence the Applicant provided a copy of an extract from the ROMARIN (International Trademark Information Database) regarding the International trademark registration 810732 (in the following: IR). The IR was registered on 10/04/03 in the name of the Applicant, designating *inter alias* AT, BX, CZ, DE, DK, ES, FI, FR, GB, GR, HU, IT, IE, PT, PL and SE. The goods of the IR cover the classes 7, 9 and 11 of the Nice Classification. In the extract, the sign is represented as follows:

**MIDAS**

- (5) In response to the Application, the Holder argues that the Applicant has misinterpreted the meaning of the Article 25(1)(e) of the CDR. According to the Holder “design means the appearance of the whole or part of the product”. Consequently “highly graphically evolved logos, the subject of the attacked registrations, are utterly different in appearance from the plain word MIDAS, the subject of the Applicant’s prior trade mark”. The Holder claims that Applicant’s arguments focus “on semantic content, not visual content” and thus should be disregarded as “in the CDR system the focus is on appearances”.
- (6) For further details to the facts, evidence and arguments submitted by the Applicant and the Holder reference is made to the documents on file.

## **II. GROUNDS OF THE DECISION**

### **A. Admissibility**

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

### **B. Substantiation**

#### **B.1 Evidence**

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

#### **B.2 Distinctive Sign**

- (9) Article 25(1)(e) CDR stipulates that a Community design is to be declared invalid if a distinctive sign is used in a subsequent design, and the Community law or the law of the Member States governing that sign confers on the right holder of the sign the right to prohibit such use.
- (10) According to Article 2 of the Directive 89/104/EEC of the Council, of 21 December 1988, a “trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.” The Directive has been implemented in each of the Member States.

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<sup>1</sup> Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs

- (11) Consequently, where a sign is registered as a trademark in a Member State and the trademark is in force, it is presumed that it is a “distinctive sign” in the meaning of Article 25(1)(e) CDR.

## **B.2 Right to Prohibit Use**

- (12) The IR of the Applicant is registered for goods in the classes 7, 9 and 11 of the Nice Classification and for a sign consisting of the word “MIDAS” written in a standard type of letters with no figurative elements. The IR has effect in various Member States.
- (13) According to Article 5 of the Directive 89/104/EEC, the proprietor of a registered trademark shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with the trademark in relation to goods or services which are identical with those for which the trade mark is registered.
- (14) Consequently, according to the law of any of the Member States designated in the IR, the Applicant has the right to prohibit the use of a sign consisting of the word “MIDAS” in any form of writing where the use of the sign in the course of trade relates to any of the goods for which the IR is registered.
- (15) Incorporation of the letters “m”, “i”, “d”, “a” and “s” into the RCD in such a way that the letters are perceived as forming the word “midas” constitutes a use of a sign identical to the IR.
- (16) The use of the sign in the RCD relates to the goods of the IR, since the sign is used in the design of a logo which intrinsically relates to any type of goods and services. In particular, it is the commercial purpose of a logo to be affixed to goods or to the packaging thereof or to be used on business papers and in advertising. Therefore, the goods to which the use of the sign in the RCD relates are identically included in the list of goods for which the IR is registered.
- (17) The use of the sign in the RCD is a use in the course of trade, since the purpose of registering a design is its use for commercial purposes.

## **C. Conclusion**

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

## **III. COSTS**

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

#### **IV. RIGHT TO APPEAL**

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

#### **THE INVALIDITY DIVISION**

**Martin Schlötelburg**

**Eva Udovc**

**Eva Vyoralova**