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**GUIDELINES FOR EXAMINATION OF  
REGISTERED COMMUNITY DESIGNS**

**EUROPEAN UNION  
INTELLECTUAL PROPERTY OFFICE  
(EUIPO)**

***Examination of design invalidity  
applications***

Obsolete

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Obsolete

# 1 Purpose

The purpose of these Guidelines is to explain how, in practice, the provisions of the Community Design Regulation <sup>8</sup> (CDR), the Community Design Implementing Regulation <sup>9</sup> (CDIR), and the Fees Regulation <sup>10</sup> (CDFR) are applied by the Invalidity Division of the EUIPO from 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 Invalidity 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 Invalidity Proceedings

### 2.1 Duty to state reasons

The decisions of the Invalidity 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 Invalidity Division will apply the principles explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 1, Adequate Reasoning.

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<sup>8</sup> [Council Regulation \(EC\) No 6/2002 of 12 December 2001 on Community Designs](#) amended 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.

<sup>9</sup> [Commission Regulation \(EC\) No 2245/2002 of 21 October 2002 implementing Council Regulation \(EC\) No 6/2001 on Community designs](#) amended by Commission Regulation (EC) No 876/2007 of 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.

<sup>10</sup> [Commission Regulation \(EC\) No 2246/2002 of 16 December 2002 on the fees payable to the Office for Harmonization in the Internal Market \(Trade Marks and Designs\) in respect of the registrations of Community designs](#) 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 Invalidity Division will 'be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments' (Article 62 CDR).

The Invalidity Division will apply the principles explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 2, The right to be heard.

## **2.3 Scope of the examination carried out by the Invalidity Division**

In invalidity proceedings, the examination carried out by the Invalidity Division is restricted to the facts, evidence and arguments provided by the parties (Article 63(1) CDR). This does not preclude the Invalidity Division from taking into consideration well-known facts (16/02/2017, T-828/14 & T-829/14, Radiatori per riscaldamento, EU:T:2017:87, § 90; the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 1, Adequate Reasoning).

The Invalidity 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 that are not supported by evidence are not taken into account (16/02/2018, R 459/2016-G, Dishes, § 26).

Facts, evidence and arguments are three different items not to be confused with each other. For instance, the date of disclosure of an earlier design is a fact. Evidence of that fact could be the date of publication of a catalogue showing the earlier design together with evidence proving that the catalogue had 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 earlier design forms an obstacle to the individual character of the contested Community design given the similar overall impression it produces on the informed user. Whether a Community design lacks individual character or not is not a fact but a legal question to be decided by the Invalidity Division on the basis of the facts, evidence and arguments submitted 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 (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 26).

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

have to be ruled on by the Invalidity Division, even when it has not been raised by the parties, if it is necessary to resolve that matter in order to ensure correct application of the CDR. The Invalidity Division will thus examine *ex officio* such matters of law that 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 (by analogy, 01/02/2005, T-57/03, Hooligan, EU:T:2005:29, § 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 Invalidity Division may disregard facts or evidence that are not submitted in due time by the parties concerned (Article 63(2) CDR).

Parties are reminded that they must submit the facts and evidence on which they rely in due time and within the time limits set by the Invalidity Division. Parties that 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 taken into consideration by the Invalidity Division.

Where the Invalidity 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 that has been submitted late is, on the face of it, likely to be relevant to the outcome of the invalidity 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 (13/03/2007, C-29/05 P, ARCOL / CAPOL, EU:C:2007:162, § 42-44; 05/07/2017, T-306/16, Door handles, EU:T:2017:466, § 15-18).

Where a party files a submission by fax, it should indicate in the accompanying letter whether an original (which, as the case may be, may contain documents in colours) has been sent. Both the fax and the original should reach the Office within the set time limit. In accordance with Article 63(2) CDR, the Office may not take into account an original that was not submitted in due time by the parties concerned.

If the time limit is still running, the party may request an extension of the time limit, pursuant to Article 57(1) CDIR (see paragraph 4.1.6 below).

For general information on time limits, see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

## **3 Filing of an Application**

### **3.1 Form of the application**

The Office recommends filing an application by e-filing through the User Area on the Office's website.

For other means of filing an application (Article 52 CDR), the Office provides a form (Article 68(1)(f) CDIR) that can be obtained upon request. Its use is strongly recommended (Article 68(6) CDIR) in order to facilitate the processing of the application and avoid errors. The completed form must be submitted by the applicant to the Office by the statutory means of communication. If an application, including supporting documents, is filed other than by e-filing or fax, it should be submitted in duplicate, in order that one set of documents can be kept in the Office's archive while the other is sent to the holder without any loss of quality due to copying. If an application is submitted in one set only, the Invalidity Division may invite the applicant to file a second set within a period of 1 month, or 2 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 invalidity 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 design must be contested individually and identified by reference to its full registration number (Article 37(4) CDR) or the numbering stipulated for multiple international applications respectively. 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 filed for each contested Community design.

### **3.3 Language of proceedings**

The language regime in design invalidity proceedings is not the same as that governing trade mark proceedings.

The application for a declaration of invalidity must be filed in the language of proceedings, which is the language used for filing the application for registering the contested Community design (language of filing), 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).

Where the application for a declaration of invalidity is not filed in the language of proceedings, the Invalidity Division will request that the applicant submit a translation within a period of 2 months of the date of receipt of the notification. Where the applicant does not comply with the request, the application will be 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 on the agreement must reach the Office within a period of 2 months of receipt by the holder of notification of the application. Where the application was not filed in that language, the applicant must submit a translation of the application in that language within 1 month of the date on which the Office was informed of the agreement (Article 98(5) CDR; Article 29(6) CDIR).

As regards international registrations designating the European Union, the language of proceedings is the language in which the international application was filed (English, French or Spanish). The first language used in the product indication (INID code 54 of the international recording and publication) is the language in which the international application was filed at the International Bureau. In case of doubt, applicants for a declaration of invalidity are advised to check the language of filing of the international registration with the International Bureau.

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

### **3.4 Identification of the applicant**

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 2 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 Invalidity Division based on Article 25(1)(a) and (b) CDR (Article 52(1) CDR).

However, where the ground for invalidity is the infringement of an earlier right, within the meaning of Article 25(1)(c) to (f) CDR, or an improper use of flags and other symbols, within the meaning of Article 25(1)(g) CDR, an application for a declaration of

invalidity is admissible only if the applicant is entitled to the earlier right or is affected by use of the symbol, as the case may be (Article 52(1) CDR). Entitlement will be examined on the basis of the international, national or European Union law that governs the earlier right or symbol in question.

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

### **3.6 Representatives**

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

### **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 2 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 2 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) (16/06/2011, ICD No 8 231).

For instance, legal interest is established where the applicant proves that the holder of the contested Community design has taken steps with a view to invoking 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 2 months and, if so, to submit reasons in support of its request in order 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'.

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

The Invalidity Division will examine an application in the light of all the 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 application does not make it possible to identify unambiguously 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 2 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).

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 earlier 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 earlier design(s) (Article 7 CDR; Article 28(1)(b)(v) CDIR). It is for

the applicant to provide the Office with the necessary information and, in particular, to identify and present precisely and entirely the earlier design relied upon (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 65).

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 demonstrating 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 entitled to invoke the prior design as a ground for invalidity (Article 28(1)(b)(ii) CDIR).

Where the applicant claims that the contested Community design infringes 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) CDIR).

Where the earlier right invoked under Article 25(1)(e) or (f) CDR is registered, a distinction is made depending on whether the earlier design or trade mark is an RCD or an EUTM. If the earlier right is an RCD or an EUTM, the applicant does not have to submit any documents. Examination of the substantiation will be based on the data contained in the Office's database. In all other cases, the applicant must provide the Office with evidence of the filing and registration of the earlier design or registered distinctive sign. The following documents will be accepted (see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 4.2.3, Trade mark registrations or applications that are not EUTMs): (1) certificates issued by the appropriate official body, (2) extracts from official databases, (3) extracts from official bulletins of the relevant national offices and WIPO.

Where the earlier right invoked under Article 25(1)(e) or (f) CDR 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 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 6ter of the Paris Convention or of badges, emblems and escutcheons other than those covered by Article 6ter 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 affected by the improper use (Article 28(1)(b) (iv) CDIR).

Where the indications required above are missing, and the deficiency is not remedied by the applicant within a period of 2 months of a request by the Invalidity Division, the application will be rejected as inadmissible (Article 30(1) CDIR).

Where the evidence in support of the application is not filed in the language of proceedings, the applicant must on its own motion submit a translation of that evidence into that language within 2 months of the filing of such evidence (Article 29(5) CDIR). The question 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 submitted, the Invalidity Division may disregard the text portions of the evidence that are not translated and base its decision solely on the evidence before it that has been translated into the language of proceedings (Article 31(2) CDIR).

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, etc.), 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 for invalidity is admissible if and insofar as the requirements regarding admissibility are satisfied for at least one of those 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 2 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 e-filing through the User Area on the Office's website (Decision No EX-19-1 of the Executive

Director of the Office concerning communication by electronic means), by post, personal delivery (Decision No EX-16-3 of the Executive Director of the Office) concerning the hours during which the Office is open for the receipt of submissions by personal delivery relating to EUTMs and RCDs) or fax (Article 65 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 earlier design(s) may be compromised by fax transmission, and colour information will be lost.

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 or 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 receipt of the retransmission or of the original will be deemed to be the date of receipt of the original communication. Where the request is not complied with within the time limit specified, the communication will be deemed not to have been received (Article 66(2) CDIR).

Where an application is transmitted by fax, the Office recommends that the applicant submits two sets of the original within 1 month of 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 to enable the Invalidity Division to make its decision. An application will be dismissed as unsubstantiated if the faxed evidence of the earlier designs, or of the earlier rights, without being totally illegible, is not of sufficient quality to allow all the details to be discerned for the purposes of comparison with the contested Community design (10/03/2008, R 586/2007-3, Barbecues, § 23-26).

### **3.12 Payment of fees**

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).

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 Invalidity Division finds that the fee has not been paid, it will request that the applicant pay the fee within a period of 2 months of 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) CDIR).

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) CDIR).

### **3.13 Deficiencies**

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

### **3.14 Communication to the holder**

When the application for a declaration of invalidity is submitted via e-filing, the RCD holder receives automated information about the filing as a simple measure of organisational procedure.

The communication constituting the decision on the admissibility of an application for a declaration of invalidity to the RCD holder is issued only after the application has been found admissible (Article 31(1) CDIR). This decision can be appealed together with the final decision (Article 55(2) CDR).

The decision on 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) CDIR), and if the applicant for invalidity fails to remedy such irregularities within the time limit prescribed by the Office (Article 30 CDIR) (Article 68 CDR and, by analogy, 18/10/2012, C-402/11 P, Redtube, EU:C:2012:649, § 59).

Where the Invalidity Division does not reject the application as inadmissible, the application is communicated to the holder and a time limit of 2 months for submitting observations in response to the application is granted (see below under paragraph 4.1.1).

### **3.15 Participation of an alleged infringer**

As long as no final decision has been taken by the Invalidity Division, any third party that proves that proceedings for infringement based on the contested Community design have been instituted against it can join as a party to the invalidity proceedings (Article 54 CDR; Article 33 CDIR).

The alleged infringer must submit its request to be joined as a party within 3 months of the date on which the infringement proceedings were instituted. Unless proof is submitted by the holder that another date should be retained in accordance with the national law in question, the Invalidity 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 that proves that (i) the rights 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 invalidity proceedings (Article 54 and Article 81(b) CDR).

The request to be joined as a party must be submitted in a written reasoned statement and will not be deemed to have been submitted until the invalidity fee has been paid. The rules explained above in 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**

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

When representation is mandatory and the holder is no longer represented, the Invalidity Division will invite the holder to appoint a representative. If the holder does not do so, procedural statements made by the holder will not be taken into account, and the invalidity request will be dealt with on the basis of the evidence that the Invalidity Division has before it.

##### **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 3.9.2 above).

The holder should submit its observations (including the supporting documents) in duplicate when not using e-filing or fax, so that one set of documents can be kept in the Office's archives and the other sent to the applicant. This is done to avoid a loss of quality due to copying by the Office. Where the observations are submitted in one set only, the Invalidity Division may invite the holder to submit a second set within a period

of 1 month, or 2 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 submits no observations within the 2-month 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).

#### 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 5 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 (European Union, international or national) trade mark having effect in the European Union that, on the date of the application for a declaration of invalidity, has been registered for not less than 5 years;
- the request for proof of use is submitted together with the holder's first submission in response to the application (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 66-72; 27/06/2013, T-608/11, Instruments for writing, EU:T:2013:334, § 87; 15/11/2013, R 1386/2012-3, CINTURONES, § 21).

#### 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 translations 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, that is, in its entirety.

Where the holder requests that the Community design be maintained in an amended form, the request must 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 5.10 below).

The request to maintain the contested Community design in an amended form must be submitted during the invalidity proceedings and before the end of the written phase. 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 2 months (Article 53(2) CDR; Article 31(3) CDIR) in particular under the following circumstances:

- where the holder's observations contain new facts, evidence and arguments that 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 from 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 paragraph 3.9 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 (05/02/2016, R 2407/2014-3, Kitchen utensils, § 21; 22/10/2009, R 690/2007-3, Chaff cutters, § 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 duplicate when not using e-filing or fax, so that one set of documents can be kept in the Office's archives and the other can be sent to the holder. This is done to avoid a loss of quality due to copying. If a reply is submitted

in one set only, the Invalidity Division may invite the applicant to submit a second set within a period of 1 month, or 2 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 1 month of the date of the submission of the original reply (Article 81(1) CDIR). The Invalidity 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 applicant is requested to submit evidence of use of its earlier trade mark, it must 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 5 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 Article 10(3) EUTMDR, 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.

Where the language of the documents submitted by the applicant is not the language of the proceedings, the Invalidity Division may require that a translation be supplied in that language, within 1 month, or 2 months if the applicant does not have its domicile or its principal place of business or an establishment within the European Union (Articles 57(1) and 81(2) 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 Invalidity Division, the application for a declaration of invalidity will be rejected to the extent that it was based on Article 25(1)(e) CDR.

When examining the evidence of use, the Invalidity 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 that are prima facie relevant for a decision on the merits, and additional observations are

not necessary, the Invalidity 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, for example, 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 by any of the parties for an extension of a time limit determined by the Office must be submitted before the original time limit expires (Article 57(1) CDIR).

As a general rule, a first request for extension of a time limit will be granted. Further extensions will not be granted automatically. In particular, the Invalidity 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 Invalidity Division. The request for an extension of the time limit must indicate the reasons why the parties cannot meet the deadline. Obstacles faced by the parties' representatives do not justify an extension (by analogy, 05/03/2009, C-90/08 P, *Corpo livre*, EU:C:2009:135, § 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 Invalidity 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 Invalidity 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 Invalidity Division may also suspend the proceedings when it is appropriate, in particular in the circumstances listed here.

- 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, trade mark or other earlier right, the validity of which is challenged in administrative or in court proceedings, until a final decision is taken in those proceedings.

- Where the Invalidity 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 may suspend the other invalidity proceedings (Article 32(2) CDIR).

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 in obtaining a decision within a reasonable period of time (see, by analogy, 16/05/2011, T-145/08, Atlas, EU:T:2011:213, § 68-77).

The Invalidity Division will notify the parties of its decision to grant or refuse a suspension, giving reasons and explaining which factors it considers when exercising its discretion. Where the Invalidity Division decides not to grant the suspension, reasons may instead be given in the decision terminating the proceedings. 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 or when it has been brought to the attention of the Invalidity Division that the event that justified the stay has occurred, or ceased 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 the suspension was requested jointly by the parties, the period will always be 1 year regardless of the period requested by the parties. Any party can bring the suspension to an end ('opting out'). It is immaterial whether the other party disagrees with or has consented to it.

If one of the parties 'opts out', the suspension will end 2 weeks after the parties have been informed 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 2 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 CDIR).

#### **4.1.8 Oral proceedings**

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

Where a party requests that they be held, the Invalidity Division enjoys broad discretionary powers as to whether oral proceedings are really necessary. A hearing will not be held when the Invalidity Division has before it all the information needed as a basis for the operative part of the decision on invalidity (13/05/2008, R 135/2007-3, *Macchine da gioco automatiche*, § 14).

The Invalidity Division will apply the principles explained in the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 5, Oral proceedings.

## **4.2 Examination**

### **4.2.1 Commencement of examination**

The Invalidity 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 can be submitted (Article 53 CDR).

### **4.2.2 Examination of the grounds for invalidity**

The grounds for declaring a Community design invalid are listed exhaustively 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 (18/03/2010, T-9/07, *Metal rappers*, EU:T:2010:96, § 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 (contrary to public policy or morality).

Where the 'Grounds' box in the application form corresponding to Article 25(1)(b) CDR is ticked, the Invalidity Division will determine which specific ground or grounds is or are relied on by the applicant from the facts, evidence and arguments referred to in the reasoned statement of grounds.

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

The Invalidity 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 (02/08/2007, R 1456/2006-3, Saucepan handles, § 10).

The examination, however, will not be extended to grounds not relied on in the application. Where an applicant exclusively challenges, for instance, either the novelty or the individual character of a Community design, the Invalidity Division will examine the invoked ground only (14/03/2018, T-424/16, Footwear, EU:T:2018:136, § 47).

The applicant cannot raise new grounds for invalidity after the date of filing of the application (10/02/2016, R 1885/2014-3, Logos, § 15-19). 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 Invalidity Division will not take a decision on the others (15/12/2004, ICD No 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 (14/06/2011, T-68/10, Watches, EU:T:2011:269).

For the examination of the substantive requirements concerning the validity of a priority claim in the course of invalidity proceedings, see the Guidelines, Examination of Applications for Registered Community Designs, paragraph 6.2.1.1, Priority.

## **5 The Different Grounds for Invalidity**

### **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 (other than forming a 'set of products', see Article 3 CDR and the Guidelines,

Examination of Applications for Registered Community Designs, Additional requirements regarding the reproduction of the design, paragraph 5.2.7, Sets of articles), or where the graphical representation consists of mere representations of nature (landscapes, fruits, animals, etc.) that are not products within the meaning of Article 3(1)(b) CDR.

### 5.1.1 Living organisms

A design that discloses the appearance of a living organism in its natural state, in principle, has to be refused. Even if the shape at issue deviates from that of the common corresponding living organism, the design should be refused if nothing suggests prima facie that the shape is the result of a manual or industrial process (by analogy, 18/02/2013, R 595/2012-3, GROENTE EN FRUIT, § 11).



A Community design will not be declared invalid if it is apparent from the representation that the product does not show a living organism or if the indication of the product specifies that the product is artificial (see, in particular, Class 11-04 of the Locarno Classification).

### 5.1.2 Ideas and methods of use

The law relating to designs protects the appearance of the whole or a part of a product, but does not protect the underlying idea of a design (06/06/2013, T-68/11, Watch-dials, EU:T:2013:298, § 72). Nor is the method of use or operation protected by a design (21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 52).

## 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 rights holder is not entitled to the Community design under Article 14 CDR.

This ground may be invoked solely by the person who is entitled to the Community design under Article 14 CDR.

In the absence of a court decision, the Invalidity Division cannot declare the contested Community design invalid under Article 25(1)(c) CDR (11/02/2008, R 64/2007-3, Loudspeakers, § 15).

It is clear from the words ‘by virtue of a court decision’ in Article 25(1)(c) CDR that the Invalidity Division has no jurisdiction to determine who is entitled to a Community design under Article 14 CDR. Such jurisdiction belongs to any national court that is competent under Article 27 and Article 79(1) and (4) CDR in conjunction with Article 93 CDR.

### **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**

The aim of Article 8(1) CDR is to prevent technological innovation from being hampered by the granting of design protection to features dictated solely by a technical function of a product (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 29).

It excludes protection for features of appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 31).

However, this does not mean that a design must have an aesthetic quality (recital 10 CDR).

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 (29/04/2010, R 211/2008-3, FLUID DISTRIBUTION EQUIPMENT, § 36).

#### **5.3.2 Examination**

It is the applicant’s responsibility to prove any technical function invoked as a ground for invalidity.

The technical facts required for assessing Article 8(1) CDR may not be well known. It is thus the obligation of the party relying on these facts to submit them, as the examination carried out by the Invalidity Division is, in principle, restricted to the facts, evidence and arguments provided by the parties (Article 63(1) CDR).

The technical functionality of the features of a design may be assessed by taking account of patent documents describing the technical elements of the shape concerned. However, the drawing illustrating a patent cannot in itself, without further facts, evidence and arguments, establish the technical function of a contested Community design.

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 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 the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (by analogy, 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56).

Whether Article 8(1) CDR applies must be assessed on the basis of all the objective circumstances relevant to each individual case, and not from the perspective of the informed user, who may have limited knowledge of technical matters.

Such an assessment must be made, in particular, having regard to the design at issue, the objective circumstances dictating the choice of features of appearance of the product concerned, and/or information on its use or the existence of alternative designs that fulfil the same technical function, provided that the circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 36-37).

The information on its use may include the use made of the actual product that the design is applied to or incorporated into, as well as any information on its marketing.

## **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 (20/11/2007, ICD No 2 970).

It is up to the applicant to prove that a Community design may be objected to on the basis of Article 8(2) CDR. 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 the product and by the Community design individually and/or in combination.

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

## **5.5 Lack of novelty and individual character**

### **5.5.1 Disclosure of earlier 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 that is identical or that produces a similar overall impression has been made available to the public before the date of filing of the application for registration or, if a priority is claimed, the date of priority (Articles 5 and 6 CDR).

The required disclosure of the earlier design is preliminary to deciding whether the two designs are identical or produce the same overall impression on the informed user. If the earlier design has not been disclosed, then the application is rejected to the extent that it is based on Articles 5 and 6 CDR.

Where the quality of the representation of the earlier design does not enable a comparison with the contested design, this does not amount to a disclosure for the purpose of Article 7(1) CDR (10/03/2008, R 586/2007-3, Barbecues, § 22 et seq.).

For the purpose of Article 7 CDR, it is immaterial whether or not an earlier 'design' within the meaning of Article 3(a) CDR enjoys or enjoyed legal protection (as a design, trade mark, copyright work, patent, utility model or otherwise) (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 24).

Under Article 7(1) CDR, the invalidity applicant relying on an earlier design has to prove the event of disclosure, for instance in publications, at exhibitions, in trade or on the internet (see paragraphs 5.5.1.3-5.5.1.5 below). Such proof will allow the Invalidity Division to prima facie deem the design to have been made available. The holder of the contested RCD can refute this presumption by way of establishing, to the requisite legal standard, that the circumstances of the case could reasonably prevent those events from becoming known in the normal course of business to the circles specialised in the sector concerned (15/10/2015, T-251/14, Doors (parts of), EU:T:2015:780, § 26; 21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 26).

The presumption set out in Article 7(1) CDR applies irrespective of where the events of disclosure took place. It is therefore not necessary that they take place within the European Union (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 27). The question whether events of disclosure outside the European Union could reasonably have become known to persons forming part of those circles is a question of fact. The answer to that question has to be assessed by the Invalidity Division on the basis of the particular circumstances of each individual case (13/02/2014, C-479/12, Gartenmöbel, EU:C:2014:75, § 34).

In the context of Article 7(1) CDR, what matters is whether the ‘circles specialised in the sector concerned’ have had an opportunity to have access to the design irrespective of the number that actually seized this opportunity and might have encountered the disclosed design. There is thus no quantitative threshold with regard to actual knowledge of the disclosure events (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 73).

It must be examined whether, on the basis of the facts to be adduced by the party challenging the disclosure, it is appropriate to consider that it was not actually possible for those circles to be aware of the events constituting disclosure, whilst bearing in mind what can reasonably be required of those circles in terms of being aware of prior art. Those facts may concern, for example, the composition of the specialised circles, their qualifications, customs and behaviour, the scope of their activities, their presence at events where designs are presented, the characteristics of the design at issue, such as its interdependency with other products or sectors, and the characteristics of the products into which the design at issue has been integrated, including the degree of technicality of the products concerned. In any event, a design cannot be deemed to be known in the normal course of business if the circles specialised in the sector concerned can become aware of it only by chance (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 56).

The term ‘circles specialised in the sector concerned’ within the meaning of Article 7(1) CDR is not limited to persons involved in creating designs and developing or manufacturing products based on those designs within the sector concerned. Article 7(1) CDR lays down no restrictions relating to the nature of the activity of natural or legal persons who may be considered to form part of the ‘circles specialised in the sector concerned’. Consequently, traders may also form part of the ‘specialised circles’ within the meaning of Article 7(1) CDR (by analogy, 13/02/2014, C-479/12, Gartenmöbel, EU:C:2014:75, § 27).

Designs that are disregarded for the purpose of Articles 5 and 6 CDR will be addressed in paragraphs 5.5.1.7 and 5.5.1.8 below.

#### 5.5.1.2 Establishing the event of disclosure

Neither the CDR nor the CDIR provides for any specific form of evidence required for establishing the event of disclosure. Article 28(1)(b)(v) CDIR only provides that ‘documents proving the existence of those earlier designs’ must be submitted. Nor are there any provisions as to any compulsory form of evidence that must be submitted. Article 65 CDR lists possible means of giving evidence before the Office, but it is clear from its wording that this list is not exhaustive (‘shall include the following’). Accordingly, the evidence in support of the event of disclosure is a matter for the discretion of the applicant and, in principle, any evidence capable of proving the event can be accepted.

The Invalidity Division will carry out an overall assessment of such evidence by taking account of all the relevant factors in the particular case. An event of 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 (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 21-24).

A global examination of the items of evidence relating to the same earlier design implies that these items must be assessed in the light of each other. Even if some items of evidence are not conclusive of an event of disclosure in themselves, they may contribute to establishing the event of disclosure when examined in combination with other items (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 25, 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 3.9.2 above).

As regards 'statements in writing, sworn or affirmed', affidavits in themselves, as a matter of principle, are not sufficient to prove a fact such as the event of disclosure of an earlier design. They may, however, corroborate and/or clarify the accuracy of additional documents (18/11/2015, T-813/14, Cases for portable computers, EU:T:2015:868, § 29).

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 the face of it, the document appears sound and reliable (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 39-40).

The Invalidity Division will apply the principles explained in the Guidelines, Part C, Opposition, Section 6, Proof of Use, paragraph 3.3.2.3, Declarations.

#### 5.5.1.3 Official publications

Publication of an earlier design in the bulletin of any intellectual property office worldwide constitutes an event of disclosure (27/10/2009, R 1267/2008-3, MONTRES, § 35 et seq; 07/07/2008, R 1516/2007-3, BIDONS, § 9). The same applies where the publication concerns the appearance of a product in relation with any other kind of intellectual property right. An example for trade marks would be the judgment of 16/12/2010, T-513/09, Ornamentación, EU:T:2010:541, § 20; and for patents the judgment of 15/10/2015, T-251/14, Doors (parts of), EU:T:2015:780, § 22.

However, a document kept by an intellectual property office, which is available to the public only by means of an application for inspection of files, may not be considered to have become known in the normal course of business to the specialised circles in the sector concerned and therefore does not give rise to a disclosure of an earlier design within the meaning of Article 7 CDR (22/03/2012, R 1482/2009-3, INSULATION BLOCKS, § 39-43; 15/04/2013, R 442/2011-3, Skirting boards, § 26).

In order to prove the event of disclosure, the evidence must specify the date of publication independently of the date of filing or the date of registration. Whether or not

the publication takes place before registration or after is irrelevant (15/04/2013, R 442/2011-3, Skirting boards, § 24).

Moreover, it is enough that the date of publication can be identified by the mention of the relevant INID code (internationally agreed numbers for the identification of (bibliographic) data) (14/11/2006, ICD No 2 061).

#### 5.5.1.4 Exhibitions and use in trade

Exhibiting a design at a trade fair exhibition anywhere in the world is an event of disclosure (26/03/2010, R 9/2008-3, FOOTWEAR, § 73-82; 01/06/2012, R 1622/2010-3, Lámparas, § 24).

Use in trade is another example given in Article 7(1) CDR as a means of disclosing a design, irrespective of whether this use is made within or outside the European Union (26/03/2010, R 9/2008-3, FOOTWEAR, § 63-71).

Disclosure of a design can be the result of use in trade even where there is no proof that the products in which the earlier design is incorporated have actually been produced or put on the market (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 36). It can be sufficient that the products have been offered for sale in catalogues distributed (22/10/2007, R 1401/2006-3, ORNAMENTACIÓN, § 25) or imported from a country outside the European Union (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 31-32) or have been the object of an act of purchase between two European operators (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 30-45).

As regards the submission of catalogues, their evidential value does not necessarily depend on their being distributed to the public at large. Catalogues that are made available to specialised circles only can also be valid means of evidence, bearing in mind that the relevant public for assessing disclosure is the 'circles specialised in the sector concerned' (Article 7(1) CDR).

It is enough that the disclosure took place at a point in time that 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 (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 31-32).

#### 5.5.1.5 Disclosures derived from the internet

Information disclosed on the internet or in online databases is considered to be publicly available as of the date the information was published. Internet websites often contain highly relevant information. Certain information may even be available only on the internet. This includes, for example, online publications of design registrations by intellectual property offices.

The nature of the internet can make it difficult to establish the actual date on which information was in fact published. For instance, not all web pages mention the date when they were launched. In addition, websites are easily updated, yet most do not

provide any archive of previously displayed material, nor do they display records that 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 website provides time stamp 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; or
- a screenshot of a web page bears a given date; or
- information relating to the updates of a web page is available from an internet archiving service such as the 'Wayback Machine' (02/07/2015, R 25/2014-3, SOFT DRINK BOTTLE, § 29).

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) prevents a design on a web page from being found to have been disclosed. When assessing whether such a disclosure could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned and operating within the European Union, aspects such as accessibility and searchability of the web page can be taken into account.

#### 5.5.1.6 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 will 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 (20/06/05, ICD No 172, § 22).

The burden of proving facts establishing confidentiality lies with the holder of the contested Community design.

#### 5.5.1.7 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 CDIR). The right of priority is 6 months from the date of filing of the first application.

The effect of the right of priority will 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 and 22, Article 25(1)(d) and Article 50(1) CDR (Article 43 CDR).

For the examination of the substantive requirements concerning the validity of a priority claim in the course of invalidity proceedings, see the Guidelines, Examination of Applications for Registered Community Designs, paragraph 6.2.1.1, Priority.

#### 5.5.1.8 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 (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 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 occur where a third party has made public a design copied from a design that was previously disclosed within the grace period by the holder itself (02/05/2011, R 658/2010-3, LEUCHTVORRICHTUNGEN, § 37-39).

Article 7(2) CDR also provides for immunity against the loss of individual character pursuant to Article 6 CDR (02/05/2011, R 658/2010-3, LEUCHTVORRICHTUNGEN, § 40). The exception provided in Article 7(2) CDR may therefore apply where the previously disclosed design is either identical to the contested Community design within the meaning of Article 5 CDR, or the previously disclosed design does not produce a different overall impression.

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 in the light of the facts, arguments and evidence submitted by the parties (25/07/2009, R 552/2008-3, LECTEUR ENREGISTREUR MP3, § 24-27).

### 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), Articles 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 earlier designs. The relevant earlier designs are 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 individually with each and every earlier design relied on by the applicant. Novelty and individual character of a Community design cannot be defeated by combining features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually (21/09/2017, C-361/15 P and C-405/15 P, Shower drains, EU:C:2017:720, § 69; 19/06/2014, C-345/13, Karen Millen Fashions, EU:C:2014:2013, § 23-35; 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 23-24).

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

In principle, subject to a number of exceptions detailed below, all the features of conflicting designs must be taken into consideration when examining novelty and individual character.

#### Point of reference for the comparison

The contested Community design is the point of reference when assessing novelty and individual character in the comparison with the earlier design.

Novelty and individual character, therefore, have to be assessed solely on the basis of the features disclosed in the contested design (13/06/2017, T-9/15, Dosen [für Getränke], EU:T:2017:386, § 87).

Consequently, if the contested Community design reproduces only certain aspect views, for instance the front view, a comparison is made only with the corresponding view of the earlier design. Any additional aspect views disclosed by the earlier design, such as the rear view, are disregarded.

The same principle applies when the contested Community design shows the appearance of only part of a product whereas the earlier design discloses the whole product.

However, in turn, when the contested Community design shows more features than the earlier design, its overall impression is determined by all of its features save for the exceptions outlined below.

#### Features dictated by a technical function and features of interconnection

Features that are solely dictated by a technical function and features that 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 earlier designs (Article 8 CDR, see paragraph 5.3.1 above).

However, when parts of a product serve a functional purpose without being dictated by it within the meaning of Article 8 CDR, its features may constitute a differentiating factor to the extent that its features could be designed differently. For instance, a button operating the functions on an electronic wristband can be placed on the product in different ways and can have different shapes and sizes (04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464, § 61).

### 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 that is composed of multiple components that can be replaced, permitting disassembly and reassembly 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 (23/06/2008, ICD No 4 919).

'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 that 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 an 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 that must be disregarded (03/08/2009, R 1052/2008-3, Contacteurs électriques, § 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), the Community design will be invalidated as a whole (20/01/2015, T-616/13, Heat Exchanger Inserts, EU:T:2015:30, § 14-16).

However, Article 4(2) CDR does not require a component part to be clearly visible in its entirety at every moment of 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 (22/10/2009, R 690/2007-3, Chaff cutters, § 21).

Where the features of a Community design applied to a component part are only partially visible during normal use of the complex product, the comparison with the relevant earlier designs invoked must be limited to the visible parts.

### Clearly discernible features

Features of a Community design that 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 of the Council of 13 October 1998 on the legal protection of designs, recital 11). Likewise, features of the earlier design that are not of sufficient quality to allow all the details to be discerned in the portrayal of the earlier design cannot be taken in consideration for the purpose of Articles 5 and 6 CDR (10/03/2008, R 586/2007-3, Barbecues, § 23-26).

Features of an earlier design can be supplemented by additional features that 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 (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 25-30).

#### Disclaimed features

Features of a contested Community design that are disclaimed are disregarded for the purposes of comparing the designs. This applies to the features of a contested Community design represented with broken lines, blurring, colour shading or boundaries or in any other manner making clear that protection is not sought in respect of such features (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 59-64).

In contrast, disclaimed features of an earlier registered design can be taken into account when assessing the novelty and individual character of a contested Community design under Article 25(1)(b) CDR because the earlier design is considered as a disclosure irrespective of the subject matter of protection as a Community design, and thus includes even the disclaimed features.

#### 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 will be deemed to be identical if their features differ only in immaterial details (Article 5(2) CDR).

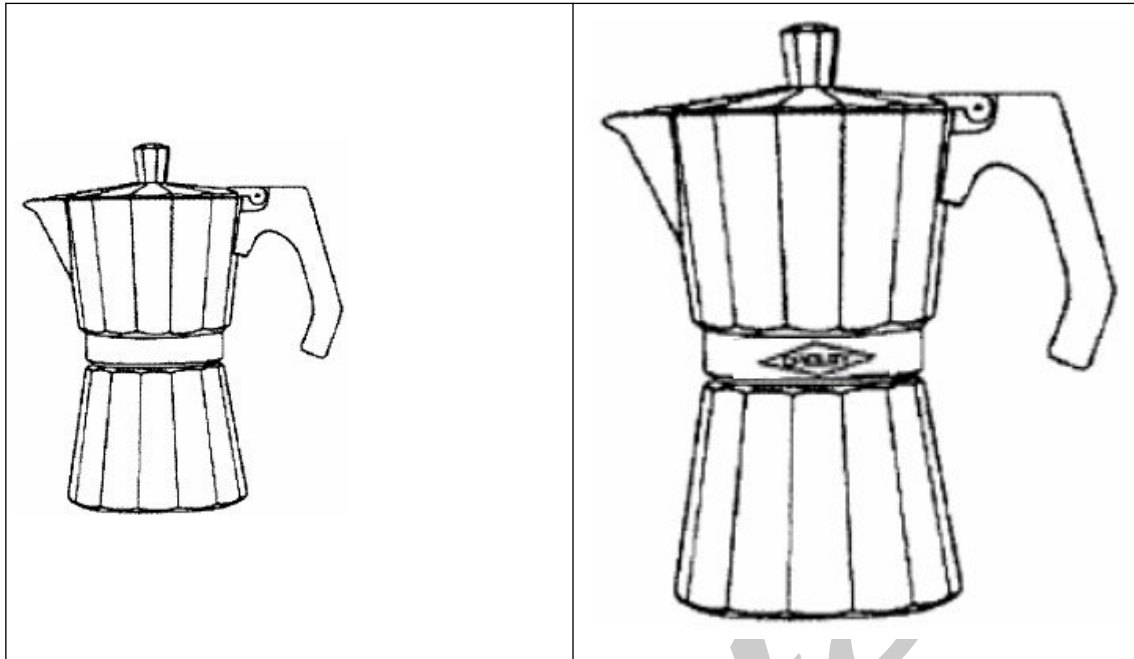
There is identity between the Community design and an earlier design where the latter discloses each and every element constituting the former. A Community design cannot be new if it is included in a more complex earlier design (25/10/2011, R 978/2010-3, PART OF SANITARY NAPKIN, § 20-21).

However, the additional or differentiating features of the Community design may be relevant for deciding whether it 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 (28/07/2009, R 921/2008-3, NAIL FILES, § 25).

Another illustration is the display, in one of the two compared designs, of a label that is so small in size that it is not perceived as a relevant feature (08/11/2006, R 216/2005-3, CAFETERA, § 23-26), as in the following example.

Contested RCD No 5 269-0001 (view No 2)	Earlier design (invented example)
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### 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 that has been made available to the public before the date of filing of 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 status of 'user' implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 46; 09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 24; 06/06/2013, T-68/11, Watch-dials, EU:T:2013:298, § 58).

The concept of 'informed user', which refers to a fictitious person, 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 has detailed technical expertise. Without being a designer or a technical expert (and therefore without necessarily knowing which aspects of the product concerned are dictated by technical function, as found in 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 48), the informed user is aware of the various designs that exist in the sector concerned, possesses a certain degree of knowledge with regard to the features that those designs normally include, and, as a result of his or her interest in the products concerned, shows a relatively high degree of attention when using them

(20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 53, 59; 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 47; 06/06/2013, T-68/11, Watch-dials, EU:T:2013:298, § 59).

In other words, the informed user is neither a designer nor a technical expert. Therefore, an informed user is a person that has some awareness of the existing designs in the sector concerned, without necessarily knowing which aspects of a product are dictated by a technical function.

The informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 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, the final users themselves (20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 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 (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 56).

When the nature of the product in which the compared designs are incorporated makes it possible, the overall impression made by these designs will be assessed on the assumption that the informed user can make a direct comparison between them (18/10/2012, C-101/11 P & C-102/11 P, Ornamentación, EU:C:2012:641, § 54-55).

The overall impression

Unless the designs compared 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 designs compared.

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 designs compared 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 (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 64-66, 72; 21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 45-46; 21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 97).

Second, when appraising the overall impression conveyed 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 question and will concentrate on features that are arbitrary or different from the norm (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 77; 28/11/2006, R 1310/2005-3, galletas, § 13; 30/07/2009, R 1734/2008-3, FORCHETTE, § 26 et seq.).

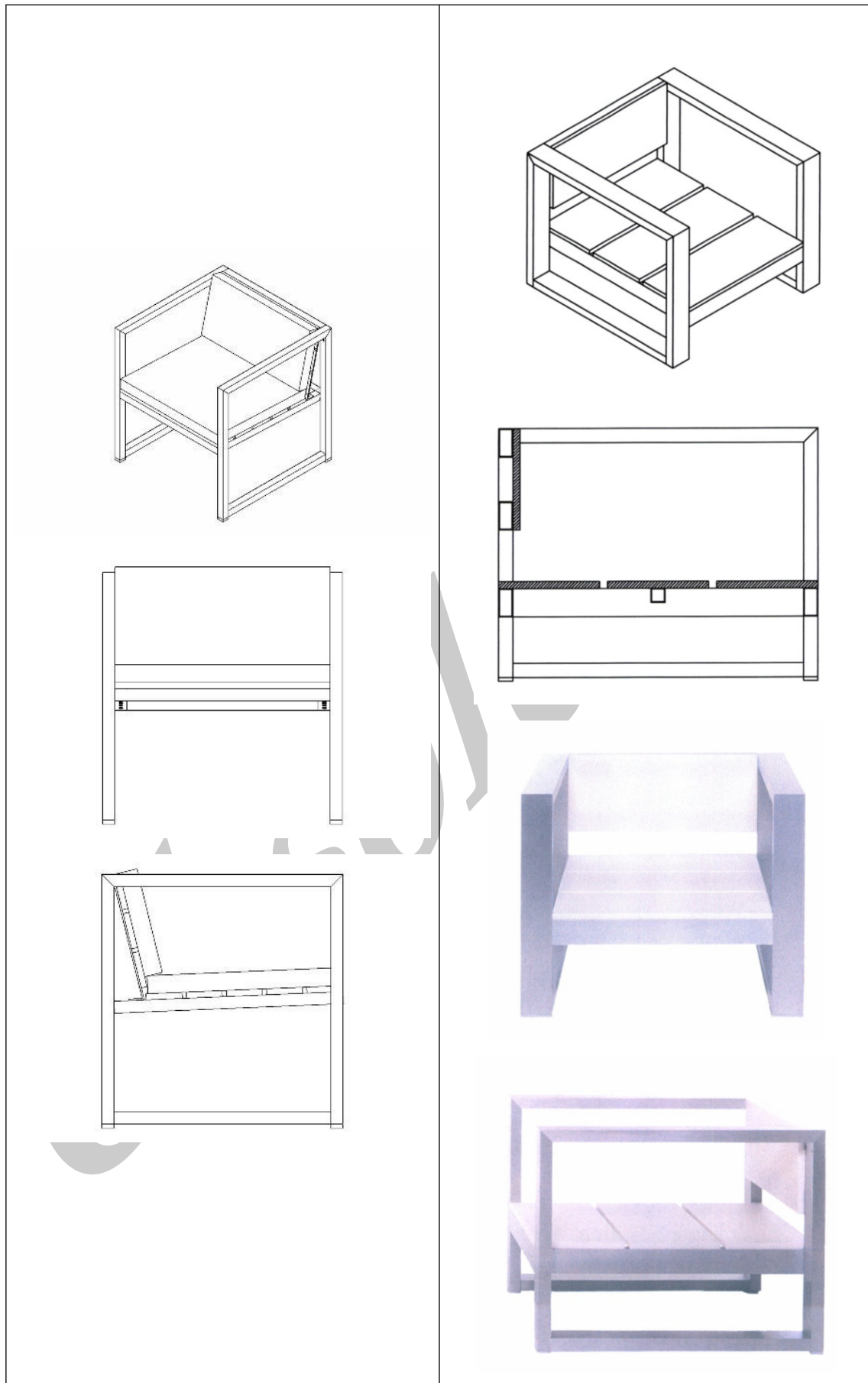
Third, similarities affecting features in respect of which the designer enjoyed a limited degree of freedom will have only minor importance in the overall impression produced by those designs on the informed user (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 72).

Fourth, when familiar with a saturation of the prior art due to the density of the existing design corpus, the informed user may be more sensitive to even minor differences between the designs that may thus produce a different overall impression (13/11/2012, T-83/11 & T-84/11, Radiatori per riscaldamento, EU:T:2012:592, § 81; 12/03/2014, T-315/12, Radiatori per riscaldamento, EU:T:2014:115, § 87). In order to prove the actual impact of such saturation on the informed user's perception, the holder of the contested RCD must present sufficient evidence of the existing design corpus and its density at the date of filing of the contested RCD or its priority date (10/10/2014, R 1272/2013-3, RADIATORI PER RISCALDAMENTO, § 36, 47; 09/12/2014, R 1643/2014-3, Radiatori per riscaldamento, § 51).

To illustrate, it was held that RCD No 1 512 633-0001 created an overall impression different from that produced by the earlier design (RCD No 52 113-0001). In an area in which the designer's degree of freedom in developing his or her design is not limited by any technical or legal restraints, the General Court (GC) upheld the decision of the Board of Appeal, which had found that the differentiating features of the two designs below prevailed over their common points. In particular, the fact that the armchair of the earlier design has a rectangular rather than a 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 (04/02/2014, T-339/12, Armchairs, EU:T:2014:54, § 23-37).

According to the GC, account must be taken of the difference between the designs at issue as regards the angle of the backrest and the seat of the armchair represented in the contested design, bearing in mind that the overall impression produced on the informed user must necessarily be determined in the light of the manner in which the product in question is used. Since an inclined backrest and seat will give rise to a different level of comfort from that of a straight back and seat, the use that will be made of that armchair by the circumspect user is liable to be affected thereby (04/02/2014, T-339/12, Armchairs, EU:T:2014:54, § 30).

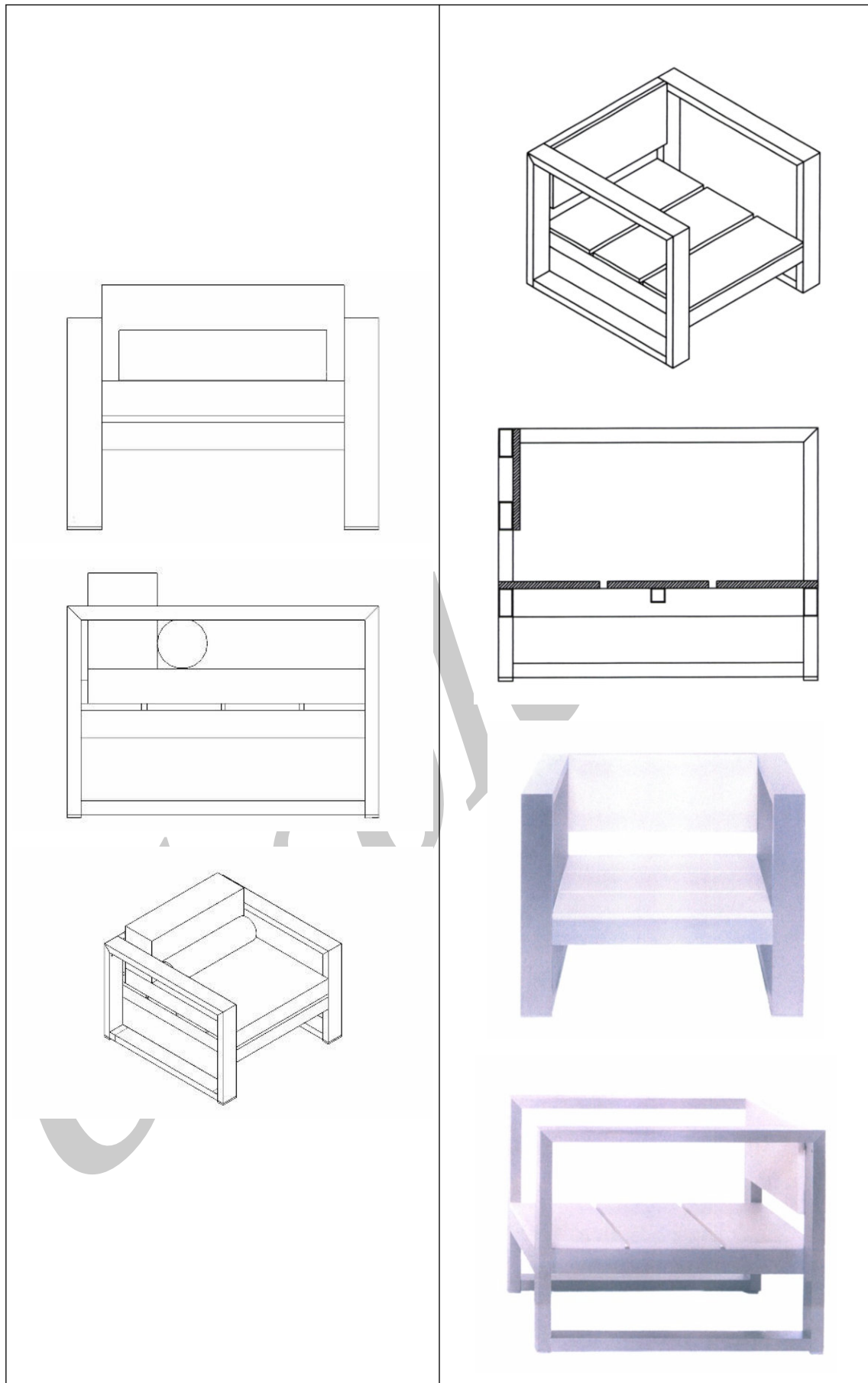
Contested RCD No 1 512 633-0001	Earlier RCD No 52 113-0001
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By contrast, the GC found that RCD No 1 512 633-0003 lacked individual character in respect of the same earlier design. It was held that the differentiating features between the designs, including 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 positioned below the mid-section of the armchairs' structure, etc.) (04/02/2014, T-357/12, Armchairs, EU:T:2014:55, § 44-60).

The GC confirmed the view taken by the Board of Appeal (27/04/2012, R 969/2011-3, ARMCHAIRS) that the cushions are less important than the structure of the armchairs when assessing the overall impression caused by the designs because the cushions are not a fixed element but can be easily separated from the main product and because they are often sold and purchased separately, at a relatively low cost compared to that of the structure of an armchair. The informed user perceives the cushions as a mere optional accessory. They can hardly be considered to be 'a significant part of the design'. Consequently the overall impression produced by the designs at issue is dominated by the structure of the armchairs itself and not by the cushions, which could be regarded as secondary elements (04/02/2014, T-357/12, Armchairs, EU:T:2014:54, § 37, 38).

Contested RCD No 1 512 633-0003	Earlier RCD No 52 113-0001
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### 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 the product belongs. The Invalidity Division will take into account the indication of the product(s) in which the design is intended to be incorporated or to which it is intended to be applied (Article 36(2) CDR), as well as the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 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 (13/11/2012, T-83/11 & T-84/11, Radiatori per riscaldamento, EU:T:2012:592, § 44).

The greater the designer's freedom in developing the challenged design, the less likely it is that minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user. Conversely, 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 (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 67, 72). Therefore, if the designer enjoys a high degree of freedom in developing a design, this reinforces the conclusion that the designs that do not have significant differences produce the same overall impression on an informed user (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 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 possible variations in the positioning of such features and in the general appearance of the product itself (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 69; 06/10/2011, T-246/10, Reductores, EU:T:2011:578, § 21-22; 09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 37).

The degree of freedom of the designer is not affected by the fact that similar designs coexist on the market and form a 'general trend' or coexist on the registers of Industrial Property Offices (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 58; 01/06/2012, R 89/2011-3, Sacacorchos, § 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 that 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 European Union, 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, the design does not produce on the informed user a different overall impression from that produced by the prior design relied on (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 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) in conjunction with Article 6 CDR.

The Invalidity 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 (by analogy, 29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 94-95) (see paragraph 4.1.6.2 above).

## **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 European Union or the law of the Member State governing that sign confers on the holder of the sign the right to prohibit such use (Article 25(1)(e) CDR).

### **5.7.1 Distinctive sign and right to prohibit use**

The notion of a 'distinctive sign' encompasses registered trade marks as well as all signs that could be relied on in the context of Article 8(4) and 8(6) EUTMR (see the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) and 8(6) EUTMR, paragraph 3.2, Types of rights falling under Article 8(4) EUTMR).

In accordance with the practice under Article 8(4) and 8(6) EUTMR, the applicant may also rely on provisions of national law on the prohibition of a later registration (see the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) and 8(6) EUTMR, paragraph 3.5.1, The right of prohibiting use).

The applicant must establish only that it has a right to prohibit use of the subsequent Community design. It cannot be required to establish that such right has been exercised; in other words, that the applicant has actually been able to prohibit such use (by analogy, 29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 191).

### **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 features omitted or added 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 (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 50-52; 25/04/2013, T-55/12, Cleaning devices, EU:T:2013:219, § 23; 09/08/11, R 1838/2010-3, INSTRUMENTS FOR WRITING, § 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 (18/09/2007, R 137/2007-3, Containers, § 20).

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

Where an application for invalidity is based on a right held to an earlier European Union trade mark, it is not necessary to submit the law and case-law relating to European Union trade marks in order to substantiate such earlier right under Article 8(1)(b) or Article 8(5) EUTMR; the same applies if the applicant invokes an earlier national registered mark.

Where the earlier distinctive sign is a sign that could be relied on in the context of Article 8(4) and 8(6) EUTMR, an application must, pursuant to Article 28(1)(b)(vi) CDIR, 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 (the principles established in the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) and 8(6) EUTMR, paragraph 4, Proof of the applicable law governing the sign will apply).

### **5.7.4 Examination by the Invalidity Division**

The examination is carried out in accordance with the law governing the earlier distinctive sign.

Where the earlier distinctive sign is a European Union trade mark, the Invalidity Division will apply the principles established in the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, and Section 5, Trade Marks with Reputation.

Where the earlier distinctive sign is a registered national trade mark, the Invalidity Division will apply the same principles (03/10/2017, T-695/15, Comfit boxes, containers, EU:T:2017:684, § 29).

For the purpose of applying these principles, the Invalidity Division will assume that the contested Community design or an element used in the contested design will be perceived by the relevant public as a sign capable of being used 'for' or 'in relation to' goods or services (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 107; 25/04/2013, T-55/12, Cleaning devices, EU:T:2013:219, § 39 and 42).

The Invalidity Division will examine for which goods the contested Community design is intended to be used (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 108). For the purpose of determining whether these goods and services are identical or similar, the Invalidity Division will take into account the indication of the product(s) in which the design is intended to be incorporated or to which it is intended to be applied (Article 36(2) CDR), and also the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56; 07/11/11, R 1148/2010-3, PACKAGING, § 34-37).

Where the Community design is intended to be incorporated in two-dimensional 'logos', the Invalidity 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 (03/05/2007, R 609/2006-3, logo MIDAS, § 27).

Where the earlier distinctive sign is a sign that could be relied on in the context of Article 8(4) and 8(6) EUTMR, the Invalidity Division will apply the corresponding law as explained in the Guidelines, Part C, Opposition, Section 4, Rights under Article 8(4) and 8(6) EUTMR.

## **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 unauthorised use of a work protected under the copyright law of a Member State (Article 25(1)(f) CDR).

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

Apart from the elements mentioned under paragraphs 3.5 and 3.9.2 above, an application must, pursuant to Article 28(1)(b)(vi) CDIR 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 (by analogy, 05/07/2011, C-263/09 P, Elio Fiorucci, EU:C:2011:452; 23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 52); and
- particulars showing that the applicant acquired the rights to the work protected under the copyright law relied on before the filing date or the priority date of the

Community design (23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 47); and

- particulars showing that the applicant satisfies the necessary conditions, in accordance with that law, to have the Community design invalidated or its use prohibited by virtue of its earlier right.

### **5.8.2 Examination by the Invalidity Division**

The object of the examination is to ascertain whether the applicant for a declaration of invalidity is the holder of the copyright invoked and whether unauthorised use of a work protected by the copyright legislation of a Member State, as interpreted by the courts of that Member State, has occurred (23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 52; 17/10/2013, R 781/2012-3, CHILDREN'S CHAIRS, § 27, 43).

It should be noted that Article 25(1)(f) CDR does not apply to cases in which ownership of the Community design is contested, in particular when the invalidity applicant's essential argument is that the Community design was created not by the registered holder but by the invalidity applicant or by its employee. The Office has no jurisdiction to determine which of the parties is the rightful owner of the contested Community design since such jurisdiction lies with national courts (11/02/2008, R 64/2007-3, Loudspeakers, § 18-19).

### **5.9 Improper use of flags and other symbols**

A Community design will be declared invalid if it constitutes an improper use of any of the items listed in Article 6ter of the Paris Convention, or of badges, emblems and escutcheons other than those covered by the said Article 6ter that are of particular public interest in a Member State (Article 25(1)(g) CDR).

The items covered by Article 6ter are the following (see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal):

- armorial bearings, flags, other emblems, official signs and hallmarks that belong to states and have been communicated to WIPO, although, in the case of flags, such communication is not mandatory;
- armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations that have been communicated to WIPO, with the exception of those already the subject of international agreements for ensuring their protection (see, for example, the Geneva Convention for the Amelioration of the Condition of the Wounded and Sick in Armed Forces of 12/08/1949, Article 44 of which protects the emblems of the Red Cross on a white ground, the words 'Red Cross' or 'Geneva Cross', and analogous emblems).

Badges, emblems and escutcheons other than those covered by Article 6ter and which are of particular public interest in a Member State could include, for example, religious

symbols, political symbols or symbols of public bodies or administrations such as provinces or municipalities.

### **5.9.1 Substantiation of the application under Article 25(1)(g) CDR (flags and other symbols)**

Apart from the requirements mentioned under paragraphs 3.5 and 3.9.2 above, when an item that is not listed in Article 6ter is invoked, the application must, pursuant to Article 28(1)(b)(vi) CDIR, show that such item is of particular public interest in a Member State.

### **5.9.2 Examination by the Invalidity Division**

The object of the examination is to ascertain whether the applicant for a declaration of invalidity is the person or entity affected by the use and whether the Community design constitutes an improper use of one of the symbols covered by Article 25(1)(g) CDR as listed above.

## **5.10 Partial invalidity**

According to Article 25(6) CDR, a registered Community design that 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.

A 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 which makes clear by means, inter alia, of broken lines 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) CDIR).

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 that constitutes a component part of a complex product, and the features removed or disclaimed are invisible during normal use of this complex product (Article 4(2) CDR); or

- where the features removed or disclaimed are dictated by a technical function or for the purposes of interconnection (Article 8(1) and (2) CDR); or
- where the features removed or disclaimed are so insignificant in view of their size or importance that they are likely to pass unnoticed.

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

### **5.11 Grounds for invalidity that become applicable merely because of the accession of a new Member State**

See the Guidelines, Examination of Applications for Registered Community Designs, paragraph 13, Enlargement and the Registered Community Design.

## **6 Termination of the Proceedings**

### **6.1 Termination of proceedings without a decision on the merits**

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

1. the applicant withdraws its application as a result of an 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 above); or
4. the Invalidity Division suspended a number of applications for a declaration of invalidity relating to the same registered Community design. These applications will 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 a decision on the merits.

## **6.2 Decision on costs**

### **6.2.1 Cases where a decision on costs is 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 unless the parties have agreed on the costs as outlined below.

### **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). The Invalidity Division will apply the principles explained in the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 5.5.2.1, Agreement on costs.

If no indication is given as to whether the parties have agreed on the costs, the Invalidity Division will take a decision on costs at the same time as confirming the withdrawal of the application. If the parties inform the Invalidity Division that they have reached an agreement on costs after the withdrawal of the application, the decision on costs already issued will not be revised by the Invalidity Division. It is, however, left to the parties to respect the agreement and not to enforce the Invalidity Division's decision on costs.

#### **6.2.2.2 Apportionment of costs**

The general rule is that the losing party, or the party that terminates the proceedings by surrendering the Community design, maintaining it in an amended form or withdrawing the application, must 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 for each party to bear 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 which the winning party is entitled to claim is mentioned in 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 insofar as represented in the invalidity proceedings by a professional representative within the meaning of Article 77 CDR. A winning party no longer represented by a professional representative at the time of taking a decision is also entitled to 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 euros, 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 costs to be paid (Article 70(6) CDR). A bill of costs, with supporting evidence, must 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 1 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 invalidity decision has been annulled, wholly or partly, and the case is remitted by the Boards of Appeal, the situation will be the following:

- The first decision (which was appealed) does not become final, not even as regards apportionment or fixing of costs.
- As regards the costs of the invalidity proceedings, one single decision on the apportionment and on the fixing of costs must be taken for the invalidity 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 applies in addition to the representation costs for the invalidity proceedings.

## **6.3 Correction of mistakes and entry in the Register**

### **6.3.1 Correction of mistakes**

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

### **6.3.2 Entry in the Register**

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

## **7 Appeal**

### **7.1 Right to appeal**

Any party to invalidity proceedings has the right to appeal against a decision that affects it adversely. A decision that 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 2 months from the date of receipt of the notification of the decision. Appeals have suspensive effect (Article 55 CDR).

### **7.2 Interlocutory 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 department whose decision is appealed considers the appeal to be admissible and well founded, it will rectify its decision. However, this will not apply where the appellant is opposed by other parties to the proceedings (Article 58(1) CDR). Therefore, revision can only be granted if the application for a declaration of invalidity is rejected as inadmissible (or deemed not to have been filed) pursuant to Article 30 CDR.

If the decision is not rectified within 1 month of 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 principles applying to revision in respect of decisions adopted by the Opposition Division apply mutatis mutandis to the decisions adopted by the Invalidity Division in the admissibility examination of the application (see the Guidelines, Part A, General Rules, Section 7, Revision).

Obsolete