

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

The Boards of Appeal

DECISION
of the Third Board of Appeal
of 18 September 2007

In Case R 137/2007-3

Zygmunt Piotrowski

Ul. Keniga 4 M. 48

PL-02-495 Warsaw

Poland

Community design proprietor / Appellant

v

COMPAGNIE GERVAIS DANONE (société anonyme)

126-130, rue Jules Guesde

F-92300 Levallois-Perret

France

Cancellation applicant / Respondent

represented by KULIKOWSKA I KULIKOWSKI SP. J, ul. Kwiatowa 21/3, PL-02-539 Warsaw, Poland

APPEAL relating to Invalidity Proceedings No ICD 2954 (Registered Community Design No 339 312 - 0003)

THE THIRD BOARD OF APPEAL

composed of Th. Margellos (Chairperson and Rapporteur), D.T. Keeling (Member) and I. Mayer (Member)

Registrar: N. Semjevski

gives the following

Decision

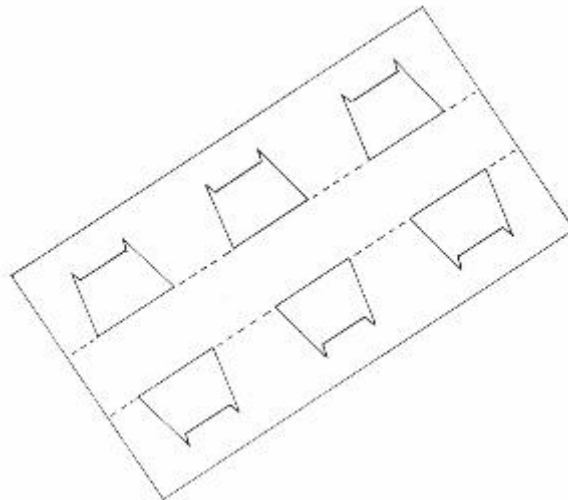
Summary of the facts

- 1 Zygmunt Piotrowski ('the appellant') is the holder of Registered Community Design No 339 312 - 0003 ('the contested RCD'), the application for which was received on 5 May 2005 and accorded the priority of a Polish industrial design filed on 7 February 2005. It is registered for the product 'containers' and 'packages' and represented as follows:

Fig. a:



Fig. b:



- 2 The documents in support of the priority claim described the design as a 'pasteboard tape with latching openings made from multi-ply cardboard, designed for holding together consumer packages, particularly bottles or cups into string sets of any length, which is spatially formed into a handling clamp and contains a cover separated by two folding lines from side walls where along both folding lines are

cut-outs symmetrically disposed, each of which is provided with a latch wing, as depicted in the drawing where:

...

- [Fig. b above] represents a pasteboard tape blank section with latching openings, as developed on a plane, in the third embodiment;
- [Fig. a above] represents a pasteboard tape blank section with latching openings, which is spatially formed into a shape of the bottle clamp, with the enlarged cut-out openings in the side walls, which is visualised, in the perspective view, in the third embodiment’.

3 On 17 July 2006, COMPAGNIE GERVAIS DANONE (société anonyme) (‘the respondent’) filed an application for a declaration of invalidity against the contested RCD pursuant to Article 25(1)(e) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs (‘CDR’) (OJ EC 2002 No L 3, p 1). The respondent invoked the exclusive rights conferred by various trade mark registrations and claimed that use in the RCD of those trade marks infringed its rights. The earlier registrations in question being:

- International trade mark registration No 649 535 of the figurative mark below registered on 1 December 1995, with effect in the designated Member States of Austria, the Benelux, the Czech Republic, Spain, Germany, Hungary, Italy, Latvia, Poland, Slovenia, Slovakia and Portugal for products in Classes 5, 29, 30, 31 and 32. Its origin was French registration No 95 574 013 of 1 June 1995.



- Polish registration No 144 971 filed on 20 October 1999 and registered on 22 May 2003 of the word mark below for goods and services in Classes 3, 16, 18, 21, 25, 28, 32, 33, 35, 36, 41, 42, 43 and 44.

DANONE

- Polish registration No 267 378 filed on 14 July 2003 and registered on 11 August 2006 of the word mark below for goods in Classes 29 and 32

DANVIVA

- 4 Invited by the Office to comment, the Community design proprietor filed observations on 2 October 2006, arguing as follows:
 - The contested design is a ‘pasteboard multi package container’. A detailed description of the design is contained in the priority certificate accompanying the application. It does not contain the words ‘DANONE’ or ‘ACTIMEL’ and the products which fill up the packaging are not part of the design.
 - If the products covered by the earlier marks were to be used in the design, the respondent would be able to rely on Article 12(c) CTMR.
 - The cancellation applicant acted in bad faith when filing the application for a declaration of invalidity and seeks in effect to appropriate its design.
- 5 The respondent was not invited to file observations. The Community design proprietor’s observations of 2 October 2006 were communicated to it for information only.
- 6 On 20 December 2006, an Invalidity Division of the Office issued a decision (‘the contested decision’) declaring the contested RCD invalid pursuant to Article 25(1)(e) CDR and ordered the appellant to bear the costs examining solely the application for cancellation based on International registration No 649 535. The reasoning in the contested decision may be summarized as follows:
 - Where a sign is registered as a trade mark in a Member State and the trade mark is in force, it is presumed that it is a distinctive sign within the meaning of Article 25(1)(e) CDR.
 - International registration No 649 535 is for a figurative mark comprising the verbal element ‘DANONE’.
 - The contested design does not contain a disclaimer. It is, therefore, defined by all features shown in all views of the design representation. The figurative mark ‘DANONE’ protected by the earlier trade mark is part of the contested design. Consequently, a sign identical to the earlier trade mark is used in the contested design.
 - The use of the earlier sign is use in the course of trade, since the purpose of registering a design is its use for commercial purposes.
 - It follows that the cancellation applicant has the right to prohibit use of the sign in the contested pursuant to Article 25(1)(e) CDR.
- 7 On 17 January 2007, the Community design proprietor filed a notice of appeal against the contested decision together with a statement setting out the grounds of the appeal.
- 8 On 30 March 2007, the respondent filed observations in response.

- 9 On 8 May 2007, the appellant replied stating that he did not wish to make further comments.

Submissions and arguments of the parties

- 10 The appellant requests the Board to annul the contested decision and maintain the contested design on the register. His arguments may be summarized as follows:
- It is clear from the priority documents accompanying the design application that the ‘pasteboard tape blank section with latching openings as developed on a plane’ is the design and that the product bearing the ‘DANONE’ marking is displayed only by way of example to show how it combines with that design.
 - Fig. b above shows the outline and folds of the pasteboard sheet and does not incorporate any of the respondent’s trade marks.
 - He has acted in good faith for and on behalf of the respondent.
- 11 The respondent maintains its position on the invalidity claim and rejects as false the allegation that the appellant has acted on its behalf.

Reasons

- 12 The appeal complies with Articles 55 to 57 CDR and Article 34(1)(c) and (2) of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs (‘CDIR’) (OJ EC 2002 No L 341, p. 28). It is therefore admissible.

Relevant provisions

- 13 Article 25(1)(e) CDR provides that a Community design may be declared invalid ‘if a distinctive sign is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use’.
- 14 In the contested decision, the Designs Division examined solely the cancellation application based on International Registration No 649 535 taking effect in the designated Member States of Austria, the Benelux, the Czech Republic, Spain, Germany, Hungary, Italy, Latvia, Poland, Slovenia, Slovakia and Portugal for products in Classes 5, 29, 30, 31 and 32, the origin of which was French registration No 95 574 013 of 1 June 1995. The Board takes into account not only that International registration but also Polish registration of the word mark ‘DANVIVA’ filed on 14 July 2003 and registered on 11 August 2006. It is natural that they should be considered together since the figurative mark ‘DANONE’ is the house mark and ‘DANVIVA’ the product identifier.
- 15 Article 2 of the First Council Directive No 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (‘TMD’) headed

‘Signs of which a trade mark may consist’ provides that a ‘trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings’.

16 Article 5 TMD entitled ‘Rights conferred by a trade mark’ provides in material part:

‘1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade.

- a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;
- b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark.

...

3. The following, *inter alia*, may be prohibited under paragraphs 1 and 2

- (a) affixing the sign to the goods or to the packaging thereof;
- (b) offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or supplying services there under;
- (c) importing or exporting the goods under the sign;
- (d) using the sign on business papers and in advertising.’

Use of a distinctive sign in a subsequent design

17 In the appeal, it is not disputed that the above International registration of the trade mark of the sign ‘DANONE’ and the Polish registration of the word mark ‘DANVIVA’ are distinctive signs within the meaning of Article 25(1)(e) CDR,

18 Nor is it disputed that those earlier signs feature prominently in the representation of the contested design (Fig. a above) on packaging typically used for some milk based food products.

19 The appellant referring to the description in the documents submitted in support of the priority claim based on the Polish design, nonetheless, argues that those trade marks do not constitute a part of the design and their depiction on the container

serves only to illustrate by way of example the design of its packaging for holding such containers together.

- 20 Firstly, in that regard it is to be noted that a detailed description of the design does not appear in the contested design nor in the Polish priority documents is there a disclaimer to the effect that that the design does not embrace the respondent's 'DANONE' and 'DANVIVA' signs. It is true that in the priority documents there is a lengthy description of the design. That description, however, merely explains the representations and contains no express indication to the effect that the 'pasteboard tape with latching openings' design does not incorporate the respondent's signs. Therefore, as the contested decision found, the subject matter of the contested design is defined by all features in all views of the representation of the design.
- 21 Accordingly, the Board considers that the contested design includes the respondent's signs.

Right to prevent use

- 22 As is clear from the Court's case-law (see judgments of the Court of 12 November 2002 in Case C-206/01 *Arsenal Football Club plc v Matthew Reed* [2002] ECR I-10273; of 16 November 2004 in Case C-245/02 *Anheuser-Busch Inc. v Budějovický Budvar, národní podnik* ('Budweiser') [2004] ECR I-10989; and of 25 January 2007 in Case C-48/05 *Adam Opel AG v Autec AG* ('Opel') [2007] ECR publication pending), the proprietor of a registered mark may prevent the use of a sign by a third party which is identical to his mark under Article 5(1)(a) TMD only if the following four conditions are satisfied:
- that use must be in the course of trade;
 - it must be without the consent of the proprietor of the mark;
 - it must be in respect of goods or services which are identical to those for which the mark is registered, and
 - it must affect or be liable to affect the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods or service.
- 23 The present design which may be applied to all products and packaging is obviously intended to be used in the course of trade.
- 24 Next, no evidence has been produced that the contested design has been used or applied for with the consent of the cancellation applicant.
- 25 Thirdly, since products covered by the respondent's international trade mark registration may be packaged in the same containers and the contested design may be applied to those same products, the conflicting goods should be considered identical.

- 26 In those circumstances, the use of the respondent's identical signs in the contested design on identical products is liable to jeopardise the guarantee of origin which constitutes the essential function of the earlier trade marks 'DANONE' and 'DANVIVA' and amounts to an unauthorised use by the appellant, which the respondent is entitled to prevent, under Article 5(1)(a) TMD pursuant to Article 25(1)(e) CDR.
- 27 For the above reasons, the appeal is dismissed and the contested decision declaring the registered Community design invalid is upheld.

Costs

- 28 Since the appeal has been unsuccessful, the appellant must be ordered to bear the fees and costs incurred by the respondent, in accordance with Article 70(1) CDR.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the appellant to bear the fees and costs incurred by the respondent.**

Th. Margellos

D.T. Keeling

I. Mayer

Registrar:

N. Semjevski