

## IV. The application of Art. 25(1)(e) CDR and its implications

### A. *The procedure of invalidation of a Community design*

#### 1. Applicant and forum

According to Art. 52 and Art. 25(1)(e) CDR it is solely the holder of a prior distinctive sign that has standing in the invalidation proceedings, which he is obliged to prove by submitting relevant documents, such as a registration certificate.<sup>289</sup> In the case of unregistered signs the applicant will have to provide evidence as to the existence of his right to the distinctive sign. He can initiate the invalidation in OHIM – as regards a registered Community design, or in a Community design court<sup>290</sup> – by way of counterclaim for invalidation of a registered or unregistered design when he has been sued for infringement of that design, or by a stand-alone action for invalidation of an unregistered Community design.<sup>291</sup>

#### 2. Applicable law and procedural challenges

The substantive law relied upon in the invalidation proceedings depends on the distinctive sign that is being invoked against the Community design. In the cases where the application is based on the right to a Community trade mark it will be the provisions on the scope of protection stipulated in the CTMR.<sup>292</sup> When a national right to a distinctive sign is relied upon – the OHIM or the Community design court will need to apply the provisions of the relevant national law.<sup>293</sup> In the OHIM it is the duty of the applicant to substantiate both the facts<sup>294</sup> and the legal ground in the same way as he would have done in the national court and he is

289 Rule 28(1)(b)(iii) CDR.

290 Art. 80 CDR, Art. 81(c)-(d) CDR.

291 Art. 24(1), (3) CDR.

292 Art. 9 CTMR.

293 as in GC Case T-148/08 - *Beifa Group Co. Ltd. v OHIM*, 2010 ECR II-01681.

294 Art. 63 CDR, including the existence and validity of the earlier right and that he has the right to prohibit the use of the subsequent design (but not that he has actually prohibited it), as stipulated in the *Community Design Invalidation Manual*, *supra* note 15, C.7.3.