

**Fuente: Texto original del fallo aportado por UAIPIT-Portal Internacional de la
Universidad de Alicante en PI y SI- <http://www.uaipit.com>.**

JUDGMENT OF THE COURT (First Chamber)

16 February 2012

(Regulation (EC) No 6/2002 – Article 19(1) – Community designs – Infringement or threatened infringement – Definition of ‘third parties’)

In Case C-488/10,

REFERENCE for a preliminary ruling under Article 267 TFEU from the Juzgado de lo Mercantil nº 1 de Alicante y nº 1 de Marca Comunitaria (Spain), made by decision of 15 September 2010, received at the Court on 11 October 2010, in the proceedings

Celaya Empananza y Galdos Internacional SA

v

Proyectos Integrales de Balizamiento SL,

THE COURT (First Chamber),

composed of A. Tizzano, President of the Chamber, M. Safjan, M. Ilešič (Rapporteur), E. Levits and M. Berger, Judges,

Advocate General: P. Mengozzi,

Registrar: K. Malacek, Administrator,

having regard to the written procedure and further to the hearing on 14 September 2011,

after considering the observations submitted on behalf of:

- Celaya Empananza y Galdos Internacional SA, by J.L. Gracia Albero, F. Rodríguez Domínguez, F. Miazetto and S. Ferrandis González, abogados,
- the Polish Government, by M. Laszuk, I. Źarski and M. Szpunar, acting as Agents,
- the European Commission, by F. Wenzel Bulst and R. Vidal Puig, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 8 November 2011,

gives the following

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Judgment

1 This reference for a preliminary ruling concerns the interpretation of Article 19(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1) ('the Regulation').

2 The reference was made in proceedings between Celaya Emparanza y Galdos Internacional SA ('Cegasa') and Proyectos Integrales de Balizamiento SL ('PROIN') concerning an action alleging infringement brought by Cegasa.

Legal context

3 It is apparent from recital 5 in the preamble thereto that the objective of the Regulation is 'the creation of a Community design which is directly applicable in each Member State' in order 'to obtain ... one design right for one area encompassing all Member States'.

4 Recital 18 in the preamble to the Regulation is worded as follows:

'A registered Community design requires the creation and maintenance of a register in which will be registered all those applications which comply with formal conditions and which have been accorded a date of filing. This registration system should in principle not be based upon substantive examination as to compliance with requirements for protection prior to registration, thereby keeping to a minimum the registration and other procedural burdens on applicants.'

5 Article 1(2)(b) of the Regulation provides that a design is to be protected 'by a "registered Community design", if registered in the manner provided for in this Regulation'.

6 Article 1(3) of the Regulation is worded as follows:

'A Community design shall have a unitary character. It shall have equal effect throughout the Community. It shall not be registered, transferred or surrendered or be the subject of a decision declaring it invalid, nor shall its use be prohibited, save in respect of the whole Community. This principle and its implications shall apply unless otherwise provided in this Regulation.'

7 Article 3(a) of the Regulation provides as follows:

'(a) "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation'.

8 Article 4(1) of the Regulation is worded as follows:

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‘A design shall be protected by a Community design to the extent that it is new and has individual character.’

9 Article 5(1)(b) of the Regulation provides that a registered Community design is to be considered to be new if no identical design has been made available to the public ‘before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority’.

10 Article 6(1)(b) of the Regulation provides that a registered Community design is to 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 which has been made available to the public ‘before the date of filing the application for registration or, if a priority is claimed, the date of priority’.

11 Article 10 of the Regulation, entitled ‘Scope of protection’, provides in paragraph 1 thereof as follows:

‘The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.’

12 Article 19 of the Regulation, entitled ‘Rights conferred by the Community design’, is worded as follows:

‘1. A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

2. An unregistered Community design shall, however, confer on its holder the right to prevent the acts referred to in paragraph 1 only if the contested use results from copying the protected design.

The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

...’

13 Section 5 of Title II of the Regulation, entitled ‘Invalidity’, comprises Articles 24 to 26.

14 Article 24(1) of the Regulation provides as follows:

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‘A registered Community design shall be declared invalid on application to the Office [for Harmonisation in the Internal Market (trade marks and designs) (OHIM)] in accordance with the procedure in Titles VI and VII or by a Community design court on the basis of a counterclaim in infringement proceedings.’

15 Article 25 of the Regulation, entitled ‘Grounds for invalidity’, provides in paragraph 1(d) thereof that a Community design may be declared invalid only if, inter alia, ‘the Community design is in conflict with a prior design’.

16 Title V of the Regulation, entitled ‘Registration procedure’, comprises Articles 45 to 50.

17 Article 45 of the Regulation, entitled ‘Examination as to formal requirements for filing’, provides in paragraph 2 thereof as follows:

‘[OHIM] shall examine whether:

- (a) the application complies with the other requirements laid down in Article 36(2), (3), (4) and (5) and, in the case of a multiple application, Article 37(1) and (2);
- (b) the application meets the formal requirements laid down in the implementing regulation for the implementation of Articles 36 and 37;
- (c) the requirements of Article 77(2) are satisfied;
- (d) the requirements concerning the claim to priority are satisfied, if a priority is claimed.’

18 Article 47 of the Regulation, entitled ‘Grounds for non-registrability’, provides in paragraph 1 thereof as follows:

‘If [OHIM], in carrying out the examination pursuant to Article 45, notices that the design for which protection is sought:

- (a) does not correspond to the definition under Article 3(a); or
- (b) is contrary to public policy or to accepted principles of morality, it shall refuse the application.’

19 Article 48 of the Regulation provides that ‘[i]f the requirements that an application for a registered Community design must satisfy have been fulfilled and to the extent that the application has not been refused by virtue of Article 47, [OHIM] shall register the application in the Community design Register as a registered Community design’.

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20 Title VI of the Regulation, entitled ‘Surrender and invalidity of the registered Community design’, comprises Articles 51 to 54.

21 Article 52 of the Regulation, entitled ‘Application for a declaration of invalidity’, states in paragraph 1 thereof that ‘any natural or legal person, as well as a public authority empowered to do so, may submit to [OHIM] an application for a declaration of invalidity of a registered Community design’.

22 Title IX of the Regulation, entitled ‘Jurisdiction and procedure in legal actions relating to Community designs’, contains inter alia Section 2, entitled ‘Disputes concerning the infringement and validity of Community designs’, which comprises Articles 80 to 92 of the Regulation.

23 Article 81 of the Regulation is worded as follows:

‘The Community design courts shall have exclusive jurisdiction:

- (a) for infringement actions and – if they are permitted under national law – actions in respect of threatened infringement of Community designs;
- (b) for actions for declaration of non-infringement of Community designs, if they are permitted under national law;
- (c) for actions for a declaration of invalidity of an unregistered Community design;
- (d) for counterclaims for a declaration of invalidity of a Community design raised in connection with actions under (a).’

24 Article 85 of the Regulation, entitled ‘Presumption of validity – defence as to the merits’, provides in paragraph 1 thereof as follows:

‘In proceedings in respect of an infringement action or an action for threatened infringement of a registered Community design, the Community design court shall treat the Community design as valid. Validity may be challenged only with a counterclaim for a declaration of invalidity. However, a plea relating to the invalidity of a Community design, submitted otherwise than by way of counterclaim, shall be admissible in so far as the defendant claims that the Community design could be declared invalid on account of an earlier national design right, within the meaning of Article 25(1)(d), belonging to him.’

The dispute in the main proceedings and the questions referred for a preliminary ruling

25 Cegasa is the holder of Community registered design No 00421649-0001, consisting of a beacon-like marker used for traffic signalling purposes. The design was

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lodged with OHIM on 26 October 2005 and published in the Register of Community Designs on 13 December 2005.

26 At the end of 2007, PROIN marketed the marker H-75. Taking the view that that marker did not give an overall impression different from that of registered Community design No 00421649-0001, Cegasa served an extra-judicial cease-and-desist demand upon PROIN in January 2008. The latter denied any infringement but none the less gave an undertaking to make changes to its design. Cegasa repeated its cease-and-desist demand to PROIN in March 2008.

27 On 11 April 2008, PROIN lodged with OHIM an application for registration of a Community design, consisting of a beacon-like marker used for traffic signalling purposes. That design was published in the Register of Community Designs on 7 May 2008 under No 000915426-001.

28 The referring court considers that the cylindrical marker marketed by PROIN is a reproduction of Community design No 000421649-0001 registered by Cegasa because an informed user does not receive a different overall impression of that marker from that given by the design registered by Cegasa. It points out that Cegasa has not, however, made any application for a declaration of invalidity of registered Community design No 000915426-001.

29 Cegasa has, on the other hand, brought proceedings before the Juzgado de lo Mercantil n° 1 de Alicante y n° 1 de Marca Comunitaria alleging infringement of a registered Community design, claiming that the offering, promoting, advertising, stocking, marketing and distributing of the H-75 signalling device by PROIN constitute a breach of the rights conferred on it by the Regulation as holder of registered Community design No 000421649-0001.

30 PROIN opposed the infringement proceedings. It submitted, inter alia, that Cegasa lacks *locus standi* to bring proceedings alleging infringement of its registered Community design because the marker marketed by PROIN is a reproduction of a Community design that is also registered. It thus argued that, until such time as the registration of that design is cancelled, its holder enjoys a right of use under the Regulation, so that the exercise of that right cannot be deemed to be an infringement.

31 In those circumstances, the Juzgado de lo Mercantil n°1 de Alicante y n°1 de Marca Comunitaria decided to stay the proceedings and refer the following questions to the Court for a preliminary ruling:

‘1. In proceedings for infringement of the exclusive right conferred by a registered Community design, does the right to prevent the use thereof by third parties provided for in Article 19(1) of [the] Regulation ... extend to any third party who uses another design that does not produce on informed users a different overall impression or, on the

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contrary, is a third party who uses a later Community design registered in his name excluded until such time as that design is declared invalid?

2. Is the answer to the first question unconnected with the intention of the third party or does it depend on his conduct, a decisive point being whether the third party applied for and registered the later Community design after receiving an extra-judicial demand from the holder of the earlier Community design calling on him to cease marketing the product on the ground that it infringes rights deriving from that earlier design?’

Consideration of the questions referred

Question 1

32 It should be noted at the outset that the Regulation does not contain any rule which refers expressly to whether it is possible for the holder of an earlier registered Community design to bring infringement proceedings against the holder of a later registered Community design.

33 However, it is clear that the wording of Article 19(1) of the Regulation does not make any distinction on the basis of whether the third party is the holder of a registered Community design or not.

34 Thus, that provision states that a registered Community design is to confer on its holder the exclusive right to use it and to prevent ‘any third party’ not having his consent from using it.

35 Similarly, Article 10(1) of the Regulation provides that the scope of the protection conferred by a Community design is to include ‘any design which does not produce on the informed user a different overall impression’.

36 It is apparent from those provisions that the Regulation does not preclude the holder of a registered Community design from bringing infringement proceedings to prevent the use of a later registered Community design which does not produce on the informed user a different overall impression.

37 It is true, as the Polish Government stated in the observations it submitted to the Court, that the holder of a later registered Community design also enjoys, in principle, an exclusive right of use of his design.

38 However, that fact cannot call into question the interpretation of the term ‘any third party’ within the meaning of Article 19(1) of the Regulation as including the third party holder of a later registered Community design.

39 It should be noted in that connection that, as submitted by the European Commission in its observations, the provisions of the Regulation must be interpreted in

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the light of the priority principle, under which the earlier registered Community design takes precedence over later registered Community designs.

40 It follows in particular from Article 4(1) of the Regulation that a design is to be protected by a Community design to the extent that it is new and has individual character. However, where two registered Community designs are in conflict with each other, the design that was registered first is deemed to have met those conditions for obtaining protection before the design that was registered second. Thus, the holder of the later registered Community design may be afforded the protection conferred by the Regulation only if he can demonstrate that the earlier registered Community design fails to meet one of those conditions, by seeking a declaration of invalidity, where appropriate by way of counterclaim.

41 In that context and as observed by the Advocate General at points 32 and 33 of his Opinion, account must be taken of the substantive features of the procedure for the registration of Community designs established by the Regulation.

42 Under that procedure, which is governed by Articles 45 to 48 of the Regulation, OHIM is to examine whether an application complies with the formal requirements for filing, as laid down in the Regulation. If the application satisfies those requirements, corresponds to the definition of a design under Article 3(a) of the Regulation and is not contrary to public policy or to accepted principles of morality, OHIM is to register the application in the Community design Register as a registered Community design.

43 That procedure therefore amounts to an essentially formal, expeditious check, which, as indicated in recital 18 of the preamble to the Regulation, does not require any substantive examination as to compliance with the requirements for protection prior to registration, and which, unlike the registration procedure under Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), does not provide for any stage during which the holder of an earlier registered design can oppose registration.

44 In those circumstances, only an interpretation of the term ‘any third party’ within the meaning of Article 19(1) of the Regulation as encompassing the third party holder of a later registered Community design is capable of ensuring attainment of the objective of effective protection of registered Community designs pursued by the Regulation, as well as the effectiveness of infringement proceedings.

45 Moreover, that conclusion is not affected by the fact that the Regulation does not confer jurisdiction on Community design courts to hear applications for a declaration of invalidity of registered Community designs and provides, in Article 85 thereof, that those courts must, in proceedings in respect of an infringement action or an action for threatened infringement, treat the registered Community design as valid.

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46 It should be noted in that regard that the Regulation makes a clear distinction, as regards actions relating to registered Community designs, between those alleging infringement and those seeking a declaration of invalidity.

47 As regards, first, actions alleging infringement, Article 81 of the Regulation confers exclusive jurisdiction to hear such disputes on Community design courts. In such actions, those courts examine solely whether the exclusive right of use conferred by the Regulation on the holder of the registered Community design has been infringed.

48 As regards, second, applications for a declaration of invalidity of registered Community designs, the Regulation opted for the centralised treatment of such actions by OHIM, although that rule is tempered by the fact that it is possible for Community design courts to hear counterclaims for a declaration of invalidity of a registered Community design raised in connection with infringement actions or actions in respect of threatened infringement.

49 The argument that any interpretation of the term ‘any third party’ within the meaning of Article 19(1) of the Regulation as encompassing the third party holder of a later registered Community design would have the effect of distorting the division of jurisdiction as between those courts and OHIM and deprive the latter’s jurisdiction in actions for a declaration of invalidity of any substance, cannot be accepted.

50 It is apparent from the characteristics set out above that actions alleging infringement and applications for a declaration of invalidity are distinguished in terms of their object and effects, so that the fact that it is possible for the holder of an earlier registered Community design to bring infringement proceedings against the holder of a later registered Community design cannot render the bringing of an application for a declaration of invalidity against the latter before OHIM devoid of any purpose.

51 Consequently, it must be concluded that, in so far as the later registered Community design, use of which is prohibited, remains valid until such time as it has been declared invalid by OHIM or a Community design court in the context of a counterclaim for a declaration of invalidity, the review system established by the Regulation is not undermined by the conclusion set out at paragraph 44 above.

52 In the light of the foregoing considerations, the answer to Question 1 is that Article 19(1) of the Regulation must be interpreted as meaning that, in a dispute relating to infringement of the exclusive right conferred by a registered Community design, the right to prevent use by third parties of the design extends to any third party who uses a design that does not produce on informed users a different overall impression, including the third party holder of a later registered Community design.

Question 2

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53 By its second question, the referring court asks, in essence, whether the answer to the first question may vary according to the intention and conduct of the third party holder of a later registered Community design.

54 The referring court alludes in particular to the situation in the main proceedings, in which PROIN registered its Community design only after it had been given formal notice by Cegasa.

55 It should be noted in that connection, first, that, as observed by all the parties concerned which have submitted observations to the Court, the scope of the rights conferred by the Regulation must be determined objectively and cannot vary according to the circumstances pertaining to the conduct of the person applying for registration of a Community design.

56 Second, as observed, in essence, by the Advocate General at point 49 of his Opinion, it is apparent from the second subparagraph of Article 19(2) of the Regulation that the European Union legislature took good faith into account in order to protect the designer who was not familiar with the unregistered design made available to the public by the holder.

57 On the other hand, it is clear that the legislature did not include considerations relating to the third party's intentions in Article 19(1) of the Regulation.

58 The answer to the second question is, therefore, that the answer to the first question is unconnected with the intention or conduct of the third party.

Costs

59 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (First Chamber) hereby rules:

1. Article 19(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted as meaning that, in a dispute relating to infringement of the exclusive right conferred by a registered Community design, the right to prevent use by third parties of the design extends to any third party who uses a design that does not produce on informed users a different overall impression, including the third party holder of a later registered Community design.

2. The answer to the first question is unconnected with the intention or conduct of the third party.

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[Signatures]

* Language of the case: Spanish.