

Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs

TITLE IX

**JURISDICTION AND PROCEDURE IN LEGAL
ACTIONS RELATING TO COMMUNITY DESIGNS**

Section 2

Disputes concerning the infringement and validity of Community designs

Article 80

Community design courts

1 The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance (Community design courts) which shall perform the functions assigned to them by this Regulation.

2 Each Member State shall communicate to the Commission not later than 6 March 2005 a list of Community design courts, indicating their names and their territorial jurisdiction.

3 Any change made after communication of the list referred to in paragraph 2 in the number, names or territorial jurisdiction of the Community design courts shall be notified without delay by the Member State concerned to the Commission.

4 The information referred to in paragraphs 2 and 3 shall be notified by the Commission to the Member States and published in the *Official Journal of the European Communities*.

5 As long as a Member State has not communicated the list as stipulated in paragraph 2, jurisdiction for any proceedings resulting from an action covered by Article 81 for which the courts of that State have jurisdiction pursuant to Article 82 shall lie with that court of the State in question which would have jurisdiction *ratione loci* and *ratione materiae* in the case of proceedings relating to a national design right of that State.

Article 81

Jurisdiction over infringement and validity

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).

Status: Point in time view as at 01/01/2007.

Changes to legislation: There are currently no known outstanding effects for the Council Regulation (EC) No 6/2002, Section 2. (See end of Document for details)

Article 82

International jurisdiction

1 Subject to the provisions of this Regulation and to any provisions of the Convention on Jurisdiction and Enforcement applicable by virtue of Article 79, proceedings in respect of the actions and claims referred to in Article 81 shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment.

2 If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment.

3 If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the Office has its seat.

4 Notwithstanding paragraphs 1, 2 and 3:

- a Article 17 of the Convention on Jurisdiction and Enforcement shall apply if the parties agree that a different Community design court shall have jurisdiction;
- b Article 18 of that Convention shall apply if the defendant enters an appearance before a different Community design court.

5 Proceedings in respect of the actions and claims referred to in Article 81(a) and (d) may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened.

Article 83

Extent of jurisdiction on infringement

1 A Community design court whose jurisdiction is based on Article 82(1), (2) (3) or (4) shall have jurisdiction in respect of acts of infringement committed or threatened within the territory of any of the Member States.

2 A Community design court whose jurisdiction is based on Article 82(5) shall have jurisdiction only in respect of acts of infringement committed or threatened within the territory of the Member State in which that court is situated.

Article 84

Action or counterclaim for a declaration of invalidity of a Community design

1 An action or a counterclaim for a declaration of invalidity of a Community design may only be based on the grounds for invalidity mentioned in Article 25.

2 In the cases referred to in Article 25(2), (3), (4) and (5) the action or the counterclaim may be brought solely by the person entitled under those provisions.

3 If the counterclaim is brought in a legal action to which the right holder of the Community design is not already a party, he shall be informed thereof and may be joined as

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a party to the action in accordance with the conditions set out in the law of the Member State where the court is situated.

4 The validity of a Community design may not be put in issue in an action for a declaration of non-infringement.

Article 85

Presumption of validity — defence as to the merits

1 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.

2 In proceedings in respect of an infringement action or an action for threatened infringement of an unregistered Community design, the Community design court shall treat the Community design as valid if the right holder produces proof that the conditions laid down in Article 11 have been met and indicates what constitutes the individual character of his Community design. However, the defendant may contest its validity by way of a plea or with a counterclaim for a declaration of invalidity.

Article 86

Judgements of invalidity

1 Where in a proceeding before a Community design court the Community design has been put in issue by way of a counterclaim for a declaration of invalidity:

- a if any of the grounds mentioned in Article 25 are found to prejudice the maintenance of the Community design, the court shall declare the Community design invalid;
- b if none of the grounds mentioned in Article 25 is found to prejudice the maintenance of the Community design, the court shall reject the counterclaim.

2 The Community design court with which a counterclaim for a declaration of invalidity of a registered Community design has been filed shall inform the Office of the date on which the counterclaim was filed. The latter shall record this fact in the register.

3 The Community design court hearing a counterclaim for a declaration of invalidity of a registered Community design may, on application by the right holder of the registered Community design and after hearing the other parties, stay the proceedings and request the defendant to submit an application for a declaration of invalidity to the Office within a time limit which the court shall determine. If the application is not made within the time limit, the proceedings shall continue; the counterclaim shall be deemed withdrawn. Article 91(3) shall apply.

4 Where a Community design court has given a judgment which has become final on a counterclaim for a declaration of invalidity of a registered Community design, a copy of the judgment shall be sent to the Office. Any party may request information about such transmission. The Office shall mention the judgment in the register in accordance with the provisions of the implementing regulation.

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5 No counterclaim for a declaration of invalidity of a registered Community design may be made if an application relating to the same subject matter and cause of action, and involving the same parties, has already been determined by the Office in a decision which has become final.

Article 87

Effects of the judgement on invalidity

When it has become final, a judgment of a Community design court declaring a Community design invalid shall have in all the Member States the effects specified in Article 26.

Article 88

Applicable law

- 1 The Community design courts shall apply the provisions of this Regulation.
- 2 On all matters not covered by this Regulation, a Community design court shall apply its national law, including its private international law.
- 3 Unless otherwise provided in this Regulation, a Community design court shall apply the rules of procedure governing the same type of action relating to a national design right in the Member State where it is situated.

Article 89

Sanctions in actions for infringement

- 1 Where in an action for infringement or for threatened infringement a Community design court finds that the defendant has infringed or threatened to infringe a Community design, it shall, unless there are special reasons for not doing so, order the following measures:
 - a an order prohibiting the defendant from proceeding with the acts which have infringed or would infringe the Community design;
 - b an order to seize the infringing products;
 - c an order to seize materials and implements predominantly used in order to manufacture the infringing goods, if their owner knew the effect for which such use was intended or if such effect would have been obvious in the circumstances;
 - d any order imposing other sanctions appropriate under the circumstances which are provided by the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law.
- 2 The Community design court shall take such measures in accordance with its national law as are aimed at ensuring that the orders referred to in paragraph 1 are complied with.

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Article 90

Provisional measures, including protective measures

1 Application may be made to the courts of a Member State, including Community design courts, for such provisional measures, including protective measures, in respect of a Community design as may be available under the law of that State in respect of national design rights even if, under this Regulation, a Community design court of another Member State has jurisdiction as to the substance of the matter.

2 In proceedings relating to provisional measures, including protective measures, a plea otherwise than by way of counterclaim relating to the invalidity of a Community design submitted by the defendant shall be admissible. Article 85(2) shall, however, apply *mutatis mutandis*.

3 A Community design court whose jurisdiction is based on Article 82(1), (2), (3) or (4) shall have jurisdiction to grant provisional measures, including protective measures, which, subject to any necessary procedure for recognition and enforcement pursuant to Title III of the Convention on Jurisdiction and Enforcement, are applicable in the territory of any Member State. No other court shall have such jurisdiction.

Article 91

Specific rules on related actions

1 A Community design court hearing an action referred to in Article 81, other than an action for a declaration of non-infringement, shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties, or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community design is already in issue before another Community design court on account of a counterclaim or, in the case of a registered Community design, where an application for a declaration of invalidity has already been filed at the Office.

2 The Office, when hearing an application for a declaration of invalidity of a registered Community design, shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties, or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the registered Community design is already in issue on account of a counterclaim before a Community design court. However, if one of the parties to the proceedings before the Community design court so requests, the court may, after hearing the other parties to these proceedings, stay the proceedings. The Office shall in this instance continue the proceedings pending before it.

3 Where the Community design court stays the proceedings it may order provisional measures, including protective measures, for the duration of the stay.

Article 92

Jurisdiction of Community design courts of second instance — further appeal

1 An appeal to the Community design courts of second instance shall lie from judgments of the Community design courts of first instance in respect of proceedings arising from the actions and claims referred to in Article 81.

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2 The conditions under which an appeal may be lodged with a Community design court of second instance shall be determined by the national law of the Member State in which that court is located.

3 The national rules concerning further appeal shall be applicable in respect of judgments of Community design courts of second instance.

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