



**DECISION
of the Cancellation Division
of 23/10/2009:**

IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY

OHIM reference number: 2797 C

Community trade mark: 5 048 665

inti-illimani

Language of the proceedings: English

APPLICANT 1)

TRADING COMPANY "INTI ILLIMANI"
Via S. Damaso, 16
00165 Rome
Italy

APPLICANTS 2)-4)

**2) Horacio Durán Vidal
3) José Luis Francisco Seves Sepúlveda
4) Horacio Julio Javier Salinas Álvarez**

Av. La Cañada, 6582-A
La Reina, Santiago de Chile
Republic of Chile

REPRESENTATIVE

Ramón Alberto Sauri Oliva
c/ García de Paredes, 51 2° - 2E
28010 Madrid
Spain

**COMMUNITY TRADE MARK
PROPRIETOR**

Inti-Illimani Corporation
42 County Road
Morris, CT 06763
United States

REPRESENTATIVE

Filemot Technology Law LTD
25 Southampton Buildings
London WC2A 1AL
United Kingdom

THE CANCELLATION DIVISION

composed of Alexandra Apostolakis, Stephan Hanne and Magnus Ahlgren has taken the following decision on 23/10/2009:

1. **The request for a declaration of invalidity is rejected as inadmissible.**
2. **The applicants shall bear the fees and costs of the Community trade mark proprietor.**
3. **The amount of costs to be paid by the applicants to the Community trade mark proprietor shall be EUR 450.**

FACTS AND ARGUMENTS

- (1) The Community trade mark No 5 048 665 inti-illimani (figurative mark) ("the CTM"), as shown on the first page, was filed on 01/05/2006 and registered on 08/03/2007 for goods and services in classes 9, 25 and 41.
- (2) On 26/03/2008, the applicants filed a request for a declaration of invalidity against the CTM on the basis of Article 52(1)(b) Council Regulation (EC) No 207/2009 on the Community Trade Mark ("CTMR").
- (3) In the application form, the three applicants 2)-4) were indicated as having the same Chilean address and as being the founding partners of applicant 1). As regards the common representative of applicants 1)-4), the type of representation was marked as employee. Furthermore, the application was accompanied by the Office's authorisation form, in Spanish, according to which the applicants 2)-4) authorized the representative to represent them before the Office as an employee. The applicants also filed an excerpt from the Chamber of Commerce of Rome, dated 12/12/2007, concerning the company "INTI-ILLIMANI DI JORGE TEOFILO COULON LARRANGA E COMPAGNI – SOCIETA IN NOME COLLETTIVO" with an address corresponding to that of applicant 1). The excerpt also states: "Durata della società: data termine: 31/12/2000".
- (4) In response to the invalidity request, the CTM proprietor states, amongst other things, that the appointed representative is not entitled to act for the applicants 2)-4) as he is neither a legal practitioner nor a professional representative as stipulated by Article 89 CTMR. According to the CTM proprietor, the applicants 2)-4) have their domicile in Chile, and therefore are required to be represented before the Office pursuant to Article 88 CTMR, which in fact they are not. Furthermore, the CTM proprietor states that the excerpt from the Chamber of Commerce of Rome filed by the applicants shows a termination date of applicant 1) suggesting that this entity no longer exists.
- (5) By an official communication of 07/07/09, the Cancellation Division informed the applicants that the applicants 2)-4) are required to be represented before the Office in accordance with Articles 92(2) and 93(1) CTMR by a professional representative as they have their domicile in Chile. According to the application form as well as the authorization form, however, the representative appears to be an employee. The Office moreover noted that

only applicant 1), having its (former) principal place of business in the Community, can be represented by an employee. However, the certificate from the Chamber of Commerce of Rome indicates a termination of this entity. In addition, no signed authorization pursuant to Rule 76(2) Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing CTMR ("CTMIR") has been filed. The applicants were therefore informed that the invalidity application might be inadmissible and they were requested to furnish additional proof concerning the representation within two months after receipt of the communication.

- (6) The applicants did not file any response within the time limit.

GROUND FOR THE DECISION

- (7) The request does not comply with the formalities prescribed in the CTMR and is therefore inadmissible.
- (8) According to Article 92(2) CTMR, natural persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Community must be represented before the Office in accordance with Article 93(1) CTMR in all proceedings established by the CTMR.
- (9) Pursuant to Article 93(1) CTMR, representation of natural or legal persons before the Office may only be undertaken by:
- (a) any legal practitioner qualified in one of the Member States and having his place of business within the Community, to the extent that he is entitled, within the said State, to act as a representative in trade mark matters;
 - (b) any professional representative whose name appears on the list maintained for this purpose by the Office.
- (10) Furthermore, according to Article 93(1) CTMR, representatives acting before the Office must file a signed authorization for insertion in the files at the Office. However, it follows from Rule 76(1) CTMIR that this is only applicable if the Office expressly requires it, or if the other party expressly asks for it.
- (11) According to Article 92(3) CTMR, natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the Community may be represented before the Office by an employee.
- (12) In the present case, according to the application form, applicants 2)-4) do not have a domicile in the Community. They are therefore required to be represented pursuant to Article 93(1) CTMR by (a) a legal practitioner or (b) a professional representative. The common representative of all applicants, however, did not show that he qualifies as a suitable representative despite the CTM proprietor's request in this respect, as also referred to by the Cancellation Division in the official communication of 07/07/09. Rather, the representative has been identified as an employee in the application and in the authorization form, who as such, is entitled to represent his employer according to Article 92(3) CTMR, the employer being a natural or a legal person having its domicile or principle place of business in the Community. Only applicant 1) with its principle place of business in Italy has such a link to

the Community. However, despite the CTM proprietor's denial of the existence of applicant 1) at the time of the filing of the invalidity request, and despite the express invitation by the Cancellation Division, the applicant in question has not proven the validity of this legal person.

- (13) It follows from the above, that the legal existence and validity of applicant 1) has not been proven and applicants 2)-4) are not represented before the Office in accordance with the provisions stipulated by the CTMR and CTMIR. The invalidity request is therefore inadmissible.

COSTS

- (14) Pursuant to Article 85(1) CTMR and Rule 94 CTMIR, the party losing cancellation proceedings shall bear the fees and costs of the other party. The applicants, as the party losing the cancellation proceedings shall bear the fees and costs of the CTM proprietor.
- (15) The amount of costs to be paid by the applicant to the Community trade mark proprietor pursuant to Article 85(6) CTMR in conjunction with Rule 94(3) CTMIR shall be EUR 450, corresponding to representation costs.



THE CANCELLATION DIVISION

<hr/> Alexandra Apostolakis	<hr/> Stephan Hanne	<hr/> Magnus Ahlgren
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Notice on the availability of an appeal:

Under Article 59 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 CTMR notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

Notice on the review of the fixation of costs:

The amount determined in the fixation of the costs may only be reviewed by a decision of the Cancellation Division on request. Under Rule 94(4) CTMIR such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2 point 30 of the Fees Regulation) has been paid.