

“Cross-border protection of design”

EUROPEAN UNION

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1.- Applicable law.

Two main legal texts govern design protection in the EU.

Community design Regulation - Council Regulation No 6/2002 on Community designs - provides a unified system for obtaining a Community design to which uniform protection is given with uniform effect throughout the entire territory of the Community.

Directive 98/71, on the legal protection of design, approximates the laws of the Member States.

Design is thus protected, independently, by the European Union as a single entity and by each and every EU Member State.

This paper will focus exclusively on EU protection of design.

2.- Scope of protection.

What can be protected?

The EU design legislation is wide ranging and protects the appearance of the whole or a part of a product resulting from the features of the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation'. Article 3 of the EU Design Regulation.

Protection is granted for the whole EU.

EU legal definition of design

- "**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;

- "**product**" means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

- "**complex product**" means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

Competent Office

The European Union Intellectual Property Office - EUIPO - based in Alicante, Spain, is responsible for managing the registered Community design.

Registered and Non-registered EU design

Seeking design protection, the following options are available in the EU:

- 1) Registered Community Design;
- 2) Unregistered Community Design.

Term of protection

1) A registered Community design is initially valid for five years from the date of filing and can be renewed in blocks of five years up to a maximum of 25 years.

2) An unregistered Community design is given protection for a period of three years from the date on which the design was first made available to the public within the territory of the European Union. After three years, the protection cannot be extended.

The act of making available to the public is called 'disclosure'. Disclosing a design and being able to prove it are key to design protection.

Scope of protection

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.

An unregistered Community design shall confer on its holder the right to prevent the same acts 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.

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.

In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.

Main phases of the registration process and fees

1) All applications go through a formalities check first. Applicants are given two months to respond to the examiner's objection.

2) Substantive examination is limited to two issues:

i) Is the design consistent with the EU definition of design?

Namely: does the design represent the appearance of the whole or part of a product?

ii) Does the design contain an element that goes against public policy and morality?

3) Fees for registration and publication of a single design item are 350 euro.

The deferment of publication fee is 40 euro.

Multiple design application are available with reduced fees.

An online application is normally examined in a matter of days and, if no office actions are issued

by the examiner, is immediately published and granted.

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3.- Validity requirements

General remarks

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

A design **applied** to or **incorporated** in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

- a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and
- b) to the extent that those visible features of the component part fulfill in themselves the requirements as to novelty and individual character.

Novelty

A design shall be considered to be new if no identical design has been made available to the public:

- a) before the date on which the design for which protection is claimed has first been made available to the public;
- b) in the case of a registered Community design, 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.

Designs shall be deemed to be identical if their features differ only in immaterial details.

Individual character

A design shall 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.

In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

Designs dictated by their technical function and designs of interconnections

A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.

A Community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.

Designs contrary to public policy or morality

A Community design shall not subsist in a design which is contrary to public policy or to accepted principles of morality.

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4.- Relationships to other forms of protection (three-dimensional trademarks, unfair competition, copyright)

The provisions of the EU Directive shall be without prejudice to any provisions of Community law or of the law of the Member State concerned relating to unregistered design rights, trade marks or other distinctive signs, patents and utility models, typefaces, civil liability or unfair competition.

A design protected by a design right registered in or in respect of a Member State in accordance with the Directive shall also be eligible for protection under the law of copyright of that State as from the date on which the design was created or fixed in any form. The extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State.

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5.- Exhaustion principle

The rights conferred by a Community design shall not extend to acts relating to a product in which a design included within the scope of protection of the Community design is incorporated or to which it is applied, when the product has been put on the market in the Community by the holder of the Community design or with his consent.

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6.- Cross-border issues

Filing: CUP priority - Hague Agreement vs. national filing

The EU is a signatory Party of the Hague Agreement. The International Bureau of the World Intellectual Property Organisation (WIPO) carries out most of the formalities check for international registrations filed with WIPO that designate the EU.

None the less, the Registered Community Design is so easy to get that it is worth considering filing a direct application instead of choosing the Hague System for filing.

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7.- Contracts and litigation

Transfer in ownership

According to Article 28 of the RCD Directive the transfer of a registered Community design shall be subject to the following provisions: (a) at the request of one of the parties, a transfer shall be entered in the register and published; (b) until such time as the transfer has been entered in the register, the successor in title may not invoke the rights arising from the registration of the Community design.

Licence

According to Article 32 of the RCD Directive a Community design may be licensed for the whole or part of the Community. A licence may be exclusive or non-exclusive. Without prejudice to any legal proceedings based on the law of contract, the holder may invoke the rights conferred by the Community design against a licensee who contravenes any provision in his licensing contract with regard to its duration, the form in which the design may be used, the range of products for which the licence is granted and the quality of products manufactured by the licensee.

Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a Community design only if the right holder consents thereto. However, the holder of an exclusive licence may bring such proceedings if the right holder in the Community design, having been given notice to do so, does not himself bring infringement proceedings within an appropriate period.

A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in an infringement action brought by the right holder in a Community design. 5. In the case of a registered Community design, the grant or transfer of a licence in respect of such right shall, at the request of one of the parties, be entered in the register and published.

Rights in rem and levy of execution

A registered Community design may be given as security and/or levied in execution.

Litigation best practices

Litigation best practices can be briefly summed up as follows.

First, a comparison between the alleged infringing goods and the Community design must be carried out in order to assess identity or similarity.

Validity of the Community design must then be evaluated. The validity of Community designs can always be challenged by an alleged infringer, Registered Community designs can be declared null by the EUIPO or - in certain cases - by national courts.

Once the infringement/validity assessment is completed, sending detailed warning letters is definitely recommended from a practical point of view. In certain cases though, *ex parte* proceedings allow the holder of the IP to seize the infringing goods without previous warning to the infringer.

Seizure and preliminary injunctions are available for the whole EU area according to the “IP Enforcement” EU Directive, namely Directive 2004/48.

Online infringement - namely, the online advertising, offer and sale of infringing products - is prohibited under EU design legislation. In such cases having a registered Community design is quite helpful. The EUIPO's online database of registered designs allows the IP protection systems of the major online market places to easily check a design registration and to consequently give

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