

STUDIO LEARDI

Intellectual Property Management



NYSBA INTERNATIONAL SECTION SEASONAL MEETING

Tokyo, November 2019

Cross-border protection of design
The EU perspective

Pierodavide Leardi

Studio Leardi - Intellectual Property Management

Milano - Italy

1.- What are we talking about?

Design is an art and a science, it forms our homes and our workplace, and it is all around us, wherever we are. Design is the surface of the man-made environment.

Great design focuses on the user, combines aesthetic, economic and practical values and is the way your customers identify innovative brilliance.





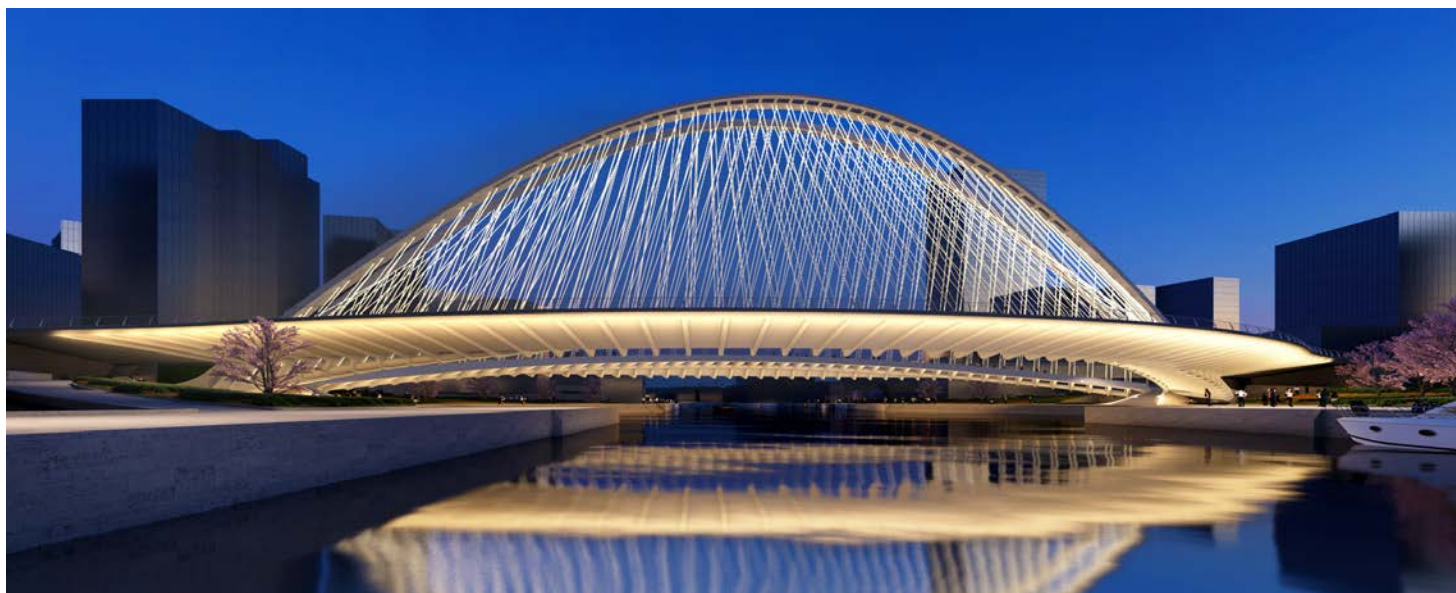












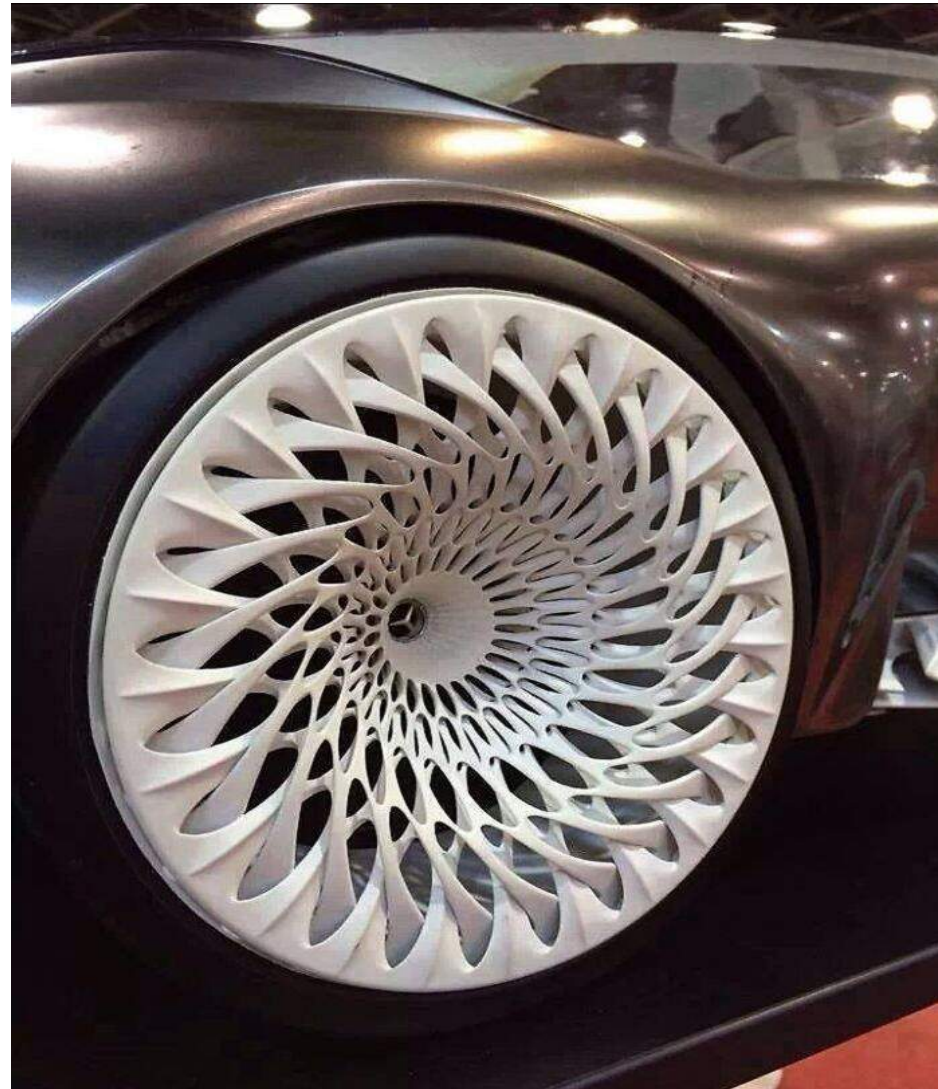
















2.- Applicable Law - European Union

EU Member States legislation

National laws of the Member States.

Directive No 98/71, on the legal protection of design, approximates the laws of the Member States.

Competent offices: national IP offices

EU as a single entity

Community design Regulation - namely 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**.

Competent office: EUIPO - Alicante, Spain

3.- 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 (web design is included!);
- "**complex product**" means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

4.- Validity requirements

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

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

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

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.

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



5.- 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.

6.- 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** (first five years term).

The deferment of publication fee is 40 euro.

Multiple design application are available with reduced fees.

7.- 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.

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.

These two pictures show two lamps that have been considered as being different from each other.



8.- 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.



9.- 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.



CREATIVITY

INNOVATION

IDENTITY

Thank you very much for your attention!

Pierodavide Leardi

leardi@leardi.it