

Intellectual Property Advisory

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European Community Designs Protect Industrial Designs That May Not Be Protected in the US and Elsewhere

BY ANNE CAMPBELL

European Council Regulation no. 6/2002 on community designs came into force on 6th March 2002, and provides design protection for types of industrial designs which might not necessarily be protectable in other jurisdictions, such as the US. Both registered and unregistered design protection exists and covers all countries which are EC member states.^[1] A registered design confers on the holder an exclusive right to use the design and prevent third parties from doing so, with no requirement to prove copying. Unlike a registered design, an unregistered design right does not confer an exclusive right on the holder because copying must be proven for infringement to be found.

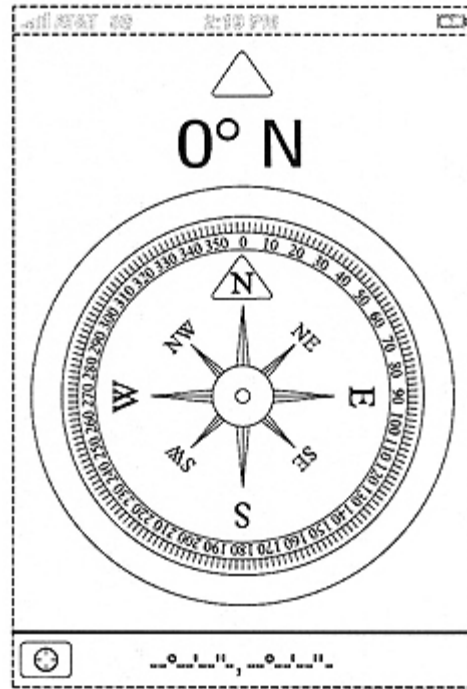
The registration system is administered by the Office for Harmonization in the Internal Market (OHIM), acting in its capacity as the trademarks and designs registration office of the European Union. OHIM's website indicates that, to date, it has received applications for and registered around 460,000 designs and that the number processed annually is increasing at a rate of about 75,000 per year.

What is Protected?

A "design" is defined in the Regulation as the outward appearance of a whole product or part of it resulting from the features (in particular, the lines, contours, colours, shape, texture and/or materials) of the product itself and/or its ornamentation. A "product" is defined in the Regulation as any industrial or handicraft item, including parts of a more complex product, packaging, get-up, graphic, symbols and typographic typefaces. In addition to protecting three-dimensional products and patterns, items such as logos, computer icons and fictional characters may also be protected.

In order to be protected, the design must be "new and have individual character." This requirement is fulfilled 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". Thus, the available prior art is extremely important when determining validity of a registered design. The degree of freedom of the designer in developing the design is taken into consideration. The case law to date has determined that an "informed user" is a person who is technically capable and discriminatory, as opposed to an average consumer. Recent decisions have also suggested that the smaller the degree of design freedom, the more that minor differences between two designs are likely to be taken into account.

Examples of protected "designs" are Apple's many registrations for screen shots of its computer applications such as:



Other examples are graphical symbols which traditionally would only have been protectable by trademark:



Being able to register designs such as these by way of a community design may avoid problems some trademark holders have had trying to protect their designs as trademarks. Some courts have refused trademark protection for various reasons such as the lifespan of a trademark being deemed to be too great to allow design protection or because of statements made in parallel patent cases. See, e.g., *Jay Franco & Sons, Inc. v Franek*, 615 F.3d 855 (7th Cir. 2010).

Applying for a Registered Design

There are some features of the registration procedure which are in sharp contrast to other systems, such as that for applying for a US Design patent, and which can provide advantages to the applicant in terms of ease of registration and costs incurred. Points of interest include:

- The representations filed can be a mixture of line drawings and photographs in black and white or colour. An application can be for either a single design or *multiple designs*. A multiple application is possible providing that all the articles for which protection is applied belong to the same class of the International Classification for Industrial Designs. Beyond this requirement, neither the Regulation nor its implementing regulation specify exactly what is allowable in terms of multiple designs in a single application, but experience to date indicates that the requirements are less stringent than in many other jurisdictions. Including several designs in a multiple application has an advantage that the fee due for each extra design beyond the first design is less than that for the first design. Each design of a multiple application can be treated separately for the purposes of renewal, enforcement and so on subsequently to registration.
- For each *design*, between one and seven representations may be filed.
- No novelty examination is carried out on applications. Instead, unless there are formal deficiencies, applications proceed quickly to registration. Indeed, OHIM boasts that more than 40% of designs are now being registered *within one week*.

- The standard procedure is for a registered design to be published upon registration. Should an applicant wish to keep a design secret beyond the date of registration, a request for deferred publication can be made. Such a request prevents publication for up to 30 months from the priority date.

Thus, the process for obtaining a registered design is relatively simple and cost-effective for the monopoly right obtained.

Other features worth noting are:

- there is a 12-month grace period for disclosure prior to filing
- the term of a registered design is five years from the date of filing and the registration can be renewed at five-year intervals for a total term of up to 25 years from filing
- One renewal fee renews a registered design throughout the EU countries

How Does the Unregistered Design Right Differ?

As stated, the Regulation also provides for protection of designs by way of Unregistered Design Right (UDR). UDR is a right which arises automatically for a design which has been made available to the public in the EU with no registration required. Novelty and individual character are both judged from the date on which the design was first made available to the public, that is “published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the European Community”.

UDR only protects a design for three years from the date on which it was first made available to the public within the EU. As well as having only a short term of protection, the usefulness of a UDR is limited in view of the fact that proof of copying is required for a claim to exist. Thus, registration of a design has significant advantages over relying merely on unregistered protection.

How Are Design Rights Enforced?

There is no specific Opposition procedure for registered Community Designs of the type available before the European Patent Office in respect of European Patents, but it is possible to apply to OHIM for a declaration of invalidity of a Community Design. However, a claim for infringement of a Community design must be brought in a national court of a Member State designated for the purpose. For example, in the case of the UK, proceedings are brought in the Patents County Court or the High Court. If such an action is brought, it is possible for the defendant to counterclaim for invalidity of the design. The particular situation, together with various rules, determines in which Member State actions must be brought and in which Member States a finding on infringement has effect.

Any final decision (i.e., following appeal if one is heard) made regarding validity takes effect in respect of the Community Design as a whole and is effective throughout all member states.

Remedies for infringement include an injunction and seizing of infringing products. Damages or an account of profits are available if they are available in the Member State in which the proceedings have been brought.

If equivalent national rights exist and a final judgment on infringement has been made on either the Community Design or the national design, the same cause of action between the same parties in respect of the other of the Community Design and the national design cannot be brought. This is in contrast to the position regarding equivalent European and national patents.

Conclusion

Given the large number of community designs registered to date, many design owners consider registering their designs in the EU to be of great importance for the relatively little outlay involved. Given the competitive advantage it can provide a design owner, who may prevent others from using a protected design throughout the EU, the system is expected to continue to increase in popularity, particularly among US entities.

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Endnotes

¹ At the present time, the member states are:

Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, United Kingdom.

Norway and Switzerland are notably absent from coverage.

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