

EUROPEAN COMMUNITY DESIGN

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EUROPEAN COMMUNITY DESIGN

Since January 1, 2003 community designs can be filed at OHIM in Alicante, where community trade marks are also filed. The earliest filing date was, however, April 1, 2003.

The community design enjoys protection in the whole European community. The protection will in future be extended to countries joining the community.

Great efforts were made to create an optimal system for the community. There are different needs in different sectors of industry. Some sectors produce large numbers of designs for products having a short market life where protection without the burden of registrations formalities is an advantage and the duration of protection is of lesser significance. On the other hand, there are sectors of industry which value the advantage of registration for greater legal certainty and which require the possibility of long term protection corresponding to the foreseeable market life of their products.

These different needs have led to two forms of protection.

Unregistered Community Design

3 years

no formalities

One being a short term, i.e. three years, Unregistered Design. Protection is obtained automatically without any formalities from the date the design is made available to the public in the European Union.

Unregistered designs are for instance appropriate for fashion.



A fashion designer will come up with new collections in short periods but there is no need for long term protection.

It is important to note that making available to the public in order to obtain protection has to occur in the Community and not somewhere else, e.g. the United States. A first publication of the design in the United States would even be novelty-destroying as a grace period is not available for the Unregistered Design.

The consequence of this is that if Dior presents his models in Paris all shown designs will automatically enjoy a three years protection as Unregistered Designs, whereas if Donna Karen presents her new models in

New York she will enjoy no protection in the European Community. She will even not be able to benefit from Unregistered Design protection by a later presentation in Europe because the presentation in New York would be novelty-destroying. But Donna Karen can be helped with a Registered Community Design. In the following the Registered Community Design will be dealt with only.

Registered Community Design

maximum of 25 years

by registration

The Registered Community Design is initially registered for five years and can be renewed for five year intervals up to 25 years.

What can be protected by a Community Design?

The answer can be found in Art. 3(a) of the

COUNCIL REGULATION (EC) No. 6/2002

of 12 December 2001

on Community designs

where the legal definition of “design” is given.

Art. 3(a)

„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;

The definition of the “product” is given in Art. 3(b).

Art. 3(b)

„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;

Of importance is the wording of Art. 3(a) according to which a design also means “the appearance of **a part** of a product”. With many products only a certain part thereof is characteristic in respect of the design, whereas other parts are usual or changeable. In order to obtain the best scope of protection for such designs it is important to select proper representations of the design for registration. This has essential relevance for the scope of protection.

The following examples demonstrate this.

A new wine glass has been created which is shown in Figure 7A, and this design had been filed as a Community Design, exactly as shown in the Figure.

The characteristic feature of the glass is obviously the stem.

The requirements for protection are summarized in Art. 4.

Art. 4

Requirements for protection

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

Novelty and individual character are defined in Articles 5 and 6.

Art. 5

Novelty

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

(b) in the case of a registered Community design, before the date of filing of the application....

Art. 6

Individual character

- 1. 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:*
- 2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.*

Assuming that the wine glass 7A



is new and has individual character – then the design enjoys protection because it fulfills the only two requirements necessary for protection given in Article 4.

The scope of protection of the Community Design is defined in Article 10.

Art. 10

Scope of protection

- 1. 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.*
- 2. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.*

Important for the question of scope of protection is that it relates to the “different overall impression”.

Assuming that a competitor markets a wine glass as shown in Figure 7B:



The question of a different overall impression is difficult to answer. The stem is obviously the same but the base of the glass as well as the upper part are clearly different. Therefore in respect of an overall impression there are arguments for both, a different overall impression and the same overall impression.

The next glass (Fig. 7C)

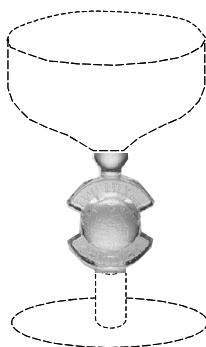


is certainly more different in overall impression because the glass base and upper part are very different to the Registered Community Design, and only the stem is the same. So the overall impression might be regarded as different.

These considerations seem to indicate that the scope of protection of a community design is quite limited.

However, by analyzing the design in respect of which part of the design is the characteristic part that gives novelty and individual character and filing the design in a different way gives much better protection.

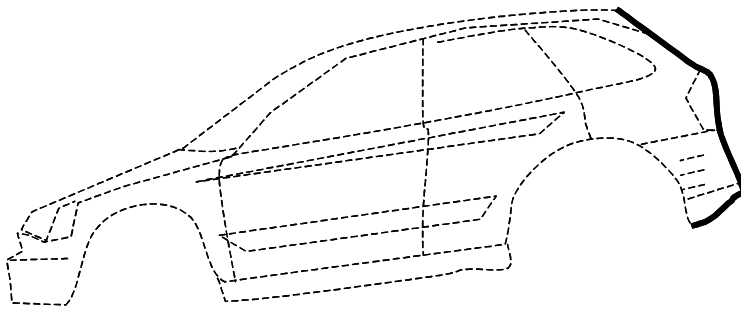
If the application shows the following representation (Fig. 7D)



then the scope of protection is much broader. What is protected is the characteristic stem of the glass, and as long as this characteristic stem is present in any kind of glass, regardless of how the upper part and the base are formed, such embodiments will fall within the scope of protection of the registered design.

So the glasses of Figures 7B and 7C will fall clearly within the scope of protection of the registered design as shown in Figure 7D.

The following examples show design representations where only the shape or contour of part of the product is to be protected.



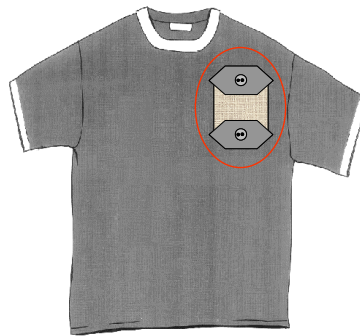
The use of dotted lines to show those parts of the product which are of no relevance for the scope is one way to achieve the goal of concentrating the design on the characteristic part.

A second possibility is to use colour. For instance a characteristic element being part of a sport shoe could be presented in colour whereas the shoe itself is shown in black and white only. An example:



A third alternative which is accepted by the Office is to highlight the part of the product which is to be protected by circling it with a coloured line.

An example is a T-shirt with a new pocket design or a new button arrangement.



It should be mentioned and emphasized that no influence on the scope of protection can be achieved by any kind of description. The principle of the Community Design is that protection is given to what is shown in the representation, and a description given in addition is irrelevant. A description will not even be published.

Another important feature of the Community Design is a grace period, which is stated in Article 7.

Art. 7

Disclosure

.....

2. *A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 and if a design for which protection is claimed under a registered Community design has been made available to the public:*

(a) by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title; and

(b) during the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority.

The grace period is 12 months. A grace period applies to a disclosure made by the designer, his successor entitled or a third person when the publication is a result of information provided by the designer or his successor. The grace period is of practical importance because it enables designers to test out their designs on the market place and to evaluate whether registration is justified.

Actually, meanwhile within the grace period, action against copying could be taken on the basis of the Unregistered Design Right which is obtained automatically when the design is brought to the market in Europe.

Another important element of the Community Design is the possibility of requesting deferment of publication.

Art. 50

Deferment of publication

1. The applicant for a registered Community design may request, when filing the application, that the publication of the registered Community design be deferred for a period of 30 months from the date of filing the application or, if a priority is claimed, from the date of priority.

Publication can be deferred for a period of up to 30 months, which means that although protection for the design is obtained, the design is actually still secret.

The request has to be filed when filing the application. It can however be requested any time by the applicant to make the file public.

The filing requirements itself are simple. There are only three “musts” to obtain a filing date.

Art. 36

Conditions with which applications must comply

1. An application for a registered Community design shall contain:

(a) a request for registration;

(b) information identifying the applicant;

(c) a representation of the design suitable for reproduction...

The application shall further contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied. It is very advisable to use the terminology of the so-called “Euro-Locarno-List”.

Euro-Locarno-List to be found at the web site of OHIM

www.oami.eu.int/search/eurolocarno

or

www.oami.eu.int/en/design/eurolocarno.htm

Using the terms of the Euro-Locarno-List greatly speeds up the registration process and avoids a discussion with the Office about the goods and classes. It is important to note that the description of the goods and classes is of no influence to the scope of protection. This additional information is

not even published in the register which shows the information concerning the applicant, the filing date, priority date and the representations of the design only.

Examination by the Office is limited to formal filing requirements (Art. 45) and whether the application qualifies as a design according to the definition of Art. 3. Novelty and individual character are not examined. Therefore the registration will usually be obtained in very short time.

The application costs are low. The total official fees for registration and publication are EUR 350.00.

A further tremendous cost saver is the possibility to file multiple applications.

With one application an unlimited number of similar designs in the same class in the form of one multiple application can be filed. The total official fee for an additional design is EUR 175.00, for the second to the tenth, and EUR 80.00 for the eleventh and all further designs.

Official Fees

Registration and publication fee:	EUR 350.00
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Additional registration and publication fee for the second to tenth design:	EUR 175.00
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Additional registration and publication fee for the eleventh and all further designs:	EUR 80.00
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The Community Design has a unitary character in the sense of equal effect throughout the Community. It cannot be divided up into or transferred in the form of national parts. However:

Art. 32

Licensing

1. A Community design may be licensed for the whole or part of the Community. A licence may be exclusive or non-exclusive.

The question whether the Community Design is of interest for industries where designs are created can be answered with a clear “YES”.

Conclusion

1. Registration of the design is easy and cheap.
2. The Community design enjoys a large scope of protection.
3. The Community design is applicable for designs of all sectors of industry.