

Community Design or Community Trade Mark?

The ability to obtain European Union (EU) wide protection for designs, the broad definition of a design in the EU legislation and the fact that protection is not limited to a given type of product, gives the possibility of gaining substantial protection in the EU for certain types of marks other than by registering them as trade marks.

What is a trade mark?

A trade mark is something which enables customers to identify goods or services as coming from a particular source, even if the precise identity of the source is not known. Usually trade marks are a word or a logo, or a combination of the two, but can also be, for example, a shape, a smell, a sound or a gesture.

What is a registered design?

It is a registered right which protects the design of the whole or part of a product and may arise from the lines, contours, colours, shape, texture, material or ornamentation of the product. The product may even be a graphical symbol.

What can be a trade mark but not a registered design?

Clearly smells, sounds and gestures cannot be designs, and it would be stretching the definition of a registered design to cover words - though if the typography of a word mark was new then this could be covered by a registered design.

What can be a registered design but not a trade mark?

If the shape, pattern etc. of the item is dictated by its function, and it is that which gives value to the item, then it cannot be a trade mark.

What kind of marks could be protected by Registered Community Design (RCD)?

Logos, shape marks, packaging and containers, and distinctive features or decoration are examples of marks that might be protected by an RCD instead of a trade mark. Examples could be a cheese in a special shape, a perfume bottle or distinctive stitching on clothing. Indeed with some "marks" such as shape marks, it may be difficult to obtain trade mark protection, as the shape may have functionality, e.g. the shape of an electrical appliance, or else be that which adds substantial value to the goods, e.g. an elaborate perfume bottle. For "marks" such as these an RCD may be a preferable option.

What are the advantages of an RCD?

There are several advantages. They include:

- no limit on the range of products protected - although a particular product needs to be specified on the form by way of example it is not limiting. For a Community Trade Mark (CTM) the basic fees cover up to three classes of goods/services; to cover a wide range of goods the extra fees can be substantial;
- an RCD can cover an unlimited number of designs, provided that the example products are all of the same type, though even this does not apply if the design is for surface ornamentation. In comparison CTM is restricted to one mark;
- details of a CTM application are available to the public within a few weeks of submitting the application. For an RCD it is possible to request deferment for up to thirty months from application (or the priority date if priority is claimed). This can be useful in certain industries so that competitors do not become aware of designs before they are launched;
- the validity of the RCD is not dependent upon the design being used: a CTM can become vulnerable to attack if use is discontinued for some time.

What are the disadvantages of an RCD?

- The mark has to be new (or almost new - within one year of first being made public) for a valid application for an RCD to be made.
- RCDs cover physical products: although there may be tangible items associated with the offering of services (e.g. brochures), it may be difficult to use an RCD to protect services.
- RCDs have a duration of up to twenty-five years, subject to the payment of renewal fees: in theory trade marks have unlimited duration. In practice twenty-five years may be more than enough length of protection, and if need be at the end of that time it may then be possible to obtain trade mark protection.

What about United Kingdom registered designs?

The criteria for United Kingdom Registered Designs (UKRDs) are similar to those for RCDs.

However, publication of UKRDs can only be deferred by up to 12 months.

Also, unless there is no interest beyond the United Kingdom, an RCD is a more economic option as all of the EU can be covered for only about double the cost of a UKRD.

Summary of major differences

	COMMUNITY TRADE MARK	COMMUNITY REGISTERED DESIGN
Plain word mark	YES	NO
Stylised word mark	YES	NOT RECOMMENDED
Logo (with or without words)	YES	YES
Pattern	YES*	YES
Shape	YES*	YES
Colour in itself, sounds, gestures, smells	YES*	NO
* Especially with such marks one may need to demonstrate that they have become distinctive in order to obtain registration.		
Mark needs to be new or almost new	NO	YES
Multiple items	NO	YES
Deferment of publication	NO	YES
Protection of services	YES	NO
Use to maintain validity?	YES	NO
Duration	UNLIMITED	25 YEARS MAXIMUM

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