

Registered Community Designs

In the context of intellectual property, the “design” of a product is generally its shape, or ornamentation applied to it, although the exact definition varies between different types of protection. Essentially, the design of a product relates to its appearance, rather than to technical principles of its construction or operation.

There are a number of ways in which designs can be protected, and this information sheet deals with how to register your design in the European Union. There are three other information sheets on designs: one addresses registration in the UK, one addressed International Registration and the other addresses automatic design protection that arises without registration.

WHAT IS A REGISTERED COMMUNITY DESIGN?

A registered Community design gives a “monopoly” right, i.e. a right to stop anybody else using the registered design irrespective of whether they copied it.

A registered Community design gives its proprietor the exclusive right in the European Union to make, use, sell import and export any product embodying the design, if it is a shape, or bearing the design if it is ornamentation.

These rights extend to similar designs which do not produce a substantially different impression on the informed user.

The proprietor will be able to take action against any third party who carries out any of the rights exclusive to the proprietor within the EU without the proprietor’s permission, even if they are using a design that they created independently and without copying.

How do I get a registered Community design?

To obtain a registered Community design, it is necessary to file a formal application at the Community Designs Office (based in Alicante, Spain).

What can be protected by registration?

A design may be that of a whole or part of a product (including its inside) and may arise from the lines, contours, colours, shape, texture, material or ornamentation of the product.

The product may even be a graphic symbol, e.g. a computer icon, or a typographical typeface.

The design which is the subject of an application for registration has to meet two criteria.

It must:

- be novel; and
- possess individual character.

Both these criteria are judged with reference to designs which have been made available to the public before the effective filing date of the application.

Designs may be made available by publication, use or any other means.

Grace period

One important exception to the above is that the prior disclosure of a design made by its designer, or in consequence of a disclosure made by the designer, within 12 months before the filing date of the application do not count for the determination of Novelty or Individual Character.

However, such disclosures may prevent further registering the design in individual countries, especially outside the European Union, as many countries in the world do not allow such a grace period, or allow a shorter period of time.

The provision does not exclude disclosures made independently of the designer during this period, and therefore applications should be filed before the design is disclosed if possible.

Safeguard clause

Another exception to the above requirements is that prior disclosures which could not have become known before the effective filing date in the European Economic Area (EEA) in the business sector concerned are disregarded.

This provision is thought only to exclude obscure disclosures, whether by virtue of the extent, location or time of disclosure.

Novelty

For a design to be Novel it has to differ from prior designs by more than immaterial details.

Individual character

For a design to possess Individual Character, it has to produce a different overall impression on the informed user from prior designs. In many cases, the informed user is likely to be the end user of the product.

In fields where the designer has less design freedom, the difference between registrable designs and prior designs may not be as great as where the designer had complete design freedom. This is also reflected in the infringement rights arising from the registration.

Complex products and spare parts

Complex products are defined as products which are composed of two or more replaceable component parts which permit disassembly and reassembly of the product.

The designs of component parts of such products will only be registered if the component parts remain visible during normal use of the complex product.

Further, the repair of a complex product so as to restore it to its original appearance by the use of a component part does not infringe a design registered for the design of that component part.

This is aimed at continuing to permit the manufacture and sale of “non-genuine” car parts, for example, even if such parts are registered.

Excluded features and designs

A design registration will not protect features of a design which are solely dictated by the product’s technical function, or features which are required to permit the product to be connected to or placed in, around or against another product so that either product may perform its function.

However, a design which serves the purpose of allowing the assembly of modular products may be able to be registered.

It is not allowable to register designs which incorporate protected emblems which include, for example, the Olympic symbols, Royal arms and national flags.

Duration of registration

If granted, the registration lasts 25 years, but to do so it must be renewed (through payment of a fee) at five-yearly intervals.

Overseas registration

The filing of a European Union design generates a “priority date”, which can be claimed to support corresponding design applications filed elsewhere within six months of the EU filing

date, if the EU design application is the first filing for the design.

The application process

We are able to deal with all aspects of filing an application and obtaining a registration of a design on your behalf.

Filing an application

To enable us to prepare the documents for filing an application, we need drawings or photographs showing all features of the design. Alternatively, if a specimen or model is available, we can prepare drawings or photographs from it. The number of views of a three-dimensional design that can be submitted is seven.

We also need to know:

- the full name, address and nationality of the applicant (which may be an individual or company); and
- a description or general name of the article to which the design is intended to be applied (if this is not obvious);
- full details of any application from which you wish to claim priority.

It is also possible to include a mention of the designer or designers, or to say that they have waived their right to be named, but this is not compulsory.

We can optionally include a brief explanation of the design in the application.

On filing it is necessary to pay the registration fee and the publication fee, and/or the fee for deferment of publication (see below).

If priority is claimed, then it will be necessary to submit a certified copy of the earliest application within three months of filing, or within a further period subsequently set by the office. It is more cost effective to file the priority document with the application.

Deferment of publication

Community designs are usually published once they are registered, but this publication can be deferred for up to 30 months from the filing of the application or the claimed priority date. This results in the file and the design not being made public, although a mention that the publication has been deferred would appear in place of the usual publication. This deferment requires the payment of a fee on application, as well as the payment of the publication fee before the design is published. Therefore the latest this fee can be paid is three months before the end of 30 months from the filing (or priority) date.

During the deferment period it is not possible to enforce the registration against a third party, unless the registration has been communicated to them.

Multiple applications

It is possible to file applications covering more than one design, as long as all the articles to which the designs are intended to

be applied fall inside the same class of the Locarno Design Classification, which has reasonably broad headings.

The advantage of filing such multiple applications is a reduced cost compared to single applications.

Each of the designs in the multiple application is a separate piece of property and therefore can be licensed and assigned separately.

Examinations

Applications are only examined on formal grounds, and no searching of earlier designs will be carried out.

Once examination is concluded, the design will be registered and published (subject to deferment: see above). This can often take place within a couple of weeks, if all formal requirements are met on filing.

Invalidity

The regulation allows for an application for a declaration of invalidity to be filed once the design is registered, provided that if lack of novelty or individual character is alleged based on an earlier right the application must be lodged by the holder of that right.

Specimens

It is possible to file a registered Community design application using a specimen of a two dimensional design rather than a conventional representation.

If the design is a repeating pattern, the whole pattern which repeats must be shown on the specimen.

This approach would be typically used in cases where the design is that of a fabric or wallpaper.

The specimen cannot exceed 26.2cm x 17cm in size, 50 grams in weight or 3mm in thickness.

We are required to file five copies of a specimen for each design.

Current members of the EU (as at 1 April 2010)

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

Deferred publication of an application with a specimen

It is only possible to use a specimen as an alternative to a representation if deferred publication is requested. By requesting deferred publication, the design is not published when it is registered and publication can be delayed by up to 30 months from the filing date or priority date.

In order for the design to be published, a standard representation of the design (e.g. a photograph) has to be filed at least three months before the publication date, and the publication fee paid if it was not paid on filing.

Gibraltar

A Registered Community Design automatically provides design protection in Gibraltar without the requirement that it be registered there.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com. Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at 33 Gutter Lane, London EC2V 8AS

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