

Summary of the European Union Council Regulation on Community Designs

Definition

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.

For this purpose “product” means any industrial or handicraft item. Therefore design protection is suitable to three-dimensional forms, two-dimensional ornamental drawings or combinations thereof, for example, an object characterized by its particular shape and by the ornamental motives appearing on its surface.

Requirements for protection

A design shall be protected by a Community design to the extent that:

- a) it is new, which means that before the date of filing of the application or the date of priority no identical design has been made available to the public;
- b) it has individual character, which means that the overall impression it produces on the informed user differs from the overall impression produced on such user by any design which has been made available to the public before the date of filing of the application or the date of priority.

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

A design shall be deemed to have been available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the European Union.

Extent and scope of the protection

A Community design shall have unitary character and it shall produce equal effects throughout the European Union.

The scope of the protection conferred by a Community design shall allow its holder to prevent any third party not having his consent from making, putting on the market or using any design which does not produce on the informed user a different overall impression.

Duration of the protection and renewal

Upon registration, a design shall be protected for a period of five years as from the date of filing of the application. The registration may be renewed for one or more periods of five years each, up to a total term of 25 years from the date of filing.

Conditions with which applications must comply

Any number of designs may be included in one multiple application for registered Community design; except in cases of ornamentation, this possibility is subject to the condition that the products in which the designs are intended to be incorporated or to which they are intended to be applied all belong to the same class of the International Classification for Industrial Designs. Obviously the costs increase in accordance with the number of designs included.

For us to prepare and file with the Office in Alicante an application for a registered Community design we only need to receive with your instructions the following documents and particulars:

- a) a good representation of the design (or designs, if it is a multiple application) suitable for reproduction, each representation including the views necessary to show all the features of the item, without exceeding seven views;
- b) if necessary, a description explaining the representation (optional and only advisable in very special cases where certain features may not be clearly shown in the representations);
- c) an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied;
- d) the citation of the designer or of the team of designers or a statement under the applicant's responsibility that the designer or the team of designers has waived the right to be cited;
- e) if a priority has to be claimed: filing number, date and country of the first application;
- f) the name, address and nationality of the applicant or applicants.

A Power of Attorney is not needed.

Claiming priority

A person who has duly filed an application for a design right or for a utility model in or for any State party to the Paris Convention for the Protection of Industrial Property, or to the Agreement establishing the World Trade Organisation, or his successors in title, shall enjoy, for the purpose of filing an application for a registered Community design in respect of the same design or utility model, a right of priority of six months from the date of filing of the first application.

In order to take advantage of this right it shall be necessary to file, within three months of the date of filing, a copy of the previous application. If the language of the latter is not one of the languages of the Office (English, French, German, Italian or Spanish), the Office may require a translation of the document in one of those languages.

Priority may be also claimed within two months of the date of filing.

Registration procedure

The application shall be examined only as to whether it meets the formal requirements. If they are satisfied, the registration shall be granted. Otherwise, the Office shall request the applicant to remedy the deficiencies within the prescribed period.

Upon registration the Office shall publish the registered Community design in the Community Designs Bulletin.

Possible deferment of publication

The applicant for a registered Community design may request, when filing the application, that the publication of the registered Community design, and the payment of the publication fee, 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.

At the expiry of the period of deferment or at any earlier date on request by the holder, the Office shall publish the registered Community design, provided that the publication fee is paid.

The request to defer the publication entails the payment of a fee.

Application for declaration of invalidity

Any natural or legal person may submit to the Office an application for a declaration of invalidity of a registered Community design. A decision declaring the registration invalid shall be rendered in the following cases:

- a) if the design does not correspond to the definition under the Regulation;

- b) if the design does not fulfill the requirements regarding novelty and individual character;
- c) if the features of appearance of the product are solely dictated by its technical function;
- d) if the Community design is in conflict with a design protected from a date prior to the filing date (or the priority date) by a registered Community design or by a registered design right of a Member State or by an application for any of such rights, even where said design has been published after the filing date or the priority date of the contested Community registration;
- e) if the Community design includes a distinctive sign already protected by a Community trade mark or by the law of the Member State governing the sign, or it includes a work protected under the copyright law of a Member State.

Before rendering a decision, the Office shall invite the parties, as often as necessary, to file observations on the respective arguments within the prescribed period.

Any party to proceedings adversely affected by a decision may appeal before the Board of Appeal within two months after the date of notification of the decision appealed from.

Against the decisions of the Board of appeal actions may be brought before the Court of Justice in Luxembourg.

Language of proceedings

The application for a registered Community design may be filed in any of the official languages of the European Union Member States, but the applicant must indicate a second language of the Office (English, French, German, Italian or Spanish), the use of which he accepts as a possible language of proceedings before the Office.

In the case of invalidity proceedings, the language of proceedings shall be the language used for filing the application for a registered Community design if this is one of the languages of the Office. If the application was made in a language other than the languages of the Office, the language of proceedings shall be the second language indicated in the application.

Community design courts

Infringement actions may be brought before Community design courts. The Member States shall designate in their territories at least two courts (1st and 2nd instance respectively) which shall be competent for said actions and their decisions shall have effects in all the Member States. These courts shall be also competent to deal with invalidity actions filed as counterclaims.

Protection conferred to unregistered designs

A design which meets the requirements of novelty and individual character shall be protected by an unregistered Community design for a period of three years as from the date on which it was first made available to the public within the European Union, in such a way that it could reasonably have become known to the circles specialized in the sector concerned, operating within the Union.

The right conferred by an unregistered design shall allow its holder to prevent any third party not having his consent from making, putting on the market or using any design which does not produce on the informed user a different overall impression, but only if the contested acts result from copying the protected design. They shall not be deemed to result from copying the protected design and therefore there shall be no infringement, if the design results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

This protection is therefore rather weak and it is advisable to apply for a registered Community design whenever a strong protection is desired. Where the design has already been made available to the public, it will be necessary to file the application within twelve months of the date at which it was first disclosed, otherwise the design shall not be deemed new.

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