

NEW EUROPEAN COMMUNITY REGISTERED DESIGN RIGHT

A Design, in European Community terms, is the appearance of the whole or part of a product resulting from the features of the lines, contours, colours, shape, texture and/or materials of the product and/or its ornamentation. The product can be any industrial or handicraft item including textile designs, packaging, get-up, graphic symbols and typographic typefaces.

Since 6 March 2002, an Unregistered Community Design Right has been in existence providing limited protection for Designs, without the need for registration. A separate paper on Unregistered Community Design Right is also available.

As from 1 April 2003, it has been possible to obtain Registered Community Designs (RCDs) in Europe. The system is administered by the Office for Harmonisation in the Internal Market (OHIM).

The Community Designs system works in addition to national laws in Europe concerning registered and/or unregistered designs and its aim is to provide a unified system for protecting Community designs throughout the entire territory of the European Community, which has not previously been possible.

Since the inception of the Community Designs systems our firm has filed and prosecuted numerous RCD applications. We can also rely on our many years of experience in dealing with OHIM in Community Trade Mark matters. Therefore we are ideally placed to assist and represent you in all aspects of Registered Community Designs.

The European Community (EC) has a total population of over 440 million and currently consists of the following 25 Member States in which Community Design protection will exist:

Austria (AT)	Estonia (EE)	Hungary (HU)	Luxembourg (LU)	Slovenia (SI)
Belgium (BE)	Finland (FI)	Ireland (IE)	Malta (MT)	Slovak Republic (SK)
Czech Republic (CZ)	France (FR)	Italy (IT)	Netherlands (NL)	Spain (ES)
Cyprus (CY)	Germany (DE)	Latvia (LV)	Poland (PL)	Sweden (SE)
Denmark (DK)	Greece (GR)	Lithuania (LT)	Portugal (PT)	United Kingdom (GB)

Advantages of the Registered Community Design (RCD):

- Provides Europe-wide protection with a single registration.
- Low cost – 25 countries for the price of 2
- Protection consists of a monopoly right. There is no need to prove copying in order to establish infringement as is required with Unregistered Community Designs.
- Protection lasts for a maximum of 25 years from filing. Unregistered Community Designs last for only 3 years.
- A single renewal fee is payable every 5 years.
- Simple application procedure.
- No need to prove ownership, although designers have a right to be mentioned.
- The ability to register a design which does not have sufficient “distinctive character” for a Community Trade Mark (CTM) and to establish the necessary “distinctive character” during the life of the RCD and apply for a CTM towards the end of its life.

In the light of these advantages we would strongly urge clients to consider obtaining design protection within the European Community by the RCD route. Some details of the system are set out on the following pages and a summary of the filing requirements is given at the end.

What can be Registered?

RCDs protect a design which is defined as “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 scope of protection conferred is for the design as such, rather than a design applied to a product. However, the product to which the design is applied may affect the validity of the RCD.

An RCD can be for either a 2D or 3D design, and need not be restricted to whole items, but also to parts of complex products (i.e. products composed of multiple replaceable components). For example, a single design may be applied to a range of items of crockery. Similarly, a single design may be applied to a range of items of clothing, luggage, furniture, clocks and watches, or to electrical “white goods” etc. Notably, there is no requirement for an RCD to have an aesthetic quality. Spare parts (e.g. a vehicle exhaust pipe design) may be validly registrable subject to the Exclusions from Registrability and Validity (see below).

Exclusions from Registrability

The only substantive grounds for non-registrability of an application are if the design for which protection is sought does not correspond to the definition of “Design” (see “What can be Registered?”) or if the design is contrary to public policy or accepted principles of morality.

Validity – Novelty, Individual Character and Technical Function

While no examination is conducted, a valid Registered Community Design must be Novel and have Individual Character. It is subject to restrictions on the design’s technical function.

A design is novel if no identical design has been made available to the public anywhere in the world before the date of filing of an application for an RCD or, if priority is claimed, the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details. A design is considered to have been made available to the public if it has been published or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community. There is a 12 month “grace period” from the date of a disclosure by the designer in respect of disclosures made by the designer. However, we recommend that the grace period not be relied upon since it does not apply to disclosures of designs produced independently.

The requirement for “individual character” is based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by any design which has previously been made available to the public. This must take into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design.

A Community Design will also not subsist: in features of appearance of a product solely dictated by its technical function; in features that must be reproduced in a product in its exact form in order to be connected or placed in, around or against another product so that either product may perform its function; or where the design is incorporated in a component part of a complex product and is not visible during normal use.

Where to File

Applications may be filed at OHIM in Alicante, Spain but we can also file Applications at the UK Patent Office.

Applicants, Representatives and Authorisations

Any person may be an applicant for an RCD. Applicants based outside the European Community must appoint a Representative in all proceedings aside from the filing of RCD Applications. We would recommend that a Representative be appointed by all applicants and our firm is ideally qualified and experienced to act for you in this way. An authorisation form is not required under normal circumstances.

Filing Requirements

In order to file a complete RCD application we will require the following:

- The name, address, nationality and state of domicile of the applicant.
- At least one representation.
- An indication of the products to which the design is to be applied, including their Locarno Classifications if you have them.
- Details of any priority to be claimed.
- A description of the representation may be given but statements of novelty are not permitted. The description may not be more than 100 words.
- Instructions if deferred publication is to be requested.
- It is also advisable to identify the designer (or team of designers if the design results from teamwork).

Official Fees are also due for payment upon filing.

Representations

- For Ornamental (2D) and for 3D designs, a maximum of 7 views will be allowed on sheets of A4 sized paper.
- Each view must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size not more than 8 cm by 16 cm per view. Photographs or drawings may be submitted.
- The filing of actual physical specimens is extremely limited.
- For typographic typefaces, the following must be provided: a string of all letters of the alphabet in both upper and lower case; all arabic numerals; and a text of five lines produced using the typeface. The letters and numerals should be in size pitch 16 and on A4 sized paper.
- We recommend that informal representations are not filed.

The requirements for representations are relatively stringent. If we are supplied with representations that do not meet the requirements then adaptation of them prior to filing may be essential because opportunities to amend after filing are limited.

Multiple Designs

An application can be filed for multiple designs.

- Additional fees are payable, but there can be substantial reductions compared with the cost of filing separate applications.
- For 2D designs there are no limits placed upon the filing of multiple applications.
- For 3D designs, multiple designs are limited in that they must all concern the same main classification of goods – please consult us for specific advice if you wish to file multiple applications for 3D designs.
- After filing, each design effectively becomes a distinct registration and separate renewal fees are payable for each design.

Priority

Any priority must be claimed within one month of the filing date. The priority document must be submitted within three months of priority being claimed.

Language

The Application may be filed in English but another official language must be nominated which may be used in certain proceedings. If an Application is filed in English then any subsequent Invalidity proceedings will also be in English.

Procedure

Once an application has been filed, it receives a formality examination and also examination as to Exclusions from Registrability (see above). There is no examination for novelty or individual character. The design is then published in the Community Designs Bulletin, typically 4 to 6 months after filing under normal circumstances. At the Applicant's request, publication can be deferred for 30 months from the filing date (or the priority date). After publication, a Registration certificate is issued.

Renewal

Renewal fees are payable every 5 years from the filing date of the RCD Application up to a total term of 25 years from filing.

Assignment and Licensing

An RCD may be transferred in its entirety but may not be divided by territory within the Community. An RCD may be licensed for the whole or part of the Community. A register will be maintained in which transfers and licences should be recorded. Any assignment should be signed by both parties to the assignment.

Invalidity

OHIM does not examine Applications for novelty or individual character. Consequently, most Applications do proceed to registration. It is left up to third parties to challenge Registrations that are invalid. Invalidity proceedings must be brought before OHIM and are primarily a written procedure. The grounds for invalidity are as follows.

- That the design falls into an Exclusion from Registrability or lacks Validity (see above).
- That the right holder in the RCD is not entitled to it.
- That it conflicts with an RCD application or application for a registered design right of an EC Member State having an earlier priority/filing date.
- That use of the design would conflict with certain other rights.

We can arrange for a watching service for clients who wish to monitor Community Design Registrations so as to bring invalidity proceedings where necessary.

Infringement

An RCD confers the right to prevent third parties from using the design, irrespective of whether the third party has copied the design. This includes making, offering, putting on the market, importing, exporting or using a product in which the design is incorporated or to which it is applied or stocking such a product for these purposes. Infringement proceedings must be brought in the national court of an EC Member State – normally the state in which the alleged infringer is domiciled.

As usual with a summary note we have only been able to deal with matters in a general fashion. For advice on specific situations please refer to us.

REGISTERED COMMUNITY DESIGNS

Checklist for Filing Applications

Essential

- Name, address, nationality and state of domicile of the applicant, including state of incorporation for a legal entity.
- Sufficient representations to illustrate the design (for colour designs please provide us with at least 2 copies of each representation).
Official requirements are:
 - for 2D or 3D designs: up to 7 views on sheets of A4 sized paper;
 - for typefaces: all letters of the alphabet in both upper and lower case; all arabic numerals; and a text of five lines produced using the typeface, all characters being in size pitch 16 and on A4 sized paper.
- An indication of the products to which the design is to be applied (including Locarno Classifications, if possible).
- Date and country of filing of any previous application from which priority is to be claimed (can be supplied up to 1 month late).

Optional

- Identity of the designer (or team of designers if the design results from teamwork).
- A description of the representation of up to 100 words (statements of novelty are not permitted). n.b. The filing of a description may delay Registration.
- Instructions for deferred publication.