

Is EU Community design the top dog in design protection?

It can be hard to choose the most appropriate and cost-effective means of protecting designs within the European Union. This article looks at the issues that parties may wish to consider if they import, distribute or sell products within the European Union by reference to their innovative, visual appeal.

What forms of design protection are available?

It is possible to register designs on a country-by-country basis, including in the UK, but the costs of cumulative national filings and official fees can be prohibitive. In consequence, design law has been significantly harmonised within the EU over the last decade with the express goal of encouraging design innovation and the development of new products. In particular, two new forms of design protection which provide pan-European cover have been created. The Community Designs Regulation (CDR) introduced both a short-term unregistered Community design (UCD) and a longer-term registered Community design (RCD) which can be obtained by a single filing. In parallel, UK law also provides unregistered protection for artistic works (e.g. architectural plans) through copyright and a much more limited design right (UDR) for non-artistic works (for example, the fictional Imperial Stormtrooper helmet created for the Star Wars films in *Lucas v Ainsworth*) which can also protect a design from being copied and exploited within the UK.

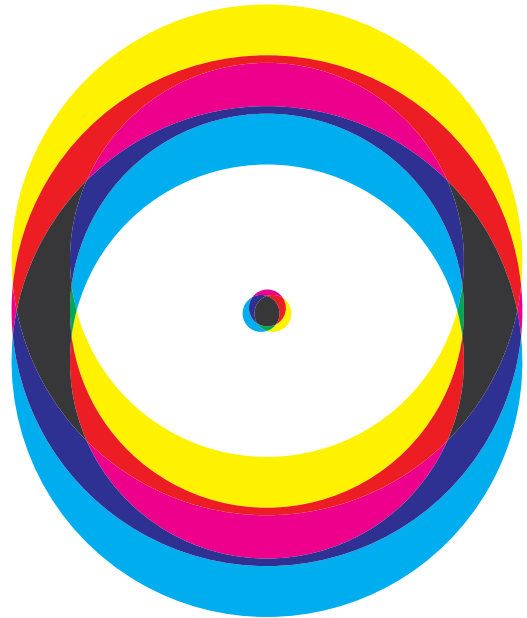
What are the advantages of registration?

The scope of protection offered by RCD is superior to UCD in two critical respects: the term of protection and the degree of exclusivity. RCDs (and UK registered designs) provide a term of protection, renewable in 5 year blocks, up to a total of 25 years from the date of filing. UCD provides protection for a period of 3 years from the date the on which the design was made available within the EU. Unregistered rights (UCD and UDR) arise automatically but are far more difficult to enforce because copying must be proven. By contrast, RCD confers exclusivity whether or not the design is copied. In general, where designs change slowly or a product's desirable appearance permits the vendor to charge a premium price, obtaining RCDs is very likely to secure a better return on investment. Even in those sectors which produce large numbers of designs for products which have a short market life UCD can be an inadequate deterrent. For example, in the fashion industry, where UCD was expected to be sufficient protection, the speed at which discount retailers source cheap copies

of fashion garments and accessories can erode profits within weeks of a new product coming to market.

What features are protected?

Community design protects the visual appearance of the whole or part of a product and, in particular, the lines, contours, colours, shape, texture and materials of the product itself and its ornamentation. The product can be an industrial or handicraft item as well as packaging, get-up and graphic symbols. The last can lead to surprising results, with corporate logos and their location and prominence on a product all being taken into account in determining whether an accused product may infringe a registered design. Features which are solely dictated by their technical function or by the requirement to inter-connect with other articles (e.g. the terminals of plug intended to fit into a socket), as well as component parts which are not normally visible during normal use of the product (e.g. a car engine), are excluded from protection. An RCD provides an enforceable right



to prevent others using or exploiting the design (e.g. by making, selling or using products which incorporate the design).

When does the design qualify for protection?

In order to qualify for design registration a design must be “new” and have “individual character”. A design will be new if no identical design has been previously made available to the public, where “identical” means that the designs differ only in unimportant details. A design has individual character when the overall impression produced on an “informed user” viewing the design clearly differs from that produced on the user by the existing body of designs, taking into account the nature of the article to which the design is applied and the industrial sector to which it belongs. We assess and advise on whether a design may be new by conducting searches of the designs registers. Depending on whether the product is an everyday item, or used only in a specialised sector, the expertise of an “informed user” may also be required.

Taking advantage of priority and the grace period

Up to six months priority can be claimed from earlier filings in countries outside the EU which are members of the Paris Convention. So, for example, if a design filing is first made in the US for products which are bound to find their way into the EU shortly after then the use of a priority claim should be considered. The CDR also, helpfully, allows for a product to be tested on the market in the EU for

up to 12 months before deciding whether to file for registration (assuming no prior disclosure). This can provide a practical means of assessing product demand and the potential long-term benefits of registration in advance of having to make a decision as to whether to seek registration.

Cost-effectiveness of registration

An application for an RCD is made to a single office and will provide uniform cover in all EU Member States. For cover in the UK alone an application for a registered design may be made to the UK IPO and will be assessed under the same criteria used to assess RCD applications. There is no substantive assessment of applications and, provided the necessary documents are in order, an RCD application usually proceeds to registration with little or no difficulty, by a single application to a single office (OHIM or the UK IPO), which can be electronically filed. RCD is the most cost-effective system of securing protection for a design in more than one EU Member State. There are official fees for filing and publication which must be paid up front and for a fixed fee we can prepare all of the necessary documents, including visual representations of the designs, and file your design with the appropriate office. In certain cases, savings can be made by filing several designs combined into one application, provided they fall within the same class of goods under the Locarno classification system.

How do I enforce my design rights?

Enforcement varies from country to country but in the UK design rights are enforced through courts specialising in IP matters. In England, matters involving the infringement and validity of RCDs are dealt with by the Patents Court and the Intellectual Property Enterprise Court in London, which are specially designated Community design courts. One matter to bear in mind is that persons and corporations not resident in or having an industrial or commercial presence within the EU are required to act through an authorised, professional representative for OHIM filings and oppositions, and appeals to the Court of Justice of the European Union.

Need advice?

For more information, please contact email@carpmaels.com.

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