

DESIGN

Note on the Community Design After 7 years of thought...

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The Council Regulation of 12th December 2001, in respect of a ruling on the creation of a Community design, was finally adopted after seven years of discussion since the first proposition was made by the European Community Commission.

The first purpose of this Regulation is to create not one, but two new industrial property rights.

Therefore, among all the available protections (copyright, national or international design applications of designs, even the filing of trademarks), it will now be necessary to take into account not the Community design but Community designs (CD):

- the registered Community design (RCD) for which, applications can be filed as from the beginning of 2003,
- the unregistered Community design (UCD), whose protection can be claimed since 6th March 2002.

1. Origin and conditions of rights

The right of a Community design belongs to its designer or his successor in title. For the RCD, the design protection starts from the date of filing at the Office of Harmonisation of the Internal Market (OHIM) in Alicante.

On the other hand, for the UCD, the right dates from the disclosure of the design to the public, within the Community, by the publication, exhibition or commercial use, so that

the specialised circles in the sectors concerned, operating in the European Community, can be reasonably informed of the design.

On the other hand, the conditions of existence of the rights, provided for in the Regulations, are identical, irrespective of whether the CD is registered or not.

These are as follows:

- The protection belongs to the visible appearance of a product or to part of a product. The elements, which are not visible in the course of normal use are not protected. Normal use excludes maintenance, servicing or repair work.
- The CD should be new. It should not have already been disclosed by its owner in the past, or already be known, at the time of filing the application (for the RCD), or at the time of the disclosure (of the UCD), except if these disclosures could not reasonably be known by the specialised circles of the sector concerned.

Exceptions are, however, scheduled to alleviate this ruling, especially in the event of abuse by third parties (see also below “when to file”).

- The CD should have an individual character. It should give the overall impression to the informed user of being different from the existing designs.

However, note will be taken of the degree of freedom which the designer had when designing his design.

- Even if no degree of aesthetic appearance is required, the appearance of the design should not be imposed solely by the technical function of the product concerned. An exception is, however, made for the parts used for assembling and connecting in modular systems.

Such would be the case, for example, of parts for construction, which can be adjusted to each other, such as bricks or panels, which are made to fit into each other.

Finally, the CD should not be contrary to public policy or to accepted principles of morality.

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2. Extent of the protection conferred to the CD

The extent of the protection of a CD varies according to whether one is talking about a RCD or a UCD.

In fact, one of the aims of the Regulation was to enable companies, which produce a large number of designs with a short economic life span, to benefit from a certain type of protection, by means of a UCD, without having to go through the whole filing procedure.

Nevertheless, the UCD is, by definition, a short and limited protection.

- *Geographical area*

In both cases, the CD is a unique right covering all of the European Union.

- *Length of protection*

For the RCD: Five years (5), which can be extended four times as from the date of filing, that is, for a maximum of twenty-five (25) years.

For the UCD: Three years (3) years as from the date of disclosure.

- *Effect of the protection*

For the RCD: against all unauthorised use of a similar or identical design.

For the UCD: against the only copy.

The protection of the CD is, however limited according to the principle known as exhaustion of rights, at the end of which the owner of the CD cannot object to the circulation of his design in the European Union, once the design has been put on the market in the European Union with his consent.

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3. Procedure for filing the UCD

The UCD cannot be filed. Thus, in addition to the proof of ownership, it is essential for the owner of a UCD to be in possession of the proof of disclosure of the design and of the date of this disclosure since these are the elements which give rise to the right to be protected for a period of three (3) years.

As far as the RCD is concerned, this should be the subject of an application for registration at the OHIM in Alicante.

The registration procedure is characterised by a formal examination of the legality of the application. No examination of the existing prior rights is done. The application for registration should be accompanied by the payment of taxes and, if need be, by a request for the deferment of the publication of the RCD.

- *Who may file a RCD?*

Any natural or legal person, irrespective of his nationality.

The representation of foreigners at the European Union is compulsory for all procedures but not for filing a design application.

In any procedure, the applicant is assumed to be the owner of the rights on the design. However, the designer has the right to see his name mentioned on the filing application of the design.

- *When does one file?*

- within the six-month period known as “priority” following the filing of a national design in a member state of the Convention of Paris or of the OMC and/or

- within a year following the disclosure of the design.

Talking of a RCD, if a filing application is not filed, at the latest, within the period of one year following the disclosure, the owner will only be entitled to the rights for a UCD.

- *What does one file?*

The application request should include graphical representations or photographs of the design. The filing of an application for tri-dimensional designs is possible. Filing applications including several designs are also possible as long as the designs belong to the same class of the Classification of Locarno. The filing application should also include the name of the product to which the design applies.

- *Language of the filing application*

The filing application should be made in one of the eleven official languages of the European Union. The choice of a second language, from among the five OHIM languages, should be mentioned.

- *Cost of a filing application*

This is not yet known.

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4. Litigation regarding Community designs

Litigation regarding Community designs falls within the jurisdiction of the specialised first and second instance Courts, known as Community Design Courts, which should be designated by the member-states by 6th March 2005 at the latest.

These Courts will have exclusive jurisdiction in infringement actions, actions for declarations of invalidity of a UCD and counter-claims for declarations of invalidity of a registered or unregistered CD, raised in connection with an infringement action.

In application of the Regulation provisions regarding jurisdictions, the Courts could come across infringement cases, which could have been committed on the territory of any member-state with the result that it would be possible to have a decision rendered which could possibly be valid throughout all of the European Union.

The competent Court is the Court of where the defendant is domiciled, or failing that, where the plaintiff is domiciled or, failing that, a Spanish Court and also the Court of wherever the infringement has been committed.

Temporary measures, including protective measures, which exist at a national level, can also be requested.

The OHIM is competent for dealing with the direct requests for cancellation of a RCD.

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5. CD – Ownership

A CD can only be assigned for the European Union as a whole.

A CD can be the subject of a licence for all or part of the European Union. These dispositions apply whether a CD is registered or not.

The RCD can also be given as a security, be the object of real rights in rem or forced execution measures.

These juridical acts relating to a RCD should be recorded on the CD Register in order to be able to be opposed against third parties.

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6. Spare parts for particular designs

These are parts, of a complex product, which are used, for the repair of this product, to restore its appearance.

The example, which is mentioned the most, is that of spare parts for motor-cars such as mudguards, rear-view mirrors, wings, etc.

Due to the differences which still exist between the national laws, what is at stake economically speaking, resulting from their protection, or on the contrary, what the result would be if the spare parts were not protected, the latter spare parts are not concerned by the Regulations, for the moment.

The status of the spare parts is, therefore, still subject to national laws.

However, the European Community Commission should put forward proposals regarding these spare parts in 2004.

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7. Choice between the various available protections for a design

The CD is a new type of protection which does not substitute already existing protections, whether these result from national or international filing applications or from copyrights.

In this respect, the Community design combines a unique, simple and short procedure giving the same widespread results, which should be in favour of it being a success.

The protections available and the choice between the various procedures are multiple in respect of registered, unregistered, Community designs, national and international filing applications, copyrights and trademarks.

This should incite a candidate, who is interested in a protection, to take the time to seek advice before deciding whether to file, a design, or not, and especially since, if the design were disclosed before it was filed, he will run the risk of losing his right, for good, to a national protection for a design, or of only benefiting from a reduced Community protection, in respect of a non-registered design.