

DESIGN PROTECTION IN THE EUROPEAN COMMUNITY RECENT DEVELOPMENTS AND FAQs

On the European Community level, there are currently important legislative developments regarding protection of designs that should be of interest for European as well as non-European designers and/or legal entities employing them.

One is Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the Legal Protection of Designs (OJ L 289, 28.10.1998, p. 28¹, "**Design Directive**"). The Design Directive aims at harmonizing the national Member States' design laws. Although this Design Directive had to be implemented by the Member States into national law by no later than October 28, 2001, German legislature missed this deadline and so far no legislative proposals have been made by the Ministry of Justice. Therefore, the provisions of the Design Directive are not applicable in Germany so far. We will further comment on legislative changes in Germany brought about by implementing the Design Directive.

The other is Council Regulation (EC) 6/2002 of December 12, 2001 on Community Designs (OJ L 3, 05.01.2002, p. 1², the so-called Community Design Regulation or "**CDR**"). The CDR entered into force on March 6, 2002. A corresponding Implementing and Fees Regulation ("**IFR**")³ is still to be enacted; however, we have been informally assured by the Office for Harmonization in the Internal Market in Alicante ("**OHIM**") that the current proposal will not be subject to further changes.

For the first time ever, the CDR provides for a Community design taking effect in the whole European Community. OHIM is entrusted with Community design administration.

The CDR establishes a **dual system** of protection affording rights not only to **registered designs ("RD's")**, but also to **unregistered designs ("UD's")**. In the following, we want to take the opportunity of pointing out a few crucial issues.

1. What qualifies as a Community design?

Art. 3 (a) CDR defines a "design" as "the appearance of the whole or a part of a product". A "product" is defined to comprise any "industrial or handicraft item, packaging, get-up, graphic symbols and typographic typefaces" (Art. 3 (b) CDR). By way of example, the CDR names "lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation" as possible appearances of a product that might qualify for protection. It follows from the definition that neither production processes nor natural products as such qualify as designs. The same is true for products whose form may vary (e.g., liquids) or immovable items such as buildings. In the area of software development, an icon or a certain design of a menu or other overall impressions on computer screens may enjoy protection.

2. What are the requirements for protection?

According to Art. 4 (1) CDR, a design shall be protected to the extent that it is "new" and has "individual character".

A design shall be considered to be "new" if no identical design has been made available to the public (Art. 5 (1) CDR) prior to the filing/priority date of an RD or the date on which the UD has first been made available to the public, respectively. According to Art. 5 (2) CDR, designs are deemed to be identical if their features differ only in immaterial details.

¹ cf. <http://oami.eu.int/en/aspects/propdir.htm>

² cf. http://oami.eu.int/en/aspects/pdf/reg2002_6.pdf

³ cf. <http://oami.eu.int/en/design/pdf/reg-2002-3687.pdf>

The requirement of “individual character” (Art. 6 CDR), on the other hand, is fulfilled if the overall impression of a design differs from the overall impression of any other design which has been made available to the public prior to the filing/priority date of an RD or the date on which the UD has first been made available to the public.

3. What about technical features of a product?

According to Art. 8 (1) CDR, a Community design shall not subsist in features of a product that are “solely dictated by its technical function”. The underlying rationale for this provision is that the Community legislator did not want to see technological innovations being hampered by granting design protection to purely technical features. For example, wings that have been designed by strictly following the principles of aerodynamics would not qualify for protection. On the other hand, it might be that there is, in fact, only a limited number of purely functional features, whereas the overall appearance of the product qualifies for protection. Likewise, protection might subsist in a feature which, despite being functional, shows design features. Take, for example, the steel tubular frame chairs designed by Mart Stam which embody purely technical features (in that a slight springing of the chair is effected by a limited use of chair bracings), whereas the proportions and strict linear form have esthetic quality.

4. Is protection granted to “*must-fit*”-Elements?

No. According to Art. 8 (2) CDR, features that must necessarily be reproduced to permit a product to be mechanically connected to or placed in, around or against another product are excluded from protection. Take, for example, couplings allowing connection of the hose with the vacuum cleaner. Such designs are excluded from the scope of design protection.

5. Are elements of complex products (“*must-match*”-elements) protected?

Often, protection is sought for a component of a complex product, e.g. headlights or

fenders of a car. In fact, the issue of protection afforded to component parts has been discussed extensively during the legislative process and plays its major role in the automobile industry. Art. 4 (2) CDR affords protection to component parts only if they remain visible during normal use of the complex product by the end user and fulfill in themselves the requirements as to novelty and individual character (Art. 4 (2) CDR). According to Art. 4 (3) CDR, it is not sufficient if the component part is visible only during maintenance, servicing or repair work as this is not considered as the “normal use”.

6. In how far does repairing of a complex product infringe a design right in a component part?

According to Art. 110 (1) CDR, for the time being protection shall not exist for a component part if the complex product is repaired so as to restore its original appearance. This provision reflects social policy concerns as regards repair of complex products as any protection of such part would inevitably hamper the repair business and tie the consumer to the seller of the original product. In fact, the requirement that a component part be visible to qualify for protection might change in the future as the Design Directive provides for the Commission to address the issue of protectability of such component parts again by the end of 2004. Legislative changes of the Design Directive would, most likely, have an impact on the CDR as well.

7. Is it true that the CDR affords protection for designs irrespective of registration?

Yes. According to Art. 11 CDR a design that is new and has individual character may be protected by an unregistered Community design (“UD”) automatically by mere disclosure. The underlying rationale is that in some sectors there are designs for products that have a short market life. If such designs were to be registered, registration formalities would put an excessive burden on the designer.

The UD may be obtained as of March 6, 2002 (i.e., when the CDR took effect). To qualify for protection, the design needs to be

made available to the public within the European Community. According to Art. 11 (2) CDR, this might be effected by publishing, exhibiting, using in trade or otherwise disclosing the design. It is a prerequisite that these events could reasonably have become known to the circles specialized in the sector concerned, operating within the European Community. For example, if a design is exhibited on a fair in Japan and a magazine within the European Community, which is usually consulted by the circles specialized in the sector concerned, reports on it by showing pictures of the design, it would be regarded to have become available within the European Community (as well), thus qualifying for protection.

8. What happens to designs that were made available to the public before March 6, 2002 and were not registered?

Before March 6, 2002, UD's did not enjoy Community-wide protection.

The CDR does not explicitly address whether these designs are protected retroactively, which brings about some uncertainty. However, there are convincing arguments that rights may only be based on UD's that have been made available to the public for the first time after March 6, 2002.

9. As of when may one file for registration of a design?

So far, no application for an RD may be filed. The OHIM presently informally advises the following intended time schedule:

First official filing date: April 1, 2003

OHIM will, according to Art. 111 (3) CDR, start processing applications received as of **January 1, 2003**, which will be deemed to have been filed on April 1, 2003.

It may be expected that the IFR will be adopted this year by the European Commission.

According to Art. 41 CDR, a designer enjoys a right of priority of six months from the date of filing of a national application if the application was first filed for in a Member

State of the Paris Convention or the WTO. In practice, therefore, a registered Community design may claim priority of applications that were first applied for nationally on or after **October 1, 2002**.

10. Are applicants from within the European Community treated differently from those from outside?

Only as regards prosecution of an RD.. Those not having either their domicile or their principle place of business or a real and effective industrial or commercial establishment within the European Community must be represented in proceedings before OHIM other than filing an application (Art. 77 (2) CDR). Representation may be undertaken by, inter alia, attorneys and patent attorneys.

In any case, the right to a UD is afforded irrespective of the nationality of the designer.

11. Is the scope of protection afforded to registered and unregistered Community designs identical?

Not quite. According to Art. 19 (1) CDR an RD confers the right to prevent others from "using" it. The scope of protection encompasses any design which does not produce on the informed user a different overall impression (Art. 10 (1) CDR). No product falling within the scope of protection of an RD may be made, offered, put on the market, imported or exported for using the product, or stocked for those purposes (Art. 19 (1) CDR).

Although the scope of protection conferred by an RD is identical to the scope of protection of a UD, the rights conferred by the latter have the additional requirement that the use results from "copying" (Art. 19 (2) CDR). Copying requires knowledge of the protected design. Therefore, if a design results from an independent work of creation by a designer, it does not constitute copying.

In practice, the holder of a UD has to provide facts allowing the conclusion that the designer of the purportedly infringing product knew or could have known this design. For example, a designer may seek presentation

of his design on an official or officially recognized international fair, allowing not only claiming a right of priority for the purposes of filing for a registered design within six months (cf., Art. 44 CDR), but also providing the opportunity to obtaining evidence for making the design available to the circles specialized in the sector concerned, operating within the Community. Art. 19 (2) S. 2 CDR provides a rule of presumption in that it does not constitute copying if the contested use results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the UD. In practice, substantial similarity of the designs show prima facie that the copy does not result from an independent work.

12. What are the terms of protection for an RD and a UD, respectively? Is there a possibility for prolongation?

a) UD's

The unextendable term of protection for a UD is limited to three years and begins with the date on which the design could first have become known to the public within the Community.

However, Art. 7 (2) CDR allows registering a previously unregistered design within a period of 12 months if the design was originally disclosed by the designer or can be traced back to him. This 12 month period is not a grace period, though, i.e. any design of a third party that has been made available to the public in the meantime will be taken into account when considering novelty and individual character.

b) RD's

An RD is protected for an initial five year period, starting with filing. The term of protection may be renewed for subsequent five year periods up to a total term of 25 years.

13. Is there also the possibility to file for a Community trademark consisting of a design instead of or in addition to filing for an RD?

In general, this would be possible, in particular since three-dimensional trademarks may be registered. However, one needs to keep in mind that a design might not meet all requirements of a Community trademark, in particular for not being sufficiently distinctive (in that the design does not allow the consumer to distinguish the product marked from others).

If you have any further questions, please do not hesitate to contact us at info@grunecker.de.