A brief guide to...
Community Design Protection

The Community Design Regulation provides an efficient and cost-effective system for the protection of industrial designs in a uniform manner throughout the European Community and provides both a registered Community Design and an unregistered Community Design. Venner Shipley have produced this guide to assist those unfamiliar with this important aspect of design protection.

Registered Community Designs
A registered Community Design is a monopoly right and can be used to prevent an unauthorised person from making, supplying, importing, exporting, using or otherwise dealing in products incorporating the design anywhere in the European Community. There is no requirement to prove that the design has been copied and the rights last for an initial period of 5 years extendible for further periods of 5 years up to a maximum of 25 years.

Unitary Character
A Community Design registration is a single registration enforceable in all the countries of the European Community without any separate formalities in each country. On the basis of one application, protection may be obtained in all states of the EU. It should be noted that a Community Design can only be registered, transferred, surrendered and declared invalid in respect of the whole of the Community. However, it can be licensed for the whole or part of the Community.

Community Design Applications
The registered Community Design system is administered by the Office for Harmonization in the Internal Market (OHIM) in Alicante, Spain. Applications can be filed either electronically via to OHIM website or as a hard copy, directly at OHIM or locally through a national office such as the UK Intellectual Property Office who will forward applications directly to OHIM. The examination conducted by OHIM covers only formal requirements although a check is made to ensure that protection is being sought for a design as defined by the Regulation. Once accepted for registration, the design proceeds to publication in the Community Designs Bulletin. However, it is possible to request deferment of publication in which case the design will be kept secret for up to 30 months from the filing or claimed priority date. Preventing publication may be preferable when an applicant wishes to obtain registered Community Design protection before launching a new design and wants to avoid making it open to public inspection once the design has been registered.

Multiple Designs
A significant advantage of the Community Design system is that it allows an applicant to file any number of different designs in a single application even if each design has a completely different appearance from the other designs. The only restriction is that, where the designs are three dimensional rather than merely ornamental, the products to which the designs are applied must all fall within the same class of the Locarno Classification which is general enough to allow many designs to be covered by one registration. Although fees are charged for each additional design, they are significantly less than the cost of filing another application.

Registrable Designs
The definition of what constitutes a registrable Community Design is very broad and there are not many designs that are excluded from registration. In particular, there is no requirement for aesthetic considerations to be taken into account when assessing the registrability of a design. Therefore, the appearance of functional designs are also registrable. Protection can also be sought for parts of products, packaging, get-up, graphic symbols typographic typefaces and graphical user interfaces, even animated GUIs by filing sequential images of the animation. The design can result from features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself or its ornamentation.

The above definition creates an overlap in potential forms of protection with other types of intellectual property as it enables registered Community Design protection to be obtained for a company logo or device in addition, or as an alternative to, a registered trade mark. For example, it may be beneficial to obtain registration as a Community Design when the number and class of goods to which the design is to be applied is very varied, as the protection afforded by registration extends to all goods rather than just those that fall within a particular class.

Requirements For Protection
To be protectable, the design must be new and must have individual character. A design is considered to be new if no identical design, or no design whose features differ in immaterial details, has been made available to the public anywhere in the world before the date of filing of the application for registration or if priority is claimed, the date of priority. However, a disclosure is not considered to have been made available to the public if it is made by the designer during the 12-month period preceding the date of filing of the application or, if priority is claimed, the date of priority. This 12-month grace period allows designers to
begin marketing their product incorporating their design without defeating the novelty of the design, provided that they make an application for a registered Community Design within 12 months of disclosing it. However, it should be noted that this exception only applies to disclosures made by the designer himself. Therefore, if a third party discloses an identical design or one that differs only in immaterial details, and which they have created independently prior to the designer’s filing date, then this disclosure will prevent registration even if it is made during the grace period. Therefore, our advice is to file an application for registration of a Community Design as soon as possible and, preferably, before disclosing the design to the public.

A design is considered to meet the requirement of individual character if it gives a different overall impression to an informed user of the design to any existing design which has already been made available to the public. When deciding whether a design has individual character, the degree of freedom of the designer in developing the design is taken into account. Therefore, a functional design which is similar to a design that has already been made available to the public is more likely to be registrable than an ornamental design that is similar to a design that has already been made available to the public, as the designer has more design freedom when creating an ornamental design than with a functional one.

Infringement
An action for infringement of a registered Community Design is heard before a Community Design Court that has the jurisdiction to impose a European Union wide injunction and award damages.

Unregistered Community Designs
Assuming that the design fulfils the same criteria for validity as for registered Community Designs, unregistered Community Design protection will come into existence automatically by making articles incorporating the design available to the public within the European Community. Infringement of an unregistered Community Design will occur if an unauthorised person makes, supplies, imports, uses or otherwise deals in a product incorporating the design. However, an important difference between the unregistered Community Design and the registered Community Design is that infringement of the unregistered Community Design only occurs when a similar or identical design has been copied from the earlier design. Furthermore, the unregistered Community Design has a period of protection of only 3 years from the date of first publication of the design in the European Community.

The usefulness of the unregistered Community Design is limited by the requirement for the designer to prove that their design has been copied and also by the relatively short period of protection. A designer seeking to optimise his protection in the European Community is therefore advised to obtain a registered Community Design.