

# Roadmap

## for Intellectual Property Protection in Europe

### How to register and protect a Community Design

Suggested for use by right holders,  
particularly new entrants to the EU market

Prepared Spring 2009

It is strongly emphasised that the information provided in this publication by no means constitutes legal advice and should not substitute for counsel. The information is based on the opinion of independent experts and does not claim to be either complete or definitive; but is intended merely as a guide. The relevant Chinese laws, EU and Member State laws and other available legal and technical sources should be properly consulted when seeking protection for IP rights.

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# Overview

In the past, designs have often been considered minor rights when compared with patents and trademarks. In recent years, this assumption has been overturned: designs are everywhere around us even if sometime we do not perceive their existence. Not only outstanding pieces of artwork can be defined as design because no objective aesthetic appeal is requested for their protection. The shape of a picture frame, our mobile phone, clothes, furniture, cars, stationary, even bottles of mineral water, labels, decorations, graphic symbols and combination of colours constitute a design.

Consequently, designs are acquiring an increasing economic value that must be protected against free riders. An efficient system of protection must be planned around the specific characteristics of a particular right: The European system for the protection of design rights aims for a more accessible protection for designs that will consequently encourage innovation and the development of new products.

The consideration that many designs are developed for products that have a very short market life (i.e. fashion accessories) induced the European legislator to provide for two different forms of protection. On the one hand, an Unregistered Community Design (UCD) is protected for only three years without the burden of registration formalities: on the other hand, the Registered Community Design (RCD) guarantees exclusive rights over designs with a predictably longer market life.

A Community design is a supranational, unitary, exclusive intellectual property right valid for all 27 Member States of the European Union (EU): Community designs are governed by the Community Design Regulation and administered centrally by the Office for Harmonisation in the Internal Market (OHIM). In other words, a Community design right produces the same juridical effects throughout the whole European Community considered in its entirety, bearing in mind that no choice of Countries is allowed.

The countries covered by this supranational right are: Austria, Belgium, Bulgaria, Cyprus, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, the Netherlands, Latvia, Lithuania, Luxembourg, Malta, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the United Kingdom.

Although it is not possible to limit the protection of the Community design only to some countries of the EU, it is still, of course, possible to register a national design only in the EU countries of interest because the community design system co-exist with national systems. In addition, thank to the thorough harmonisation process undergone by those countries, the law that applies to national designs of the EU Member States and that applies to Community designs, is substantially the same.

However, it must always be remembered that OHIM does not replace the industrial property offices of the Member States of the European Community and the courts competent to rule on RCD and UCD infringements are specialised national courts of the EU Member States.

# Part I: Basic concepts

## WHAT IS A DESIGN?

In law, a design is the external appearance of a product or part of it, resulting from the lines, contours, colours, shape, texture, materials and/or its ornamentation.

The design or shape of a product can be synonymous with the branding and image of a company and can become an asset with increasing monetary value. If one does not seek protection, free riders may benefit from the investments and efforts made. For this reason, it is advisable to apply for protection as soon as a new design is ready and before making the design available to the public.

## WHAT IS A COMMUNITY DESIGN?

A Community design is a right for the external appearance of a product or part of it, resulting from the features of the product itself and/or its ornamentation valid for all 27 Members of the European Union and directly enforceable in all of these countries.

The Community Design Regulation No 6/2002 is the core legislation for the regulation of the EU Design system.

The term Community design encloses two different rights: the Registered Community Design (RCD) and the Unregistered Community Design (UCD).

**Note:** there are important differences between these two different rights.

Registered Community Designs (RCD) are administered by the Office for Harmonisation in the Internal Market (OHIM). The OHIM is the official trademarks and designs registration office of the European Union, which carries out the tasks entrusted to it by the Regulation.

Once a design can be qualified as a Community design (in the ways and under the conditions that will be explained in this roadmap and with the due differences between RCD and UCD), the following statements apply;

- making a product incorporating the protected design (or to which the design is applied) without the consent of its proprietor would be considered illegal;

- putting on the market a product incorporating the protected design or to which the design is applied) without the consent of its proprietor would be considered illegal;
- offering for sale a product incorporating the protected design without the consent of its proprietor would be considered illegal;
- marketing a product incorporating the protected design without the consent of its proprietor would be considered illegal;
- importing/exporting a product incorporating the protected design without the consent of its proprietor would be considered illegal.

## WHAT ARE THE MAIN DIFFERENCES BETWEEN A REGISTERED (RCD) AND AN UNREGISTERED (UCD) COMMUNITY DESIGN?

Although RCD and UCD are defined by the Community Design Regulation in the same way, and both must satisfy the same requirements (mainly novelty and individual character) before protection may be conferred, the **scope and duration** of the protection afforded to their right owners are quite different.

### The term of protection

**A RCD is initially valid for five years** from the date of filing and can be renewed in blocks of five years up to a maximum of twenty-five years.

**An UCD is given protection for a period of three years** from the date on which the design was first made available to the public within the territory of the European Union («disclosure of design»).

**After three years, the protection cannot be extended.**

**Important!** A UCD can still be registered within a maximum period of twelve months from the date on which the design was first made available to the public.

A UCD can be bought, sold or licensed as any other exclusive right.

## The scope of protection

Holders of a RCD have exclusive rights to use the registered design and to prevent any third party from using it anywhere within the European Union.

They will be protected against:

1. deliberate copying of the design;
2. independent developments of a similar design.

As mentioned, the RCD covers, in particular, the making, offering for sale, putting on the market, marketing, importing, exporting, or use of a product in which the design is incorporated or to which it is applied.

One of the most important advantages of registering a design is that **RCD are protected against similar designs even when the infringing design has been developed in good faith.**

On the contrary, an **UCD** merely grants a right to prevent the commercial use of a design only if it is a **bad faith copy of the protected design**. If a design is the result of an independent creation by a second designer, who is able to show that he/she was not aware of the existence of the protected design, there is no infringement.

Therefore, it must be remembered that it can be quite hard to prove that, when the first disclosure occurred, the alleged infringer was or should have been aware of it.

As a UCD does not require any formality, it is prudent to keep as much evidence as possible of the original sketches and their development as to be able to prove the ownership of that right.

## WHICH ARE THE MAIN ADVANTAGES OF A REGISTERED COMMUNITY DESIGN (RCD)?

- **A RCD produces equal effect and grants uniform protection across the 27 Members States of the European Union** covering a market of almost 500 million people enjoying a high standard of living.

However, being a uniform right, if the design is invalidated in one EU country, it will lose protection in all remaining 26 countries.

- In case of enlargement of the European Union, the geographical area of Community design protection is automatically extended to the new enlarged territory, without any need to make new applications or to pay additional fees.
- A great level of harmonisation of the legal system governing European design rights has been achieved with the implementation of the Community Design Regulation (also referred to in this publication as “the Regulation”; Council Regulation (EC) No 6/2002), providing strong protection against both copying and independent development of similar designs.
- In a single application, the applicant can file as many designs as he wishes, with the only restriction being that the products to which the design is applied must all belong within the same class of the Locarno Classification.

**Locarno Classification:** based on the Locarno Agreement Establishing an International Classification for Industrial Designs, the Locarno Classification, since 1968, is the most widely applied means of classification for industrial designs. It indicates 32 classes of goods and 219 related subclasses in which industrial designs can be incorporated. The list of classes and subclasses can be found on <http://www.wipo.int/classifications/nivilo/locarno/index.htm#>

Even if the products to which the design will be incorporated have to be indicated when filing the application for registration, the design protection extends to all products incorporating the design. For example, a design developed for a car, would be infringed by a toy reproducing it or even, for example, by a key ring.

- Finally, the RCD system consists of a **simple registration procedure**:
  - a single application.
  - a single language of filing.
  - a single administrative office.
  - a single file to be managed.
  - a single set of fees in an unique currency
  - the possibility to keep the design undisclosed for up to 30 months to avoid competitors learning of it.
- **Speedy procedure**: the average time needed to register a Community design is currently around six weeks, but the most straightforward cases can be registered in a matter of days.

Rapidity is particularly important in the industrial design field: quickness is a key word in many industry sectors producing goods having a short market life.

The fees for registering and publishing the Community design can be checked at: [http://oami.europa.eu/ows/rw/resource/documents/RCD/feesPayment/list\\_fees\\_en.pdf](http://oami.europa.eu/ows/rw/resource/documents/RCD/feesPayment/list_fees_en.pdf)

### COMMUNITY DESIGN SYSTEM AND INTERNATIONAL SYSTEMS: SOME BRIEF REMARKS

There are two different ways to protect a design in the whole territory of the European Union. Namely through:

- Community design system
- Hague system of international registration of industrial designs administered by the International Bureau of the World Intellectual Property Organisation (WIPO)

As mentioned, the Community design is a unitary system: one application provides design protection throughout the whole European Union. Consequently, the right has equal value in all the Member States.

Differently, the Hague Agreement is an international system which gives the owner of an industrial design the possibility to have it protected in the territories of the Contracting Parties by filing a single application with the WIPO, in one language (English or French), with one set of fees in one currency (Swiss Francs).

However, this system only entitles the owner to a **bundle of separate design rights each valid in the chosen country and each one following that country's legislation and enforcement procedures**.

Since the accession of the European Community to the Hague Agreement, in 2008, it is now possible to choose the European Community as a single entity when registering an international design. This will have the same effect as applying directly with OHIM for a RCD.

### CAN AN APPLICANT HAVE A NATIONAL DESIGN REGISTRATION AND THEN APPLY FOR A REGISTERED COMMUNITY DESIGN?

This is possible during the so-called "grace period", which allows producers to commercialise their products incorporating a new design during the 12-month period preceding the date of filing the application for the same design.

During this short period of time the design will be protected through the unregistered right offered by the Regulation on Community designs.

The "**grace period**" is extremely useful to determine whether seeking protection for a design is likely to be worth the time and money required and to test consumers' response to that specific product.

Also, if application for the national design was filed less than six months earlier, then it is also possible to claim the right of priority.

The **right of priority** gives applicants the possibility of dating back their rights by invoking the filing date of the first application. The right of priority can be invoked only if the second application is filed within six month from the first one.

Therefore, for instance, a Chinese owner of a design registered with SIPO on 1 January 2009 can claim this priority date before OHIM when applying for a Community design, for example, on 1 June of the same year. The Community design right will commence on 1 January even if its application was actually filed on 1 June.

## DIFFERENCES BETWEEN INTELLECTUAL PROPERTY RIGHTS

Because of their nature, designs are likely to interfere with the scope of protection of other IP rights. The shape of a product can become an exclusive right not only by registering it as a design but also by registering it as a bi-dimensional or three-dimensional trademark.

In addition, recalling the requested prerequisites, the shape of a product can be protected by copyright.

It is also possible that the shape of a product can endorse the requirement to be protected as a patent or, more possibly, as a utility model.

### What are the main differences between a Community Trademark (CTM) and a Community design?

As it will be discussed later, a Community design will be protected if it meets the legal requirements of novelty and individual character at the time of filing. The protection granted to a Community design is limited to the shape, lines, and contours of a product into which it is incorporated or applied.

A three-dimensional CTM will be granted **if the shape of the product can be considered as a sign able to distinguish the applicant's goods from those of anyone in a similar business**. The protection granted by a CTM is related to the **distinctiveness** of the sign itself compared to identical or similar reproductions of the same (taking into account visual, phonetic or conceptual similarities leading to the likelihood of confusion for the relevant public).

A CTM has to guarantee the origins of the products bearing it: a Community design is not intended for this purpose.

### It is possible to obtain both forms of protection.

For example, it is possible to protect packaging as both a 3D CTM and RCD if they meet the corresponding legal requirements: a shape which has distinctive character may then be registered as a trade mark as well as being protected by a Community design on the grounds of its individual character and novelty.

It is advisable to proceed with the double registration of symbols considering that they will consequently enjoy a double protection.

In design infringement situations, there is no need to prove the likelihood of confusion making them more effective in combating "look-a-like" products.

Finally, we should highlight the fact that a trademark has no time limit (it can be renewed indefinitely for periods of ten years) whereas, as previously mentioned, a registered Community design has a maximum of 25 years duration from the date of application for registration.

However, although trademark owner are requested to use their trademark (five years of non-use can lead to the cancellation of the mark) there is no requirement of using the design once registered.

### What are the main differences between a patent and a design?

A patent covers the function, operation or construction of new creation. To be patentable, a function must be innovative, have an industrial application and be described in such a way that an expert in the related field would be capable of exactly reproducing the process.

On the other hand, because a design covers the appearance of a product, it cannot protect, at the same time, the function of a product.

However, it is possible to obtain both forms of protection (i.e. a new product can perfectly include both new functions and a new appearance). If protecting a product with both a patent and a design registration, the timing of the applications will be crucial, as it must be ensured that the publishing of one or other of the rights does not destroy the novelty of the other application.

### WHAT ARE THE MAIN LEGAL REFERENCES FOR THE COMMUNITY DESIGN?

The most relevant Regulations relating to the Community design are:

- **Community Design Regulation** (CDR – also referred in this paper as “The Regulation”); Council Regulation (EC) No 6/2002 of 12 December 2001, on Community Designs is the core legislation for the regulation of the EU Design system; it coexist with national legislations.  
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2002:003:0001:0024:EN:PDF>
- **Directive 98/71/EC** of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs. The Directive aims at harmonizing national legislations on the protection of designs in the bid of eliminating the obstacles to free competition on the internal market and it **only deals with the harmonisation of national registered design rights**:  
[http://eur-lex.europa.eu/smartapi/cgi/sga\\_doc?smartapi!cellexapi!prod!CELEXnumdoc&lg=EN&numdoc=31998L0071&model=guichett](http://eur-lex.europa.eu/smartapi/cgi/sga_doc?smartapi!cellexapi!prod!CELEXnumdoc&lg=EN&numdoc=31998L0071&model=guichett)
- **Implementing Regulation** (CDIR); Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No. 6/2001 on Community Designs:  
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2002:003:0001:0024:EN:PDF>
- **Fees Regulation** (CDFR); Commission Regulation (EC) No 2246/2002 of 12 December 2001, on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs:  
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2007:193:0016:0017:EN:PDF>

# Part II: Requirements for design protection based on the Community design regulation

## GENERAL DEFINITIONS IN THE COMMUNITY DESIGN REGULATION (ARTICLE 3)

The Community Design Regulation defines “design” 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 Regulation defines «product» as any industrial or handi-craft item, including, for example, parts intended to be assembled into a «complex product», packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs.

For example, the appearance of a two-dimensional graphic symbol constitutes a design which may be protected by the Community design system.

## CONDITIONS OF PROTECTION: NOVELTY AND INDIVIDUAL CHARACTER

According to Article 4 CDR, the design must satisfy two main conditions before protection can be conferred: **novelty and individual character**. A further consideration is the requirement of **visibility**, but only when it comes to register component parts of a complex product.

### Novelty

**A design is new if it does not belong to prior art.**

A design is considered to belong to prior art when, generally speaking, it has been published, used in trade, exhibited or otherwise disclosed before the **relevant date**.

**Relevant date for registered designs:** in the case of a registered Community design, a design is new if no identical design has been made available to the public before the date of filing of the application for registration of the design for which protection is claimed. If priority is claimed, the date of priority is the one to take into account. The relevant date is the date in which the application was filed.

**Relevant date for Unregistered Community Design:** when the design was firstly made available to the public.

It must be noted that the prior art for a Community design is of a worldwide nature: an application for an identical/similar design (for RCD) or a disclosure of an identical design (for UCD) that took place anywhere in the world, will destroy the novelty of the design.

However, there are limitations to such a broad definition of prior art.

- Firstly, as already mentioned, the “grace period” allows a designer to commercialise a product incorporating a new design during the 12-month period preceding the relevant dates: the date of filing for registered designs and the public disclosure for unregistered designs.

Consequently, any design that has been openly used for more than 12 months cannot be registered anymore – it will only enjoy the protection given to unregistered Community designs for a period not exceeding three years.

- A design will not form part of the state of the art if, in the normal course of business, its disclosure could not have been reasonably become known to the circles specialised in the relevant sector operating within the EU.
- **Exhibition Priority:** a design will not lose its novelty if disclosed during a recognised international exhibition and then registered within a period of six months from the date of the first disclosure of the product incorporating the design.
- Also, a design will not be deemed to have been made available to the public if it has been disclosed to a third person under explicit conditions of confidentiality.

Therefore, when showing a design to third parties it is highly advisable to request them to sign a confidentiality agreement. When you exhibit your unregistered design for the first time, it is important to make sure that the day in which it was exhibited could be easily identified.

## Individual Character

A Registered Community Design shall be considered to have individual character if the overall impression it produces on the “informed user” differs from the overall impression produced on such user by any other design that has been made available to the public before the date of filing the application for registration. If the priority is claimed, the date of priority will be the one to refer to.

### Who is the “Informed User”?

The Community Design Regulation does not define the parameter of the informed user. However, it is very important to understand who is the “person” that will determine if one design is different from another design. Design infringements strongly depends on the informed user because, based on its judgement, the scope of protection afforded can easily be reduced or broadened. The informed user is a central concept of the design protection system.

For example, if the overall impression of a design applied to a sofa is assessed by an interior designer, his competences in the field will automatically enable him to notice even the smallest particulars and differences between two similar designs. On the other hand, if the overall impression of the same design is assessed by someone who is less competent in the field, it is possible that some peculiarities that can actually produce a different overall impression are underestimated.

Even if there is still not a uniform definition of “informed user”, the prevalent orientation considers that s/he is not a design expert. Generally speaking, it can be viewed as someone who is quite familiar with the related field and consequently able to discern differences in details between the products at hand.

It is important to take into account the concepts of individual character and that of informed user when creating a new design: the validity of a design will be assessed on those concepts.

Small differences in the definition of those concepts can invalidate a right.

In assessing individual character, the degree of freedom of the designer in developing the design shall be considered. In some field, called of “**crowded art**”, the designer has relatively little freedom in developing the design, especially on accounts of technical or functional constraints: in these cases, even small differences in relation to earlier designs may be sufficient to endow the design with individual character.

For instance, it is much easier to develop a new design for a lamp than a new design for a pair of sunglasses.

### DESIGNS EXCLUDED FROM PROTECTION

The CDR excludes from protection three main types of subject matters:

- A Community design cannot relate to characteristics of the appearance of a product that are **exclusively** dictated by its technical function. Functional shapes can be protected only when they are not the only shape that can actually produce that function. This exclusion aims to set the boundaries between design protection and patent or utility model protection.
- A Community design shall not consist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions to be connected with another product in order to perform a certain function. These cases are also referred to as “**must fit**” and “**must match**” cases. An example of such products can be the USB memory stick connection that shall necessarily match with the USB slots.

The purpose of this exception is to enhance the interoperability of products of different producers and to prevent manufacturers of design products from distort certain markets, by monopolising the shape and dimensions of interconnections.

- A design applied to or incorporated in a component part of a complex product if the component part does not remain **visible during the normal use** of the complex product. However, if the component parts fulfil in themselves the requirements of novelty and individual character and if they remain visible during normal use, they can be protected as designs

The term “normal use” shall mean use by the end user, excluding maintenance, servicing or repair work.

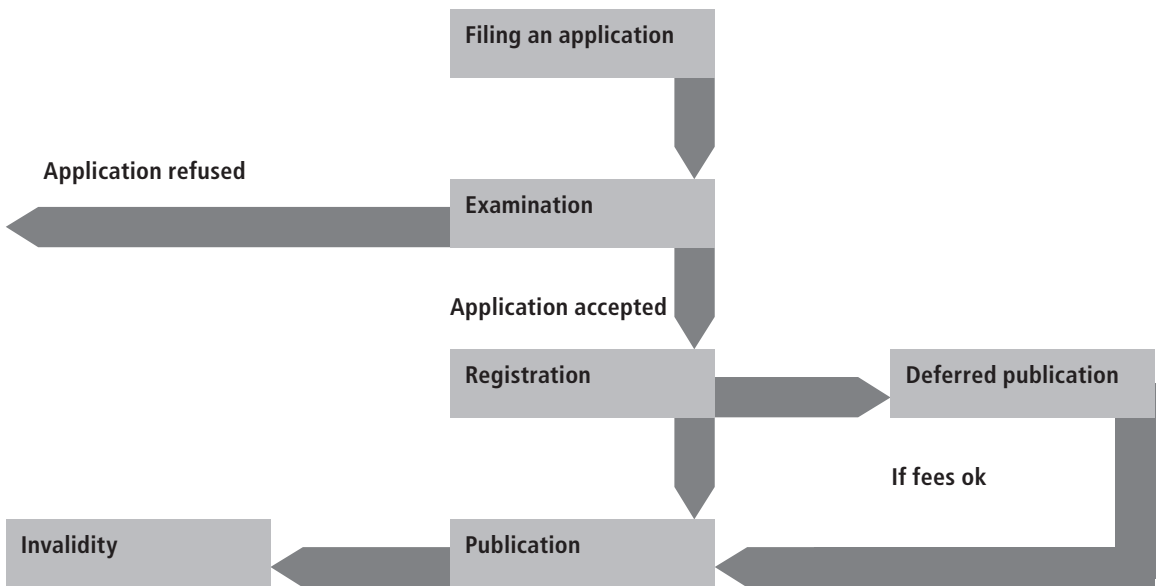
The Community designs Regulation defines «complex product» as a product which is composed of multiple components which can be replaced permitting disassembly and reassembly of the product.

A different level of protection has been granted to **spare parts** such as, for example a car panel; although they can actually be registered, the right is not infringed by activities concerned with repairing or restoring the original appearance of the product itself. Consequently, the design of the same panel cannot be used on other cars without the right-owner consent but it can be used by manufactures of car body panels for repair purposes.

It is not possible to protect a specific **material** by a Community design, since the protection only covers the appearance of the product to which the design is applied.

Also, Community designs contrary to public policy or to accepted principles of morality (from the European point of view), are excluded from protection.

# Part III: Registering a Community design with OHIM



Source: OHIM

## FILING AN APPLICATION

Filing is the most important stage in the registration of a Community design. There is no national restriction on who may apply for a RCD.

### Where can the application be filed?

An application for a registered Community design can be filed either at the OHIM or at the central Intellectual Property Office of a Member State. The IP office of the Member State will act as a receiving office and it will transmit the application to OHIM which is the only entity entitled to examine the application.

OHIM provides different forms for the RCD application, which can be filed online (e-filing), by fax, by post or personal delivery.

More information can be found on:

<http://oami.europa.eu/ows/rw/pages/QPLUS/forms/electronic/fileApplicationRCD.en.do>

When applicants file the application via fax, they should make sure that a paper copy of the representation is sent to the OHIM within one month from the date of the receipt of the fax.

### Minimum requirements to file the application

The minimum requirements that an application for a registered Community design must contain, are:

- A request for registration of design as a registered Community design;
- information identifying the applicant;
- between one and seven visual representation for each design whose protection is applied (each photograph or graphic representation must contain only one view), or where applicable, a sample of the product.

Since the representation is the means to specify the features of the design for which protection is sought, it is of utmost importance to provide a clear and complete design representation.

Drawings, photographs (except slides), computer-made representations or any other graphical representation are acceptable, provided they are suitable for reproduction. However, it is the responsibility of the applicant to ensure that the representation is of a quality allowing all details for which protection is sought to be clearly distinguished.

The application shall also contain:

- other formal requirements, e.g., an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied;
- if the applicant has appointed a representative, his/her personal contact details;
- if applicable, a declaration that priority of a previous application or exhibition priority is claimed;
- a specification of the language in which the application is filed and one of the second language;
- the signature;
- acknowledgement of payment of fees.

## Languages

The application may be filed in any of the 22 official languages of the European Union.

The applicant must also indicate a second language, among the five languages of the Office, Spanish (ES), German (DE), English (EN), French (FR) and Italian (IT), and which must be different from the language of filing.

Due to the speedy nature of the proceeding, the practice of the Office is to send communications in the language of filing.

## Representation before OHIM

To ensure that the Office and applicants can communicate easily, it is necessary for the Office to be aware of the correct person to contact.

Any natural or legal person not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the EU has to be represented before the OHIM by legal practitioners or professional representatives entitled to act in IP matters in the EU or included in the list maintained by OHIM.

Even natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the EU (who are not required to be represented before the OHIM) often refer the filing of a Community design to professional representatives so as to rely on their experience both with the relevant legislation and procedural aspects.

The “FindRep” tool offered by OHIM on its website, can be of great help for Companies to find a suitable firm of IP consultant/lawyer: [http://oami.europa.eu/FRP/RequestManager/en\\_SearchBasic\\_0](http://oami.europa.eu/FRP/RequestManager/en_SearchBasic_0)

## Indication of product and classification

The application must contain an indication of the product, worded in such a way that its nature is clearly indicated. Applicants are encouraged, in order to avoid problems related with the translation of product terms, to prepare the application form with the aid of the classification tool made available by the OHIM, Eurolocarno.

The classification can be found on:

<http://oami.europa.eu/ows/rw/pages/QPLUS/databases/eurolocarno.en.do>

In case the submitted classification is incorrect, the OHIM examiner may either request that you specify the nature and purpose of the designated product or to change the indication of product.

**Note:** As specified earlier, the indication of the product and the classification do not affect the scope of protection of the registered Community design.

## Description

The applicant may include a description, not exceeding 100 words, explaining the representation of the design or the sample provided for each design. The description does not affect as such the scope of protection of a registered Community design.

## Multiple applications

An important advantage of the registered Community design system, established with the aim of saving costs, is the possibility of multiple filing: in a single application, the applicant can file as many designs as he wishes. The only restriction is that the products to which the design applies must all belong to the same class ("unity of class") of the Locarno Classification.

## Claiming priority

As already said, the CDR provides the possibility of claiming the priority date of a previously filed application within six months from the filing of such application.

The previous application of a design or utility model must have been filed in a State which is party to the Paris Convention or a member of the World Trade Organisation (WTO). This is the case for application for designs filed before SIPO.

### Paris Convention for the Protection of Intellectual Property Rights

The Paris convention for the Protection of Intellectual Property Rights is one of the first and most important conventions ever signed for the protection of intangible properties. Signed in 1883, it is one of the most widely adopted Treaties in the world, counting 173 signatory states. The Convention applies to industrial property in the widest sense, including patents, utility models, trademarks, industrial designs, trade names, geographical indications and it also includes rules on unfair competition.

The priority claim needs to be supported before the OHIM by means of a priority document which may be enclosed with the application or submitted within three months from the date of receipt of the declaration of priority. In this regard the applicant must provide to the OHIM a certified copy of the previous application or registration, issued by the authority which received the previous application and accompanied by a certificate stating the filing number and date of the previous application. That document may be filed in original or in the form of an accurate photocopy.

## Fees and payment

The application for registration must be filed together with payment of required fees, which vary in accordance with the application filed.

There are three types of fees related to an application for a registered Community design: registration, publication and, in case that the deferment of the publication is requested, the deferment fees.

The registration fee and publication fee must be paid at the same time, together with the filing of the application.

It must be highlighted that in case of multiple applications, the registration, publication and, where appropriate, deferment fees, are gradually reduced.

There are three different means of payment for the RCD fees:

- Payment through a bank transfer to an account of the OHIM. In this regard, visit the OHIM web (<http://oami.europa.eu/ows/rw/pages/RCD/feesPayment/feesPayment.en.do>).
- Payment through a current account opened by the applicant or representative with the OHIM. This payment method is particularly useful for frequent users. In order to sign up for this service, it is needed to contact with the OHIM Finance Department.
- Other means of payment: credit or debit card, or Euros in cash, when paid in person at the OHIM.

All the fees and charges due to the OHIM must be paid in Euro, with all bank charges met by the applicant so that the Office receives the full-required amount.

## EXAMINATION OF REGISTERED COMMUNITY DESIGN APPLICATIONS

**Once the application for registering a Community Design is submitted, OHIM will not check the novelty of the design itself.** In other words, OHIM will not verify if a similar/identical design has already been registered. In addition, OHIM does not check whether an application for a registered Community design is infringing any other intellectual property right of a third party.

The applications for the concession of IPR can be checked against:

- **substantive grounds of invalidity** (the ones which affect the right itself) and
- **formal ground of invalidity** (the ones affecting some procedural/formal stage of the application procedure and not related with the right that the applicant is seeking protection for).

### Examination on substantive grounds

OHIM will examine the admissibility of an application only on two substantive grounds (in accordance with article 3 and 9 CDR):

- whether the subject of registration complies with the definition of a “design” and
- whether its features offend against morality or public policy.

If an application is found to be defective on either ground, an objection will be raised by OHIM to the holder of the application, and it will allow the applicant, generally within a two-month time limit, an opportunity to withdraw or amend the application or submit his observations, before refusing the application.

In the case of multiple applications, if the substantive fault is contained in only some designs, OHIM will refuse the application only in so far as those designs are concerned.

### Examination of formal grounds

OHIM will begin examining whether the application meets all the formal “minimum requirements”, namely:

- Name and address of the applicant
- Indication of the first and second chosen language
- Clear and complete visual representation of the design
- Priority claim, if an and supportive documents
- Indication of the type of product designed
- Signature of the applicant
- Payment of the relative fees

If the application does contain all the minimum requirements, **the OHIM will grant a filing date**. Otherwise, the OHIM will notify the applicant that a filing date cannot be allocated, and will grant a time period of two months to remedy the deficiencies. If deficiencies are remedied within this time, the date on which all the deficiencies are remedied will be deemed the date of filing.

A failure to remedy all the deficiencies within this time will lead to the application being deemed never to have been filed and any fees paid will be refunded.

## PUBLICATION

### Notice of acceptance and publication

If examination reveals no deficiencies or if the problems have been amended, and a request for deferment has not been made at the time of filing the application, the application will be accepted and the design will be registered and published immediately in the Community Designs Bulletin. The Community Designs Bulletin is only published in electronic form (<http://oami.europa.eu/ows/rw/pages/RCD/RCDBulletin.en.do>).

A registration certificate shall be issued after the publication of the registered Community design.

### Deferred publication

An applicant for a registered Community design may request deferment of the publication for up to 30 months from the date of application or the priority date, if claimed.

Deferment is a particularly useful tool for designers or companies that need to keep their designs confidential; avoiding disclosure until the product is actually on the market.

Therefore, potential competitors will not be able to look at the design during this deferment period, helping to maintain competitive advantage.

Deferment can only be made at the request of the applicant at the time of filing the application with the OHIM. It will not interrupt the registration process since only the publication of the design is deferred.

As long as the publication is deferred, neither the representation of the design nor the indication of the products will be published. Nevertheless, third parties wishing to inspect the entire file may request so if they have obtained the applicant's

approval beforehand, or if they can establish a legitimate interest, in particular, when an interested person proves that the holder of the registered Community design has taken steps with the view to invoke the right against him.

## GROUNDS FOR INVALIDITY AND INVALIDITY PROCEDURE

There are two ways of invalidating a design that has already been registered:

- requesting for it to be invalidated by OHIM.
- requesting for the design to be invalidated during infringement proceedings before a Community design court (conflicts concerning unregistered Community design will be dealt with exclusively by the Community design courts).

**Presumption of validity:** during a court proceeding dealing with a design infringement or threatened infringement of a registered Community design, the Community design court shall consider the Community design as valid. Validity may be challenged only with the said counterclaim for a declaration of invalidity.

Applications for a declaration of invalidity of a registered Community design can be made, after paying the related fees, to OHIM by any natural or legal person as well as a public authority empowered to do so. The application has to be a written statement containing facts, evidence and arguments.

**There are several grounds on which a Community design may be declared invalid.** Article 25 of the CDR establishes that a Community design may be declared invalid only in the following cases:

- the design does not correspond to the definition of a Community design under Article 3(a) of the Regulation;
- the design lacks of novelty or individual character;
- the design has been dictated only by technical function of the product that incorporates it;
- the person who registered it, is not entitled to the design;
- the Community design is in conflict with a prior national design;
- the Community design makes unauthorised use of a sign protected by the law of a Member State (for example, emblems, flags, badges);
- the Community design makes unauthorised use of a work protected by copyright;

Both the RCD holder and the party requesting the invalidation of the design, participate to the invalidity procedure. The invalidity of the Community design is a written procedure in which the parties are invited to present their arguments and file observations. The decision may be appealed before the OHIM Boards of Appeal.

## Appeals

An appeal can be filed by any party adversely affected by an OHIM decision.

Only final decisions which do terminate proceedings, and not mere communication, can be subject to appeal. Decisions that do not terminate proceeding can only be appealed together with the final decision, unless the decision allows separate appeal.

**The first stage** of the appeal procedure is filing, in writing at the OHIM within two months after the date of notification of the decision appealed from, the **Notice of Appeal**. The notice of appeal must be filed in the language of the proceedings and must contain a statement identifying the contested decision and the extent to which amendment or cancellation is requested. The notice is actually considered filed only when the fee for appeal has been paid.

Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

If the department whose decision is contested considers the appeal to be admissible and well founded, it shall amend its decision (the so called "Interlocutory revision"). If the decision is not rectified within one month after receipt of the statement of grounds, the appeal shall be remitted to the Board of Appeal (BoA) immediately and without comments as to its merits.

The **Board of Appeal**, which comprises three members (one of whom acts as a Chairman), shall examine whether the appeal is to be allowed. The Board of Appeal issues its decisions in writing: the decision must state the reasons upon which it is based. In case that the appeal is considered founded, the Board of Appeal shall remit the case for further prosecution to the department whose decision was appealed. Such department is bounded to the main reasoning given by Board of Appeal.

The OHIM's decisions can be appealed, within two months from the notification of the Board of Appeal decision) before the **Court of First Instance** (CFI).

The potential grounds for such appeal are broad and are set out in Article 61(2) CDR: lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, the CDR or any rule of law relating their application. In its decision, the CFI can vary the Board of Appeal decision, or can support it or reverse it. **The Office is obliged to implement the decision of the Court.**

All the decisions of the CFI can be finally appealed to the **European Court of Justice (ECJ)**, but only on legal basis (if an existing law has not been applied properly) and not on an issue related with facts or circumstances of the case at hand. Both the OHIM and the parties can appeal the decision of the CFI.

**The European Court of Justice (ECJ) and the Court of First Instance (CFI)** are the judicial bodies of the European Union. Together they interpret the EU Treaties and legislation (only Community Laws not national laws) with the aim of ensuring the consistent application of EU law across the EU.

Individuals and companies of the 27 Member States can bring their cases before the Court of First Instance while the ECJ primarily deals with cases taken by Member States or cases that the courts of each Member State has referred to it.

More information on the appeal procedure can be found on: <http://oami.europa.eu/ows/rw/pages/RCD/FAQ/RCD13.en.do>

### **Consequences of invalidity**

A Community design that has been declared invalid shall be deemed as it has never existed.

However, the retroactive effect of invalidity of the Community Design will not affect:

- any previous already decided court decision on infringements;
- any contract concluded prior to the invalidity decision, in so far as it has been performed before the decision.

It is nonetheless possible to claim compensation for damages caused by the holder of the invalidated Community design and/or the repayment of the sums (for example, license fees) paid under the relevant contract.

### **RENEWALS**

A Registered Community Design is valid from five years commencing from the filing date. It can be renewed every five years for a maximum of 25 years.

The application for renewal must be submitted either via OHIM's e-renewal system or by filing in paper form; and the renewal fee must be paid within a period of six months before the expiry date.

However, subject to the payment of an additional charge, OHIM permits right holders to renew their design after the expiration period.

If no application for renewal has been submitted, or is submitted after expiry of the 'additional period', OHIM will inform the RCD proprietor that the RCD is cancelled from the Register and a notice will be published in the RCD Bulletin.

## Part IV: Means of enforcing a Community design – brief remarks

A Community design gives its proprietor the **exclusive right** to use it and to prevent any third party from the 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 those purposes.

When these exclusive rights are infringed upon, the right holder is entitled to enforce them through the civil, administrative and criminal means of enforcement offered by the legislation of the 27 Member States.

As mentioned, the enforceability of a RCD is strongly based on the two concepts of individual character and the informed user together with the filing date.

As for the UCD, its protection is strictly related with the evidence that the right owner possess of the exact date when he has firstly made the design available to the public and of the fact that it is a result of an independent work carried on by the designer. (As said, the UCD is infringed only when an unauthorised copy of such design is realised by someone who was not aware of the existence of such design).

With the aim of having few and highly specialised IP courts, the Regulation has provided that each Member State will institute a small number of first and second instance IP courts with exclusive jurisdiction on Community trademarks and designs infringement actions, so as to create a system ruled by judges highly specialised in IP matters.

Decisions of these courts may be enforced in other EU Member States by applying the simplified enforcement procedure introduced by Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters Council Regulation (EC) No 44/2001 can be found at: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:32001R0044:EN:HTML>.

The Community design courts have jurisdiction:

- for all infringement or threatened infringement actions (counterfeit actions) relating to Community designs;
- for counterclaims for revocation or for a declaration of invalidity of the design during infringement actions;
- for actions for a declaration of invalidity of an Unregistered Community Design;
- for granting preliminary measures.

### PRELIMINARY MEANS

Preliminary measures are crucial to protect IPR: they entitle right holders, when [1] there is the likelihood of an actual or potential damage to their rights or interests and when [2] there is the concrete risk of the evidence of the infringing acts being otherwise destroyed by the infringers, to **immediately act against infringements before the commencement of the lawsuit**.

A preliminary measure can be requested to:

- The Community designs court
- The normal courts of a Member State

As stated in the Regulation, in an action for infringement or for threatened infringement a Community design court can:

- prohibit the defendant from proceeding with the acts which have infringed or would infringe the Community design;
- order to seize the infringing products;
- order to seize materials and implements predominantly used in order to manufacture the infringing goods, if their owner knew or could have reasonably known that they were used for IPR infringement actions;
- entail any order imposing other sanctions appropriate under the circumstances provided by the law of the Member State in which the acts of infringement or threatened infringement are committed.

A great attempt at harmonising the existing disparities among the various EU jurisdictions has been made with the implementation of **Directive 2004/48: the Enforcement Directive** (<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2004:157:0045:0086:en:PDF>). The main goal of the Directive is to provide a uniform approach in dealing with means of enforcement of IP rights mainly by way of **preliminary measures** such as evidence collection means and preliminary injunctions and seizure orders.

There are three measures harmonised throughout Europe:

**Evidence collection** – an order, granted by a judge that entitles the right holder to discover evidence of an infringement without any warning being given to the infringer. The claimant requests that the court authorise it to enter the defendant’s premises to collect documents, pictures, samples of the allegedly infringing goods.

**Injunction** – a judge order aimed at:

- Preventing any imminent infringement of an IPR or
- Forbidding the continuation of the alleged infringement.

Injunctions are normally subject to a penalty in case of non-compliance.

**Seizure** – judge order that entitles the right owner to seize goods suspected to infringe an IPR as to prevent their entry on the market.

**Note:** The preliminary means listed can be taken even without the defendant having been heard! This normally happens when any delay would cause irreparable harm to the right holder.

The claimant is required to pay a **bond** as a guarantee of the defendant’s rights mainly to avoid episodes of malicious actions.

The above-mentioned measures will lose their effect if the applicant does not immediately institute legal proceedings. The term for instituting legal proceedings varies from country to country but, generally speaking, is a maximum 1 month.

In granting the measure, the Community design court will apply its national substantial and procedural law.

## CIVIL MEANS

The civil route is the most widely applied for seeking protection of intellectual property rights. During civil actions, the parties maintain full control over the proceeding (they can settle the issue at any time if they reach an agreement): civil actions are also the most appropriate route to recover the damages caused by the infringement.

Considering that the Community design courts will apply the rules of procedure governing the same type of action relating to their national design right and that the different means of enforcement are considered differently from country to country, **it is advisable to consider the different options available for choosing the jurisdiction in which the matter will be decided.**

On all matters not covered by the Community Design Regulation, a Community design court will apply its national substantial and procedural law, including its private international law.

The criteria used to determine the competent Court are as follows:

1. the defendant domicile or the principal place of business;
2. the co-defendants domicile or principal place of business;
3. the claimant domicile or principal place of business;
4. the court of the Country where the design was actually infringed;
5. any court that results from the parties’ agreement.

Apart from preliminary measures the **Directive 2004/48** also harmonises rules related with the collection of evidence, the determination of damages and costs and the judicial publication.

It shall be noted that the judicial authorities have been empowered to require **disclosure of information** on origins of products and distribution networks from almost anyone who was in some way related to the infringing activities. If the infringement is committed on a commercial scale, more stringent rules apply.

The system, as designed, can be very efficient in combating counterfeiters.

The national law of the Member State in which that court is located determines the rules and conditions of appeal to Community design courts of second instance.

## ADMINISTRATIVE AND CRIMINAL MEANS

IPR can also be enforced through **customs** or through **criminal proceedings**. Although the civil route is the most widely applied, the possibility to freeze the import of export of allegedly infringing goods offered by the administrative custom authorities, is of relevance: it will allow the IP owners to organise the subsequent measures to be taken in order to protect its IPR.

In Europe, the **EC Regulation 1383/03** establishes the Community Custom Code: it provides for harmonised border enforcement of IPR in case of infringement.

The Regulation can be found at:

[http://eur-lex.europa.eu/smartapi/cgi/sga\\_doc?smartapi!celexapi!prod!CELEXnumdoc&numdoc=31994R3295&model=guichett&lg=en](http://eur-lex.europa.eu/smartapi/cgi/sga_doc?smartapi!celexapi!prod!CELEXnumdoc&numdoc=31994R3295&model=guichett&lg=en)

The Regulation offers the possibility to freeze the import or export of goods that appear to be counterfeit or pirated. The customs authority may, in accordance with the rules in force in the Member States concerned, notify the holder of the right, where known, that a possible infringement is taking place. The goods will be kept by the customs, (the right owner may be requested to pay a bond) to enable the holder of the right to enforce it without losing control over the suspected goods.

Community design right holders can also benefit from the **criminal protection** offered to their rights under the law of each Member State.

Most often, criminal enforcement is invoked in order to deter further infringements: given the particularities of criminal proceedings, the choice to protect designs or other IP rights via the criminal court requires careful evaluation of the factual circumstances of the case. The public prosecutor (governmental official in charge of criminal proceedings) maintains full control over the proceeding and autonomously decides what action will be taken to punish the counterfeiters (i.e. evidence collection, means of investigation, sanctions, etc.).

In addition, for a criminal offence to take place, contrary to what requested in civil cases, it is also necessary that the infringer is totally aware that is performing an IPR infringement. This is called the **subjective element** of the infringement. The **objective element** is the same as for civil cases: the infringers' act interferes with the proprietor's rights over its creation.

It can therefore happen that a design infringement will not be deemed as a criminal infringement because of lack of wilful intention to infringe.

**Note:** The wilful intention to infringe can be quite hard to prove.

It should also be noted that in Europe Criminal Law is left entirely to the exclusive jurisdiction of each Member State and that, again, the differences between the various systems in this area are particularly significant as no harmonisation rule applies.

It is strongly recommended to refer the matter to specialist in the law of the country where the infringement occur. As already stated, there are not, strictly speaking, European Courts appointed to deal with IP cases and, consequently, there are several differences amongst different Member States' substantive and procedural law. These differences and peculiarities, needs to be assessed by experts in the related field.

# European contact information

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Fax: + 34 96 513 1344

### Getting general information

Telephone +34 96 513 9100  
from 9.00 to 13.00 and 14.00 to 17.00;  
e-mail [information@oami.europa.eu](mailto:information@oami.europa.eu)  
The Information Centre team provides general information concerning the filing of Community design applications, general questions concerning the procedure (fees, priority, seniority, etc.) as well as information on OHIM itself.

### Contacting OHIM-Examiners

e-mail [information@oami.europa.eu](mailto:information@oami.europa.eu)  
The best way to contact an examiner is to go through the switchboard and ask for them by name. If the examiner is not available, we recommend that you leave a message in the answering machine of the examiner or send an e-mail to the Information Centre – you should get a reply within two days. However, it must be emphasised that e-mail can only be used for informal communication with the Office.

### Getting support for e-business

Telephone + 34 96 513 9400 from 7.30 to 19.30;  
e-mail [e-businesshelp@oami.europa.eu](mailto:e-businesshelp@oami.europa.eu)  
Expert help is available if you need assistance with urgent technical issues concerning e-filing applications, e-oppositions, e-renewals, MyPage and databases.

**The fees** for registering and publishing the Community design can be checked on: [http://oami.europa.eu/ows/rw/resource/documents/RCD/feesPayment/list\\_fees\\_en.pdf](http://oami.europa.eu/ows/rw/resource/documents/RCD/feesPayment/list_fees_en.pdf)

**The Community Designs Bulletin** is only published in electronic form. (<http://oami.europa.eu/ows/rw/pages/RCD/RCDBulletin.en.do>)

**A list of legal references** related to design, including reference to the laws of the Member States, can be found on: <http://oami.europa.eu/ows/rw/pages/RCD/legalReferences/legalReferences.en.do>

# Acknowledgements

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This Roadmap for Intellectual Property Protection is part of a series of guides prepared under the EU-China Project on the Protection of Intellectual Property Rights (IPR2). The series aims to provide European and Chinese companies with up-to-date information on how to protect their intellectual capital in Europe and in China. For other guides, visit [www.ipr2.org](http://www.ipr2.org) or contact IPR2 ([info@ipr2.org](mailto:info@ipr2.org)).

IPR2 is a partnership project between the EU and the PRC on the protection of intellectual property rights in China. This is done by providing technical support to, and building the capacity of the Chinese legislative, judicial and administrative authorities in administering and enforcing intellectual property rights; improving access to information for users and officials; as well as reinforcing support to right holders. IPR2 targets the reliability, efficiency and accessibility of the IP protection system, aiming at establishing a sustainable environment for effective IPR enforcement in China.



IPR2 co-operates closely with the European Union's China IPR SME Helpdesk. The China IPR SME Helpdesk is a European Union initiative, which supports European small and medium-sized enterprises (SMEs) with free information, training and first-line advice about protecting and enforcing their intellectual property rights in China. The Helpdesk offers practical information, training and workshops in Europe and China in order to assist European SMEs to make the right business decisions with regard to their China IPR matters.

**If you are a European SME or SME representative body, for further information contact the European Union's China IPR SME Helpdesk:**

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[www.epo.org](http://www.epo.org)



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MINISTRY OF COMMERCE OF THE PEOPLE'S REPUBLIC OF CHINA

The Ministry of Commerce (MOFCOM) is the IPR2 Chinese implementing organisation.  
[www.mofcom.gov.cn](http://www.mofcom.gov.cn)



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