

## Designs

*Design rights in the European Union can be a surprisingly strong source of protection for both three-dimensional (3D) and virtual products, says Elisabeth Murray at Mathys & Squire.*

An aspect of European intellectual property (IP) law that is widely underappreciated is the powerful protection now available for features of design of an enormously wide variety of products. Design in this context includes the appearance of a product or its packaging. While there are inevitably some commercial products for which design protection is excluded, products for which designs are protectable vastly outnumber products for which they are not. Design protection is not restricted to the design of decorative objects; consumer and industrial products as diverse as mobile phones, building components, drinks cans, machine tools, computer equipment, kitchen gadgets and vehicle parts can all be the subject of design protection. Nor is design protection restricted to the design of 3D objects: computer icons and user interfaces, financial literature and graphic symbols may all now qualify for some form of design protection.

For those familiar with patent protection, it is interesting to note three important areas where design protection is dramatically more favourable to the design right owner:

- registered design protection in the European Union is (within limits) still available after the product in question has been launched;
- some design protection is acquired automatically without registration procedures or fees;
- the owner of an EU (Community) design right can enforce the right in all EU countries simultaneously, in one court proceeding.

These differences will of course have important consequences not only for the design right owner, but also for companies seeking to launch competitive products.

There are essentially two regimes of protection: automatic unregistered protection, which is free to obtain, relatively short-lived and enforceable only against those who actually copy the design; and registered protection, for which there is an application procedure, which is long-term and is enforceable against use of the design, irrespective of whether or not there was deliberate copying. A requirement for protection as a registered or unregistered Community design is that the design is new.

Within this important and developing area of law there are of course drawbacks, complexities and some conditions. These are summarized in the remainder of this article, but you are recommended to seek expert assistance, for example from a European patent attorney, most firms of which are also skilled in design matters.

## What is a design?

From a legal perspective, according to the Regulation on Community Designs, 'design' means 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. 'Product' is defined widely in the Regulation, and includes not only the actual product or component itself, but also packaging as well as get-up, graphic symbols and typefaces. Computer programs are specifically excluded from design protection but protection can be obtained, for example, for the design of computer icons.

## Legal protection for designs in the European Union

In the European Union the law of designs is complex, and is a tangle of Community and national design laws as well as, in some cases, national copyright laws. Protection of a design can be obtained through registered rights (those which are applied for) and can also arise through unregistered rights, which come into being without application.

Until recently, the laws relating to designs differed widely across the various Member States of the European Union. EU legislation introduced the registered Community design right and unregistered Community design right through Council Regulation No. 6/2002, and harmonized (the main features of) national registered design law by way of Directive 98/71/EC. The advent of the Community Design Regulation has greatly simplified the law across the EU for registered Community and registered national design rights.

However, there has been no harmonization of the national unregistered design rights or of the relevant national copyright laws, which still differ widely between countries. The different laws provide, for example, different scopes of rights, different conditions as to term, different criteria for infringement, and different remedies for infringement.

All of these different laws exist in parallel, and so a particular product can have aspects that are the subject of a registered Community and/or registered national design,

aspects that are protected by unregistered Community design and/or unregistered national design rights, and still further aspects may be the subject of copyright protection. (In addition, the product may be the subject of one or more patents and/or trade mark registrations.) For simplicity, reference is made in this article mainly to protection obtainable under the Community Regulation, although some reference is included to the additional national provisions.

Further complexity arises since the definition of design relates to a product or part of a product, and thus a single product could include several designs, each one being the subject of separate design protection. For example, a mobile phone could include new designs for its overall shape, as well as for separate elements such as its screen or keypad.

Design protection differs from patent protection. Design protection can be obtained for a product's aesthetic appearance, whereas patents protect inventions, for example relating to the function of the product. Indeed, the registered Community Design Regulation specifically excludes from protection features for which design is solely dictated by function.

## Protection of designs under the Community Design Regulation

For protection under the Community Design Regulation a design has to be (among other things) new and have individual character. A design is considered to be new if no identical design has been made available to the public. The test for individual character considers the overall impression the design produces on the informed user. In other words it must be apparent that the design is different from designs that existed previously. Such a design may benefit automatically from the unregistered design right, and/or registered protection can be applied for.

## Rights obtained under the Community Design Regulation

A Community design right gives its owner the right to prevent third parties using in the European Union an identical design or a similar design which does not produce on the informed user a different overall impression from the protected design.

A registered Community design right gives a monopoly right: a right to exclude others from using the design. The registration affords protection in respect of both designs that have been deliberately copied and designs that have been developed independently.

An important distinction is that the unregistered Community design does not provide a monopoly right. This limits the value of the unregistered right as it is necessary to prove copying for infringement to be proved.

While the design right relates to a product, the scope of protection afforded by a Community design right is not limited to that particular product but extends to any article bearing that design, whether the article is similar or not to the product. The

protection of the design extending to its use in respect of other articles is of particular benefit where features of a design extend across a company's product range. In such cases registered design protection can provide some form of protection for brand identity, and can thus be an important partner to trade mark registration.

## Taking action against infringement

Action against infringement of a registered Community design or unregistered Community design right is brought in a designated Community Design Court; each EU member state designates the relevant courts. A judgement given in a designated court is valid across the European Union. The Community Design Court can award an injunction, seizure of products and other sanctions which are provided by the law of the Member State in which the acts of infringement or threatened infringement are committed', and so the remedy of damages or account of profits may also be available.

## Benefits of registration under the Community Design Regulation

The Community Design Regulation provides a single procedure for obtaining a design registration covering all of the countries of the European Union. This is clearly preferable to filing separate national applications where protection in several EU countries is to be sought.

Unlike a registered Community design, an unregistered Community design does not provide a monopoly right. Thus, while the unregistered rights may be useful for taking action to prevent deliberate copying, copying can be difficult to prove.

Remedies available for infringement of unregistered rights may be limited compared with registered rights. In particular, the remedy of damages may, in some cases, be unavailable in actions for infringement of unregistered rights. Licences may be available as of right for the infringer of unregistered rights, and thus the owner of the unregistered right may not be able to prevent use of the unregistered design, whereas an injunction might have been obtainable had the design been registered.

The maximum term of protection for a registered Community design is 25 years, whereas the term of an unregistered Community design right is considerably shorter at three years. National unregistered rights generally also have a relatively short term. Unregistered rights are thus more suited for providing relatively low-level protection, in particular for short-term products or products having a short production run.

Thus there is clear legal benefit in obtaining registration, in addition to the deterrent to would-be infringers that registration may provide.

## Applying for registration

Application for a registered Community design is made at the Office for Harmonization in the Internal Market (OHIM) in Alicante. The application procedure is simple. The

application is filed with representations showing all the features of the design to be protected. In some cases a sample of the design may be filed. An 'indication of product' is filed with the application, which states the product to which the design is to be applied, but this does not affect the scope of protection afforded by the registration. Several designs can be included in a multiple application, thus reducing overall costs.

Examination of the application is carried out only as to formal requirements; no comparison of the design applied for is made with prior rights to see whether the design is new and of individual character. When the application has been accepted it proceeds to registration and publication. It is possible to request deferred publication, in which case the publication can be delayed by up to 30 months after the application date or priority date, if applicable.

Protection in non-EU countries may be obtained by filing further design applications in other countries. If such applications are filed within six months of the date of filing of the initial application for the design (the priority date), then they may claim the benefit of the filing date of the initial application.

## When to file

A requirement for Community registration is that the design is new, in that it has not been made available to the public before filing. However, there is a grace period of 12 months so that under certain circumstances disclosure of the design may not destroy the novelty of the design with regard to obtaining registered Community design rights.

However, many countries do not have such a grace period against self-disclosure, and therefore, if valid protection for the design is to be obtained in any of those countries, an initial application for registration must be filed before there is any relevant public disclosure of the design.

## Third parties' rights

It follows that since steps should be taken to ensure design protection is in place before launching a new product, it is also necessary to consider the rights of others and the risk of infringement of a third party's design registration or other rights. Consideration should be made to carrying out searches to look for registered design rights which might be infringed by sale of a product. If relevant third-party rights are found, redesign of the product could be considered, or a licence of rights could be sought. Application can be made to OHIM for a declaration of invalidity of a registered Community design right.

It is not generally possible to search for unregistered rights as such, but for there to be infringement of an unregistered Community design right there must have been copying of a prior design. Care therefore should be taken to avoid copying third parties' designs.

National registered and unregistered rights may also exist in parallel to any Community rights, and expert assistance should be sought to advise on such matters.

## Summary

The design of a product is potentially of great commercial importance, giving added market value and setting a company's product apart from those of competitors. Design can not only provide value to products themselves, but can also provide a branding function, giving coherence of design across a company's product range. Community design law provides important protection of this valuable asset, and Community design rights extend and are enforceable across the whole of the European Union.