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GENERAL COMMENTS

NOTICE

Terminology: In the present guide, the term "design" is used to designate three-dimensional features (shape or surface) as well as two-dimensional features (patterns, lines or colour) as applied to industrial products and which give the product an attractive appearance for the consumer.

1. WHAT IS A DESIGN?

A design is the ornamental or aesthetic aspect of an article.
 There are two types of design:

1. A three-dimensional creation (shape): this gives the product a special appearance, without its application producing a technical effect.

Examples¹:

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2. A two-dimensional creation: patterns, lines or colours added to products to give them a special appearance, without their application producing a technical effect.

Examples²:

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Designs are applied to a great variety of products from different industry and trade sectors, from complex instruments with a special or exclusive use (such as machines, vehicles, tools, engines, computers, architectural structures, etc.) to simple or everyday articles (such as clothes, footwear, jewellery, electrical appliances, toys and furniture).

National legislation on industrial designs protect these products as regards their aesthetic features, excluding from all protection any technical features or the functional characteristics of the products to which they are applied.

2. WHAT VALUE DOES A DESIGN HAVE FOR A COMPANY?

- The design as a **marketing feature**. The reason for including a design in a specific product is to attract the consumer's attention to the product that is to be commercialised. The design is an ideal feature for *increasing the attractiveness* of the product to which it is applied.
- The design is a **business asset**: like any other industrial or intellectual property right, an industrial design forms part of the fixed assets of a company. The greater commercial success the design achieves, the greater its economic value for the company will be.
- The industrial design is an **exclusive right** (registered designs offer greater protection and more advantages than unregistered designs); as with all industrial property rights, a design may be assigned, licensed, mortgaged or transferred *mortis causa*. Without doubt, a design which has acquired a certain level of popularity in the market can mean a profitable business for the holder. For example, it can be used to attract investors, to guarantee the holder's credit or even to achieve a return as a non-monetary contribution to a trading company.
- The design as an element that **increases the competitiveness of a company**: Products can be differentiated for the technical features that make them more or less useful to the consumer. But when the practical use of a commonly used product cannot be substantially distinguished from that of another product fulfilling the same function (which is most commonly the case), the consumer will base his/her decision on the design of the product. That is to say, he/she will decide to purchase the most attractive, most original, most appealing product, all in all, the one with a better design.

3. WHY IS IT ADVISABLE TO LEGALLY PROTECT A DESIGN?

When a *new* and *original* design is created and, above all, once it is applied to a product and commercialised, if it obtains a certain level of commercial success, it is very important to protect it legally. This is because if a third party (normally a competitor) manufactures, uses or

sells products with the same design or a very similar one that can be confused with the original, it will be highly detrimental for the creator of the design.

The creator of the design has not only made a financial investment in order to develop the design, but has also obtained a competitive advantage in the market thanks to its commercial success. If the design is not legally protected and, therefore, any third party may use and reproduce it freely, the initial financial investment and the real or potential competitive advantage in the market are or might be lost.

Ultimately, the importance of legally protecting a design lies in the fact that the design increases the commercial value of the product to which it is applied.

In accordance with this, industrial design legislation offers designers legal protection against imitation. Indeed, by means of an application and registration at a competent Office, the holder of the design acquires an exclusive right over the creation.

The registration of a design provides a solid basis for the holder to legally defend his/her rights and interests.

All this helps the holder to recover investments made during the different stages of the creation and exploitation process of the design.

The holder of a *registered* design has an exclusive right for a limited time (between 10 and 25 years, depending on the relevant legislation), which allows the exclusive exploitation of the design, as well as lawfully preventing third parties from manufacturing, using, selling, copying or imitating the design without prior consent.

The exclusive right over a design is NOT (normally) obtained simply through use.

A design that has not been protected will not benefit from the specific legal protection provided by industrial design legislation. That is to say, if no application is made for an industrial design, followed by the relevant registration procedure and subsequent publication of the grant, the design will only benefit from other forms of legal protection, different from the protection conferred by industrial design law. Therefore, it may be protectable under unfair competition law or, as the case may be, under copyright law, as long as it fulfils the relevant legislative requirements.

However, it is worth noting that it is possible to legally protect an unregistered design in the United Kingdom. The unregistered [Community design](#) will be dealt with later.

As a general rule, the holder of registered design rights may oppose the making, commercialisation, importation, exportation, exhibition, use or stocking for any industrial or commercial purposes of any product which has the same appearance as the protected design.

4. HOW CAN I LEGALLY PROTECT A DESIGN?

CONDITIONS

For the design to enjoy legal protection as an industrial design, the creator must apply to the competent body for the registration of the design, although there are some laws that provide for the protection of designs without previous registration (as is the case of the unregistered design included in the Community Regulation as well as in the United Kingdom's legislation).

A design may be protected if it is *new*, i.e., provided the form of the product is not already known before protection is applied for.

Apart from being new, according to most national laws on industrial designs, the design must be *original* or have an *individual character*. Moreover, in some countries, such as

Australia, Benelux, Canada, the United States of America, Brazil or Mexico, the product to which the design is applied must have a [useful function](#) .

What is meant by new?

A design is considered to be new when, prior to the date of filing of the registration application, no other identical design has been made public.

Designs which only differ in insignificant details from other previously known designs will be considered identical.

What is meant by original?

A design is considered original when it has been created independently by its author, without copying or imitating a previous design. The author conceives the design with his/her own personal and particular touch.

What is meant by individual character?

The design is considered to have an individual character when the general impression given to the user differs from the impression produced by any other previous product.

What is meant by useful function?

This is a requirement included in the industrial design legislation of certain countries, such as, for example, Australia, the Benelux, Canada, the United States of America, Brazil or Mexico.

A product is considered to have a useful function when its purpose is to be used or when it is a working tool.

The design applied to an article that does not have a useful function, and is only ornamental or decorative, will not be protected under industrial design law.

WAYS OF PROTECTION

In principle, depending on the provisions of the national laws of each country, a design may be protected in different ways. On the one hand, it may be protectable under an [Industrial Property](#) right and, on the other hand, it may be protectable under [Intellectual Property](#) or Copyright law.

Likewise, in some cases the design is protectable under [Unfair Competition Law](#). In this case, the scope of protection, design copyright and other features of legal protection are normally very different from those applied under Industrial or Intellectual Property law.

In most countries the different forms of protection may coexist, whereas in other countries coexistence is expressly excluded (for example in France).

Industrial Property

Within the scope of Industrial Property Laws, a design may be protected as:

1. An industrial design:

To have access to this sort of protection the design must be [new](#), although a different degree of novelty is required in each country. In most States, (the European Union, Canada, Mexico, Brazil, Argentina), worldwide novelty is required (absolute), but

there are some national laws (the Benelux countries, Australia) which simply require nationwide novelty (relative).

Likewise, depending on the specific requirements of the laws in question, the design will have to be *original* or have an *individual character*, or be applied to a product having a *useful function*.

The duration of protection conferred by the industrial design right generally ranges from 10 to 25 years, depending on the applicable national laws, from the date of filing of the registration application.

2. A trade mark:

The shape, design or packaging of a specific product may be the distinguishing factor between this and other companies' products. In this case, the design may be registered as a trade mark.

In order to be protected as a trade mark, the design must be distinctive and not consist of an exclusively functional shape or one which is necessary for the functioning of the product to which it is applied.

The duration of design protection as a trade mark is unlimited.

Trade mark and design protection may coexist (depending on the laws of each country), but they must be applied for separately and the design must fulfil the requirements for each form of protection.

Examples³:

Intellectual Property

Some designs are conceived and considered a work of art, that is why, in some cases, they are automatically protected from the outset under Copyright Laws.

The protection granted in these cases is, in principle, for the whole life of the author plus 70 years after his death (depending on relevant national legislation).

Independently of whether the design enjoys intellectual property protection, it is also convenient to apply for an industrial design registration (taking into account that not all legal systems allow for the coexistence of these two forms of protection), as the protection and defence mechanisms recognised under industrial property laws are more effective.

Unfair Competition

In most countries, the Industrial Design is also protected by Unfair Competition laws.

Thanks to these provisions, the design is protected against any acts of unfair competition, especially acts of confusion, imitation, taking advantage of someone else's reputation, etc.

As a means of defence against possible unfair or unjustified conduct by a third party, the design holder has the right to take legal action⁴, including:

- Action for cessation
- Action for restitution
- Action for damages
- Action for unfair enrichment

Likewise, the design holder may legally apply for the necessary injunctions to be imposed⁵ in order to interrupt or prevent the continuation of any damage to and infringement of his/her rights and to guarantee the real and effective enforcement of the future decision.

5. THE GEOGRAPHIC SCOPE OF DESIGN PROTECTION

Like any other industrial property right, design protection is territorial in nature, i.e., the geographic scope of design protection may be national, international or for the whole of the European Community, depending on the State or States where protection is applied for.

Thus, from the geographic point of view, a design may have different levels of protection:

a. National:

Protection is granted for each country individually in accordance with its national laws. The exclusive right obtained can only be asserted within national territory.

In the European Union, [Directive 98/71/EC](#) has compelled Member States to harmonise their national laws on industrial designs on certain vital points. The deadline set for member states to adopt the provisions established by the aforementioned Directive expired on 28th October 2001.

b. Community:

Registered Community design. Protection granted by the [OHIM](#) in compliance with [Regulation EC 6/2002](#), and [Regulation EC 2245/2002](#). The legal protection granted by the Community design covers the whole territory of the European Union.

c. International:

Protection granted by the [WIPO](#) in compliance with [The Hague Agreement](#) concerning the International Deposit of Industrial Designs. The main advantage is the possibility of having a registration which is valid in several countries, i.e., to freely choose the countries in which the industrial design registration is to be asserted. This protection is valid in the [signatory countries](#) of the Treaty.

COMMUNITY DESIGN

1. THE COMMUNITY DESIGN

What is the Community design?

The term "Community design" includes bi- and three-dimensional industrial designs.

Community design means the appearance of the whole or part of a product, which is derived from its features, especially the lines, outlines, colours, shape, texture and/or materials of the product in itself and/or its ornamentation.

The concept of product covers any industrial or handmade article, specifically excluding computer programmes.

One of the main qualities of the Community design is its unitary character, i.e., the design has a uniform effect throughout the entire territory of the European Union. Therefore, it may only be registered, transferred, surrendered, declared expired or invalid, or have its use prohibited, for the Community as a whole.

2. TYPES OF COMMUNITY DESIGNS

What types of Community designs are there?

Community Legislation distinguishes two different types of Community design:

1. UNregistered Community design:

The design is made public within the European Union. It is considered public when it has been published, exhibited, used in trade or disclosed in any way in commercial trade.

Protection is obtained automatically, without any formality requirements. This sort of design constitutes a vital instrument of protection for the industries which normally renew their product collections every season, such as the footwear, textile or jewellery industry or the toy or furniture industry.

2. Registered Community design:

Condition held by the design which is registered at the [OHIM](#) in compliance with the registration procedure provided in [Regulation EC 6/2002](#), and [Regulation EC 2245/2002](#).

In order for this sort of design to be protected, an application must be filed and registration granted. The exclusive right conferred by design registration is much stronger and more extensive than the protection provided for the unregistered design.

3. PROTECTION OF THE COMMUNITY DESIGN

Requirements for protection

[Community legislation](#) requires the design to be *new* and to have an *individual character*.

The following examples are excluded from all protection⁶:

- Designs dictated solely by their technical function
- Designs which are contrary to public order
- Designs contrary to public morality
- Ideas per se
- Colours per se
- The material used in the construction of the article
- Construction methods
- Any invisible parts (to register a design it must be easily visible)

Territorial scope

The unitary character of the Community design means that the protection, validity and efficacy of the design covers the whole territory of the European Union.

Duration

The protection period of the Community design varies depending on the type of design concerned:

- The *UNregistered Community design* will be protected for 3 years from the date the design has been made public for the first time in the European Union.
- The protection of the *Registered Community design* will have a duration of 5 years from the date of filing of the registration application. Likewise, a renewal may be requested for one or several subsequent periods of 5 years, up to a maximum of 25 years.

4. RIGHTS GRANTED

What are the rights granted by the Community design?

The rights granted to the holder of a Community design depend directly on the type of design concerned.

Registered Community design

The holder of this type of design will hold the following rights:

1. The exclusive right to use the design.
The exclusive right of use includes, in particular, the making, offering, putting on the market, importing, exporting, stocking or use of the product in which the design is incorporated or to which it is applied.
2. The right to prevent the non-authorised use of the design by third parties.
The registered Community design confers on its holder the right to exclude from the market any subsequent creation which is identical or similar, with no need to prove that it has been created by copying his/her own design.

Unregistered Community design

This sort of design will only confer on its holder the right to prevent the non-authorised use of the design by third parties; this right is subject to the requirement of proving that use results from copying the protected design.

In this sense, the contested design shall not be deemed to result from the copying of the protected design if it results from an independent work of creation.

In order to assert his/her rights before the court, the holder of an UNregistered design shall have to prove the existence of his/her design and that it fulfils protection requirements (Art. 85.2 of [Regulation EC 6/2002](#)).

5. APPLICATION FOR REGISTRATION

Who may apply for registration?

Any natural or legal person may apply to register a Community Design, with no restrictions regarding the nationality or domicile of the applicant.

Those persons entitled to apply for a design registration are:

- The designer
- His/her successor in title

If two or more persons have jointly developed a design, the right to the Community design shall vest in them jointly.

Where a design is developed by an employee in the execution of his/her duties or following the instructions given by the employer, the right to the Community design shall vest in the employer, unless otherwise agreed or specified under national law.

Where may an application for registration be filed?

The application may be filed at the applicant's choice:

- At the Community Office (OHIM).

An application for a registered design may be filed personally at the OHIM, or by ordinary mail or fax or electronically.

- At the central Industrial Property office of a Member State.

- In the Benelux countries, at the [Benelux Design Office](#) .

Where an application for a Community design registration has been filed at the central industrial property office of a Member State of the European Union or at the Benelux Design Office, that office shall forward the application to the OHIM, which is the competent Office to examine formal requirements and explain the reasons for refusing registration as the case may be.

What conditions should the application meet?

The registered Community design application must comply with the following conditions: (Art. 36 [Regulation EC 6/2002](#))

1. Minimum conditions: These are the minimum data the application must include for the Office to grant a filing date.
 1. Request for registration
 2. Information identifying the applicant (natural or legal person)
 3. A representation of the design suitable for reproduction (or a specimen, in the case of a request for deferment of the design publication)
 4. The list of products to which the design is intended to be applied or incorporated.
2. Optional information:
 1. A description explaining the design
 2. A request for deferment of publication of the registration
 3. Information identifying the representative (where one has been appointed)
 4. The [Classification](#) of products to which the design is intended to be applied or incorporated.
 5. Citation of the designer or designers, or a statement declaring that the designer has waived the right to be cited.
 6. A declaration of priority: the priority of an application for an industrial design filed in any State party to the Paris Convention or to the Agreement establishing the World Trade Organisation may be claimed. An exhibition priority may also be claimed if the applicant of the Community design has disclosed the products in which the design is incorporated at an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions.

What is the applicable classification for Community designs?

For the registration of Community designs, the International Classification for Industrial Designs provided in the Annex to the [Locarno Agreement](#) signed on 8th October 1968 shall be applicable.

In order to facilitate the application of this classification, the Office for Harmonisation in the Internal Market (OHIM) has [expanded](#) the Locarno Classification and translated it into all the official languages of the European Union. The result of this arduous task is called [EUROLOCARNO](#).

May multiple applications be filed?

Several designs may be included in the same application, provided that the products to which the design will be applied or incorporated belong to the same class in the [International Classification for Industrial Designs](#).

There is no limit to the maximum number of designs that may be applied for in a multiple application.

Designs consisting of simple ornamentation are excluded from this requirement of belonging to the same class.

6. REGISTRATION PROCEDURE

One of the main commitments of the Office for Harmonisation in the Internal Market is to achieve a registration procedure which is fast and easily accessible for small and medium-sized enterprises as well as for individual designers.

The registration procedure of a Community design is as follows:

- Filing of the application at the OHIM, at the central industrial property office of a Member State or at the Benelux Design Office. That office shall then forward the application to the OHIM as soon as possible.
- Once the application is received, the OHIM shall examine whether the application complies with the [minimum conditions](#) for granting a filing date.
- Besides, the OHIM will carry out a formal examination:
 1. The Office shall examine whether the other formal [requirements](#) of the Community design [application](#) have been fulfilled and the corresponding fees have been paid, as well as whether the requirements for [multiple applications](#) have been met (articles 36 and 37 of [Regulation EC 6/2002](#) and correlative articles of [Regulation EC 2245/2002](#)).
 2. It will also examine, as necessary, that the application meets the requirements established by article 77.2 of [Regulation EC 6/2002](#), concerning the applicant's appointment of a representative at the Office.
 3. Likewise, in the event that a priority date has been claimed, the Office will examine whether the requirements provided in [Regulation EC 6/2002](#) and [Regulation EC 2245/2002](#) have been met.
- The OHIM will also carry out a thorough examination: during the formal examination the Office may refuse registration if the design does not comply with the definition of the Community design or it is contrary to principles of public policy or morality.
- If there are deficiencies in the application, the Office will allow a period of time for the applicant to remedy these.
- After the examination, and, as may be the case, the period to remedy possible deficiencies has been granted, the Office shall decide on the registration or refusal of the Community design.
- Before refusing the application, the applicant will have a new opportunity to amend, withdraw or limit his/her application for a Community design.
- If the application satisfies the legal requirements and it has not been refused, the Office shall register the application in the register as a registered Community design.
- Upon registration of the design, the Office shall order its publication. However, the applicant may request a "deferment of publication" for a period of up to 30 months (this request shall be made when filing the application for registration).
- The decision of the Office (regarding registration or refusal) may be appealed.

7. LANGUAGES

What languages are used in the Community design registration procedure?

The request for registration of a Community design shall be filed in one of the official languages of the European Community; this language will be known as the "first language". (Art. 98 [Regulation EC 6/2002](#))

Likewise, the applicant will designate a second language different from the first one, which will be known as the "procedure language". This language must be one of the official languages of the OHIM.

The official languages of the Office are:

[German](#), [Spanish](#), [French](#), [English](#), [Italian](#)

8. INVALIDITY

Who may submit an application for the invalidity of a Community design?

Any natural or legal person with a legitimate interest, as well as a public authority empowered to do so, may submit an application for a declaration of invalidity of the Community design.

The declaration of invalidity may be filed in the following ways:

1. By means of an application filed at the [OHIM](#).
The Office will receive the application for invalidity (written and reasoned) and examine it in order to determine whether it falls within the [grounds](#) provided in article 25 of [Regulation EC 6/2002](#).
2. By means of an application submitted to the Community design court, only if it is an unregistered design.
3. By means of an action for counterclaim brought during legal proceedings.
This action shall be brought in the context of legal proceedings for design infringement of as heard before the Community design court.

What are the grounds for invalidity of a Community design?

The following grounds may serve as the basis for an application for the declaration of invalidity of a Community design:

- The design does not correspond to the [definition of design](#) as provided in the Community Regulation.
- It does not fulfil the requirements for design registration as set out in the Community Regulation and its implementing Regulation.
- The holder is not entitled to apply for the design or to hold the ownership thereof.
- If there is a conflict with a prior design which has priority.
- The design constitutes an infringement of a work protected by copyright.
- The design constitutes an improper use of public interest signs in any of the Member States.

If a Community design is declared invalid, it is considered that the design has never produced legal effects. The declaration of the invalidity of the design will be in force in the whole of the European Union territory.

9. FEES

The fees that must be paid at the OHIM during the registration procedure and during the legal duration of the Community design are the following⁷:

Concept	Fees	Additional fee for each design (from 2 to 10)	Additional fee for each design (from 11 onwards)
Registration	230 euros	115 euros	50 euros
Publication	120 euros	60 euros	30 euros
Deferment of publication	40 euros	20 euros	10 euros
Surcharge for late payment of the registration fee	60 euros		
Surcharge for late payment of the publication fee	30 euros		
Surcharge for late payment of the deferment of publication fee	10 euros		
Surcharge for late payment of the additional designs fee	25% of the corresponding fee		
Renewal (first)	90 euros		
Renewal (second)	120 euros		
Renewal (third)	150 euros		
Renewal (fourth)	180 euros		
Surcharge for late payment of the renewal fee	25% of the corresponding fee		
Request for invalidity	350 euros		
Appeal	800 euros		
Restitutio in integrum	200 euros		
Request for transfer	200 euros (max. 1,000 euros)		
Transfer of the design			
Licence registration			
Licence cancellation			

Issue of a copy of the application, the registration certificate or a registration abstract (not certified)	10 euros
Issue of a copy of the application, the registration certificate or a registration abstract (certified)	30 euros
Fee for public consultation of files	30 euros
Issue of a copy of the file documents (not certified)	10 euros + 1 euro for each page after 10
Issue of a copy of the file documents (certified)	30 euros + 1 euro for each page after 10
Fee for communicating data contained in a file	10 euros + €1 for each page after 10
Fee to revise the established procedural costs that have to be reimbursed	100 euros

10. APPLICABLE LEGISLATION

The legal provisions concerning the regulation and protection of Community designs may be found in:

- [Regulation EC 6/2002](#)
- [Regulation EC 2245/2002](#)
- [Regulation EC 2246/2002](#)

1. The above are all Registered Designs
2. The above are all Registered Designs
3. The three-dimensional shape of the above bottle is a registered trade mark. At the time of trade mark registration, the shape of the bottle was also protected as a registered industrial design.
4. The type of action will depend on the Unfair Competition Laws of the country in question.
5. The type of injunction or specific procedure for its application will depend on the relevant country's Legislation.
6. Non-exhaustive list by way of example only
7. Fees established in [Regulation EC 2246/2002](#)