

UNITED STATES PATENT AND TRADEMARK OFFICE
GLOBAL INTELLECTUAL PROPERTY ACADEMY

DESIGN PROTECTION AND EXAMINATION EUROPEAN APPROACH

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ANANDA INTELLECTUAL PROPERTY LIMITED

ASEAN-USPTO WORKSHOP ON DESIGN EXAMINATION
THAILAND, 10-12 MAY 2011

“DESIGNS ARE LANGUAGE OF
COMMUNICATION OF OBJECTS”

“THEY COMMUNICATE THE
AESTHETICS OF A PRODUCT”

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DESIGN PATENT PROTECTION IN EUROPE: MULTIPLE OPTIONS

- 1) NATIONAL PROTECTION
EX: “DESSINS ET MODELES” IN FRANCE

- 2) REGIONAL PROTECTION
REGISTERED COMMUNITY DESIGN (RCD)
UNREGISTERED COMMUNITY DESIGN (UCD)

- 3) INTERNATIONAL PROTECTION
THE HAGUE AGREEMENT (WIPO)

TEXTS REGULATING COMMUNITY DESIGNS

- COUNCIL REGULATION (EC) N° 6/2002 OF 12 DECEMBER 2001 ON COMMUNITY DESIGNS (CDR)
- COMMISSION REGULATION (EC) N°2245/2002 OF 21 OCTOBER 2002 IMPLEMENTING COUNCIL REGULATION (EC) No 6/2002 ON COMMUNITY DESIGNS (CDIR)
- COMMISSION REGULATION (EC) N° 2246/2002 OF 16 DECEMBER 2002 ON THE FEES PAYABLE TO THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS AND DESIGNS) IN RESPECT OF THE REGISTRATION OF COMMUNITY DESIGNS (CDFR)

THE REGISTERED COMMUNITY DESIGN (RCD): OVERVIEW

WHAT CAN BE PROTECTED (1/2)?

- THE APPEARANCE OF A PRODUCT OR PART OF A PRODUCT THE APPEARANCE CAN RESULT FROM THE SHAPE, LINES, CONTOURS, ORNAMENTATION, COLOURS, TEXTURE OR MATERIALS OF THE PRODUCT.
A PRODUCT MEANS ANY INDUSTRIAL OR HANDICRAFT ITEM EXCEPT A COMPUTER PROGRAM, AND INCLUDES PARTS INTENDED TO BE ASSEMBLED INTO A COMPLEX PRODUCT, PACKAGING, GET-UP, GRAPHIC SYMBOLS OR TYPEFACES.
- TWO DIMENSIONAL DESIGNS (E.G. PATTERNS) OR THREE DIMENSIONAL DESIGNS
- DESIGNS COMPRISING TWO AND THREE DIMENSIONAL ELEMENTS (E.G. A MOBILE PHONE)

THE REGISTERED COMMUNITY DESIGN (RCD) : OVERVIEW

WHAT CAN BE PROTECTED (2/2)?

- DESIGNS FOR COMPONENTS OF COMPLEX PRODUCTS THAT ARE VISIBLE IN USE (E.G. WING MIRRORS OF A CAR)
- LOGOS, STYLISED WORD, LABELS AND THE APPEARANCE OF PACKAGING, THAT HAVE TRADITIONALLY BEEN PROTECTED BY TRADE MARKS AND/OR COPYRIGHT.

RDC ARE USEFUL SUPPLEMENT OR ALTERNATIVE TO TRADE MARK PROTECTION WHERE TRADE MARK PROTECTION MAY BE DIFFICULT TO OBTAIN OR CANNOT BE SECURED WITHOUT EXTENSIVE USE (E.G SHAPE OF GOODS/PACKAGING).

THE REGISTERED COMMUNITY DESIGN (RCD) : OVERVIEW

WHAT CAN NOT BE PROTECTED (1/2)?

- FEATURES OF A DESIGN WHICH
 - (I) ARE SOLELY DICTATED BY TECHNICAL FUNCTION, OR
 - (II) MUST BE REPRODUCED EXACTLY TO ENABLE THE PRODUCT TO FIT WITH ANOTHER PRODUCT SO THAT EITHER PRODUCT CAN FULFIL ITS FUNCTION



THE REGISTERED COMMUNITY DESIGN (RCD) : OVERVIEW

WHAT CAN NOT BE PROTECTED (2/2)?

THE REPAIR OF A COMPLEX PRODUCT SO AS TO RESTORE IT TO ITS ORIGINAL APPEARANCE BY THE USE OF A COMPONENT PART DOES NOT INFRINGE A DESIGN REGISTERED FOR THE DESIGN OF THAT COMPONENT PART.



THE REGISTERED COMMUNITY DESIGN (RCD) : OVERVIEW

OTHER REQUIREMENTS:

(1) NOVELTY

(2) INDIVIDUAL CHARACTER

A DESIGN IS REGARDED AS HAVING “INDIVIDUAL CHARACTER” IF IT PRODUCES A DIFFERENT OVERALL IMPRESSION ON AN INFORMED USER TO THAT PRODUCED BY ANY PREVIOUS DESIGN.

(3) NOT CONTRARY TO PUBLIC ORDER

THE REGISTERED COMMUNITY DESIGN (RCD) : OVERVIEW

MAIN FEATURES:

- HAS A LIFE OF 5 YEARS FROM THE DATE OF FILING AND CAN BE RENEWED IN PERIODS OF FIVE YEARS UP TO A MAXIMUM OF **25 YEARS**.
- VALID IN THE EUROPEAN UNION AS A WHOLE. IT IS NOT POSSIBLE TO LIMIT THE GEOGRAPHIC SCOPE OF PROTECTION TO CERTAIN MEMBER STATES.
- GRACE PERIOD OF 12 MONTHS FOR APPLICANT
- A SUCCESS STORY: ALREADY 400,000 REGISTERED COMMUNITY DESIGNS FILED

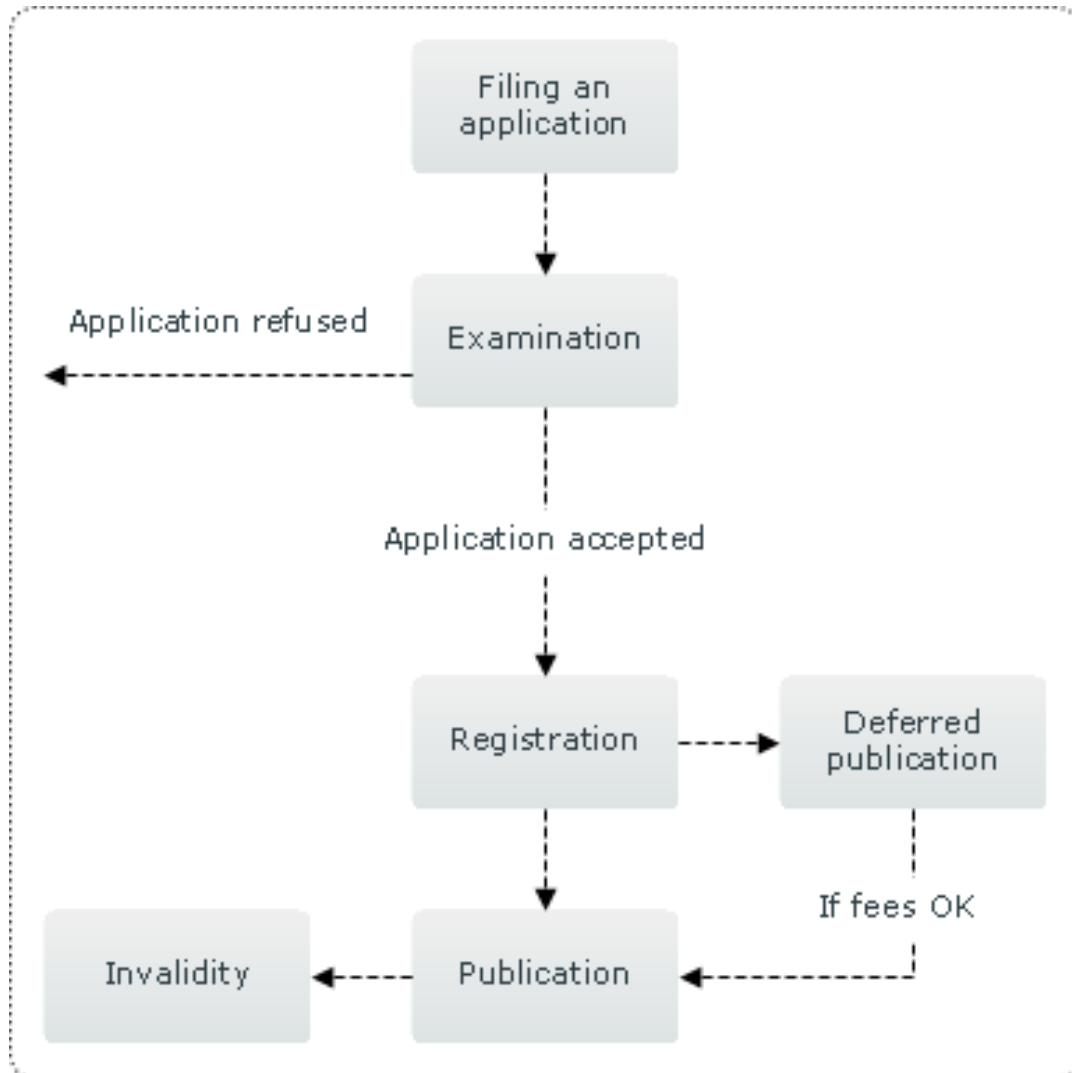
THE REGISTERED COMMUNITY DESIGN (RCD) : OVERVIEW

- SINGLE LEGAL SYSTEM APPLIES
- SIMPLE REGISTRATION PROCEDURE BEFORE OHIM:
 - A SINGLE APPLICATION
 - A SINGLE LANGUAGE OF FILING
 - A SINGLE ADMINISTRATIVE CENTRE
 - A SINGLE FILE TO BE MANAGED
 - A SINGLE PAYMENT
- THE POSSIBILITY TO FILE MULTIPLE APPLICATIONS (I.E. TO INCLUDE SEVERAL DESIGNS IN ONE APPLICATION, SUCH AS A WHOLE RANGE OF SIMILAR PRODUCTS)
- THE POSSIBILITY TO KEEP THE DESIGN CONFIDENTIAL FOR UP TO 30 MONTHS (“DEFERMENT OF PUBLICATION”)

THE REGISTERED COMMUNITY DESIGN (RCD) : OVERVIEW

- HIGH LEVEL OF PROTECTION: HOLDERS HAVE EXCLUSIVE RIGHTS TO USE THE DESIGN CONCERNED AND TO PREVENT ANY THIRD PARTY FROM USING IT WITHIN THE E.U.
- PROTECTION AGAINST BOTH DELIBERATE COPYING AND THE INDEPENDENT DEVELOPMENT OF A SIMILAR DESIGN.
- PROTECT THE DESIGNER FOR ANY DESIGN "WHICH DOES NOT PRODUCE ON THE INFORMED USER A DIFFERENT OVERALL IMPRESSION."
- RIGHTS COVER THE MAKING, OFFERING, MARKETING, IMPORTING, EXPORTING OR USE OF A PRODUCT IN WHICH THE DESIGN IS INCORPORATED OR TO WHICH IT IS APPLIED, OR HOLDING STOCK OF SUCH PRODUCT FOR THOSE PURPOSES.

THE REGISTERED COMMUNITY DESIGN (RCD) : OVERVIEW



Representation
before the
OHIM

Inspection of
files and copies

Changes to the
register

RCD: EXAMINATION GUIDELINES: GENERAL PRINCIPLES 1/3

UNITARY CHARACTER (Art 1(3), 32(1) CDR)

- GRANT PROPRIETOR A UNIFORM PROTECTION WITH UNITARY EFFECT THROUGHOUT THE ENTIRE TERRITORY OF THE COMMUNITY (27 COUNTRIES).
- RCD CAN ONLY BE REGISTERED, TRANSFERRED OR SURRENDERED IN RESPECT OF THE WHOLE COMMUNITY
- LICENSES HOWEVER CAN BE GRANTED FOR PART OF COMMUNITY ONLY.

RCD: EXAMINATION GUIDELINES: GENERAL PRINCIPLES 2/3

REGISTRATION (Art 2, 72 CDR)

- RCD REQUIRES THE CREATION AND MAINTENANCE OF A REGISTER IN WHICH PARTICULARS OF THE REGISTRATIONS WILL BE ENTERED. SUCH TASK IS ENTRUSTED TO OHIM.

EXAMINER (Art 103 CDR)

- AN EXAMINER IS IN CHARGE OF TAKING DECISIONS ON BEHALF OF THE OFFICE.

RCD: EXAMINATION GUIDELINES: GENERAL PRINCIPLES 3/3

SCOPE OF EXAMINATION (Art 47 CDR)

- NO SUBSTANTIVE EXAMINATION OF THE COMPLIANCE WITH THE REQUIREMENTS FOR PROTECTION
- A MINIMUM BURDEN FOR APPLICANTS

HOWEVER: TWO SUBSTANTIVE GROUNDS FOR REFUSING AN APPLICATION:

- WHERE THE SUBJECT MATTER OF THE APPLICATION DOES NOT CORRESPOND TO THE DEFINITION OF A DESIGN (ART 3 CDR); OR
 - WHERE THE DESIGN IS CONTRARY TO PUBLIC POLICY OR ACCEPTED PRINCIPLES OF MORALITY (NO LEGAL DEFINITION IN CDR)
- THE EXAMINER WILL NOTIFY THE APPLICANT IN EXAMINATION REPORT. APPLICANT CAN WITHDRAW OR AMEND THE APPLICATION OR SUBMIT OBSERVATIONS

RCD: EXAMINATION GUIDELINES: RECEIPT OF APPLICATION

DATE OF RECEIPT AND FILE NUMBER (Art 35 CDR; Art 7(1)(3) CDIR)

- APPLICATIONS CAN BE FILED AT OFFICE DIRECTLY OR AT CENTRAL INDUSTRIAL PROPERTY OFFICE OF A MEMBER STATE OR BENELUX DESIGN OFFICE

ISSUE OF RECEIPT (Art 7 CDIR)

EXAMINER ISSUES A NOTIFICATION OF RECEIPT WITHOUT DELAY.

NOTIFICATION WILL SPECIFY FILE NUMBER, REPRESENTATION, IDENTIFICATION OF DESIGN, NATURE AND NUMBER OF DOCUMENTS, DATE OF RECEIPT, NUMBER OF DESIGN FILED IN CASE OF MULTIPLE APPLICATION.

IF NO DEFICIENCY THE NOTIFICATION MAY INDICATE THAT RCD IS ACCEPTED FOR REGISTRATION. IN CASE OF DEFICIENCY EXAMINER ISSUES AN **EXAMINATION REPORT TOGETHER WITH NOTIFICATION OF RECEIPT.**

RCD: EXAMINATION GUIDELINES: ALLOCATION OF FILING DATE

MINIMUM REQUIREMENTS (Art 36(1), 38 CDR; Art 10(1) CDIR)

- THE APPLICATION SHALL CONTAIN:
 - A REQUEST FOR REGISTRATION (CAN BE APPLICANT'S OWN FORM)
 - INFORMATION IDENTIFYING THE APPLICANT
 - A REPRESENTATION OF DESIGN SUITABLE FOR REPRODUCTION

NOTE: PAYMENT OF FEES IS NOT A REQUIREMENT TO SECURE A FILING DATE.

RCD: EXAMINATION GUIDELINES: ALLOCATION OF FILING DATE

REPRESENTATION OF THE DESIGN (Art. 36(1)(c) CDR; Art. 4, 66 CDIR)

- CLEAR
- COMPLETE
- NOTHING REGARDING THE DESIGN SHALL BE LEFT TO CONJECTURE
- DRAWINGS, PHOTOGRAPHS (EXCEPT SLIDES), COMPUTER-MADE REPRESENTATIONS OR ANY OTHER GRAPHICAL REPRESENTATION ARE ACCEPTED PROVIDED THEY ARE SUITABLE FOR REPRODUCTION
- NEUTRAL BACKGROUND AND NOT RETOUCHEDED BY INK OR CORRECTING FLUID
- CAPABLE OF BEING REDUCED OR ENLARGED TO A SIZE NOT MORE THAN 8CM X 16CM PER VIEW FOR ENTRY IN REGISTRAR AND BULLETIN.

RCD: EXAMINATION GUIDELINES: ALLOCATION OF FILING DATE

SPECIMEN (Art. 36(1)(c) CDR; Art. 5(1)(3), 65(2) CDIR)

- POSSIBILITY TO FILE A SPECIMEN PROVIDED THAT:
 - THE APPLICATION RELATED TO A TWO DIMENSIONAL DESIGN, AND
 - THE APPLICATION CONTAINS A REQUEST FOR DEFERMENT

TREATING DEFICIENCIES (Art. 38(2), 46(2) CDR; Art 10(1)(2), 66 CDIR)

TRANSMISSION OF APPLICATION FROM NATIONAL OR REGIONAL OFFICE TO THE OFFICE (WITHIN 2 MONTHS TO KEEP FILING DATE)

TRANSMISSION BY FAX: RISKY TO SECURE A FILING DATE-CONFIRMATION COPY
STRONGLY RECOMMENDED WITHIN ONE MONTH

TIME LIMIT OF TWO MONTHS TO REMEDY DEFICIENCIES

RCD: EXAMINATION GUIDELINES: GROUNDS FOR NON-REGISTRABILITY

- NOT A DESIGN AS PER ARTICLE 3(A) CDR;

IN CASE OF MULTIPLE COMPONENT AT LEAST ONE VIEW ASSEMBLED IS NEEDED.

IN CASE OF A SET OF ARTICLES, PRODUCTS SHALL BE SO CLOSELY RELATED THAT THEY CAN BE CONSIDERED AS FORMING A SINGLE PRODUCT (EX: FORKS, SPOONS, KNIFES)

- CONTRARY TO PUBLIC POLICY/MORALITY (RACIST MESSAGE ETC.)

RCD: EXAMINATION GUIDELINES: INDICATION OF PRODUCTS AND CLASSIFICATION

CLEAR INDICATION (Art. 36(2) CDR; Art. 1(1)(d), 3(3) CDIR)

- INDICATE CLEARLY NATURE OF THE PRODUCTS IN ORDER TO ALLOW CLASSIFICATION IN ONLY ONE CLASS OF THE LOCARNO CLASSIFICATION.
- INDICATION OF PRODUCT DOES NOT AFFECT THE SCOPE OF PROTECTION OF COMMUNITY DESIGN.
- NOT A DEFICIENCY TO FAIL TO SUBMIT A CLASSIFICATION.

EUROLOCARNO (LOCARNO+2000 ADDITIONAL TERMS) DATABASE IS ACCESSIBLE ONLINE ON OHIM WEBSITE

RCD: EXAMINATION GUIDELINES: MULTIPLE APPLICATION

UNLIMITED NUMBER OF DESIGNS (Art. 37(1) CDR; Art 2(1) CDIR)

NOTE: IF IN THE SAME CLASS OF THE LOCARNO DESIGN CLASSIFICATION WITH THE EXCEPTION OF ORNAMENTATION.

IN CASE OF DEFICIENCY (NO UNITY OF CLASS IN A MULTIPLE APPLICATION), EXAMINER WILL REQUEST DIVISION OF APPLICATION AND APPLICANT HAS TWO MONTHS TO COMPLY AND PAY OFFICIAL FEES. IF APPLICANT DOES NOT RESPOND, APPLICATION IS REJECTED IN ITS ENTIRETY.

RCD: EXAMINATION GUIDELINES: DESCRIPTION

SCOPE (Art. 36(3)(a) CDR; Art 1(2)(a) CDIR)

APPLICATION CAN CONTAIN A DESCRIPTION NOT EXCEEDING 100 WORDS
WHICH DOES NOT AFFECT THE SCOPE OF PROTECTION AND IS NOT ENTERED IN
REGISTER NOR PUBLISHED.

RCD: EXAMINATION GUIDELINES: PRIORITY

PREVIOUS APPLICATIONS (Art. 41, 42 CDR; Art 8 CDIR)

PARIS CONVENTION/WTO SIX MONTHS PRIORITY. MULTIPLE PRIORITY CAN BE CLAIMED (EX: FOR MULTIPLE APPLICATION).

MUST BE CLAIMED AT TIME OF FILING OR WITHIN ONE MONTH OF FILING.

MUST PROVIDE CERTIFIED COPY OF PRIORITY APPLICATION WITHIN THREE MONTHS AND TRANSLATION IN ONE OF FIVE LANGUAGE OF COMMUNITY.

EXHIBITION PRIORITY (Art 44 CDR; Art 9 CDIR)

ALSO SIX MONTHS. AUTHORITY RESPONSIBLE FOR IP AT EXHIBITION SHALL ISSUE A CERTIFICATE TO BE FILED WITH OHIM WITHIN THREE MONTHS. ONLY APPLICABLE TO OFFICIALLY RECOGNIZED INTERNATIONAL EXHIBITIONS UNDER CONVENTION ON INDUSTRIAL EXHIBITIONS (1928)

RCD: EXAMINATION GUIDELINES: FORMALITIES OF APPLICATION

REPRESENTATIVE (Art. 45(2), 46(3), 62, 77, 78 CDR; Art 1(1)(e), 10(3)(4) CDIR)

FOR APPLICANTS NOT HAVING THEIR DOMICILE OR THEIR PRINCIPAL PLACE OF BUSINESS OR A REAL AND EFFECTIVE INDUSTRIAL OR COMMERCIAL ESTABLISHMENT IN THE COMMUNITY. MUST APPOINT A REPRESENTATIVE WITHIN TWO MONTHS OF FILING APPLICATION.

FORMAT OF THE REPRESENTATION OF THE DESIGN (Art. 45(2), 46(3) CDR; Art 4 (1) CDIR)

- SEPARATE SHEETS OF PAPER NOT FOLDED NOR STAPLED;
- A4 SIZE WITH SPACE FOR REPRODUCTION NOT LARGER THAN 26.2 CM X 17 CM, MARGIN OF 2.5 CM ON LEFT HAND SIDE, SHALL INDICATE ON TOP NUMBER OF VIEWS, NO WORDING, NO SYMBOLS
- POSSIBILITY OF E-FILING

RCD: EXAMINATION GUIDELINES: FORMALITIES OF APPLICATION

FORMAT OF THE REPRESENTATION OF THE DESIGN (Art. 45(2), 46(3) CDR; Art 4 (1) CDIR) continued

- POSSIBILITY OF COLOR REPRESENTATIONS
- UP TO SEVEN DIFFERENT VIEWS PER DESIGN
- DOTTED LINES PERMISSIBLE EITHER TO INDICATE THE ELEMENTS FOR WHICH NO PROTECTION IS SOUGHT OR TO INDICATE PORTIONS OF THE DESIGN THAT ARE NOT VISIBLE IN THAT PARTICULAR VIEW
- BOUNDARIES AND COLORING MAY BE USED TO HIGHLIGHT FEATURES FOR WHICH PROTECTION IS SOUGHT.
- ONCE FILED, NOT POSSIBLE TO INCLUDE ADDITIONAL VIEWS.
- FOR REPETITIVE PATTERNS, THE REPRESENTATION MUST SHOW COMPLETE PATTERN AND A SUFFICIENT PORTION OF REPEATING SURFACE.

OTHER IMPORTANT PROVISIONS

REQUEST FOR DEFERMENT OF PUBLICATION (30-MONTHS)

(ART. 50 CDR; ART. 15, 16 CDIR)

NOTE: DEFERMENT OF PUBLICATION MAY ONLY BE REQUESTED IN THE APPLICATION. REQUEST FOR PUBLICATION SHALL BE MADE BY APPLICANT AT LEAST THREE MONTHS BEFORE DEFERMENT PERIOD EXPIRES. NO REMINDER IS SENT.

PUBLICATION (ART. 49 CDR; ART. 14 CDIR)

UNLESS AN APPLICATION CONTAINS A REQUEST FOR DEFERMENT OF PUBLICATION, PUBLICATION TAKES PLACE IMMEDIATELY AFTER REGISTRATION AND CERTIFICATE IS ISSUED.

WITHDRAWAL AND CORRECTIONS (ART. 12(1) CDIR)

APPLICANT CAN WITHDRAW APPLICATION OF PART OF A MULTIPLE DESIGN APPLICATION AT ANY TIME. CORRECTIONS ARE ALLOWED EXCEPT FOR REPRESENTATION.

COSTS

THE FEES RELATED TO THE FILING OF AN APPLICATION
WITH NO DEFERMENT ARE:

REGISTRATION FEE

FIRST DESIGN	230 €
FROM 2 ND TO 10 TH DESIGN	115 €
FROM 11 TH ONWARDS	50 €

PUBLICATION FEE

FIRST DESIGN	120 €
FROM 2 ND TO 10 TH DESIGN	60 €
FROM 11 TH ONWARDS	30 €

UNREGISTERED COMMUNITY DESIGN (UCD)

- RCDs AND UCDs HAVE TO MEET THE SAME CONDITIONS TO BE PROTECTED.
- THREE YEARS FROM THE DATE ON WHICH THE DESIGN WAS FIRST **MADE AVAILABLE TO THE PUBLIC** WITHIN THE TERRITORY OF THE EUROPEAN UNION. DISCLOSURE WILL NOT BE TAKEN INTO ACCOUNT IF THE DESIGN, AFTER DISCLOSURE, IS NOT KNOWN **"IN THE NORMAL COURSE OF BUSINESS TO THE CIRCLES SPECIALISED IN THE SECTOR CONCERNED OPERATING WITHIN THE COMMUNITY"**.
- THE DATE OF DISCLOSURE MUST BE CERTAIN.
- AN UCD ONLY CONFERS ON ITS HOLDER A RIGHT TO PREVENT **COPYING**.

THE HAGUE AGREEMENT

- THE HAGUE AGREEMENT COMPRISES TWO DIFFERENT “ACTS”, THE HAGUE (1960) ACT AND THE GENEVA (1999) ACT. BOTH ACTS CONSIST OF A DIFFERENT SET OF LEGAL PROVISIONS. INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS MAY ONLY BECOME PARTY TO THE GENEVA ACT. THE GENEVA ACT BECAME FULLY OPERATIONAL ON 1 APRIL 2004.
- THE EUROPEAN UNION (EU) ACCEDED TO THE GENEVA ACT ON 24 SEPTEMBER 2007, AND THE ACT ENTERED INTO FORCE WITH RESPECT TO THE EU ON 1 JANUARY 2008.
- 37 MEMBER STATES

THE HAGUE SYSTEM

ACCESSION OF THE EU TO THE GENEVA ACT

- APPLICANTS CAN FILE INTERNATIONAL APPLICATIONS THROUGH NATIONALITY OF A MEMBER STATE OF THE EU OR HAVING A DOMICILE, REAL AND EFFECTIVE COMMERCIAL OR INDUSTRIAL ESTABLISHMENT, OR HABITUAL RESIDENCE, IN THE TERRITORY OF A MEMBER STATE OF THE EU
- ANOTHER CONSEQUENCE IS THAT THE EU MAY BE DESIGNATED IN AN INTERNATIONAL REGISTRATION. IF OHIM DOES NOT ISSUE A REFUSAL IN RESPECT OF SUCH AN INTERNATIONAL REGISTRATION, IT WILL HAVE THE SAME EFFECTS IN THE TERRITORY OF THE EU AS A COMMUNITY DESIGN.

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INTELLECTUAL PROPERTY

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