

Protection of Industrial Design as Intellectual Property Right in European Union

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Abstract

This article is aimed to present the main legal framework for obtaining intellectual property rights for industrial design in European Union.

The main legal document is Regulation № 6/2002 of the Council for a Community design administrated by European Union Intellectual property Office (EUIPO) based in Spain.

This article reveals main legal characteristics of this Regulation such as: main terms and types of EU designs, requirement for registration of industrial design called Community design (CD), the scope of protection, procedure and exclusive intellectual property rights (IP rights) for CD.

A community design has a unitary character and has equal effect throughout the each country of EU – EU countries.

The final part is focused on the advantages of the CD system – administrative and financial, for the applicants and holders.

Key words: industrial design, Community design, intellectual property rights

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INTRODUCTION

The system of 'Community Design' has been working from March 6, 2002

The authority responsible for the administration of Community design is the European Union Intellectual property Office (EUIPO) - ex Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM).

EUIPO is an administrative, legal and financially independent office of the European Community based in the Spanish city of Alicante.

A design which meets the conditions contained in the regulations regarding industrial design is hereinafter will be under title a "Community design" (CD).

Generally speaking EU design protects shape, patterns, and colors.

Annually EUIPO registers around 85000 design for the territory of EU countries.

MAIN NOTES

The regulations governing the issues of Community design are the following:

- Regulation № 6/2002 EC of 12.12. 2001 on Community designs – the main Regulation;
- Regulation № 2245/2002 of the Commission of 21:10. 2002 implementing Council
- Regulation № 6/2002 of the Council for a Community design;
- Regulation № 2869/95 of the Commission of 1995 on the fees charged by the Office for Harmonization in the Internal Market;
- Regulation № 216/96 Commission of 5.02.1996 on the procedures of the Appeals Committee

The main Regulation which presents a legal framework and main aspect of procedure and legal consequences is Regulation № 6/2002 of the Council for a Community design.

This Regulation is on the focus of our attention and analysis.

The European regulation presents 2 legal option for the design protection:

- as an "**unregistered community design**", if made available to the public in the manner provided for in this regulation;

- as a "**registered community design**", if registered in the manner provided for in this Regulation.

A community design shall have a unitary character. This means that the Community design shall have equal effect throughout the each country of EU – EU community¹.

I. MAIN LEGAL POINTS ACCORDING TO THE REGULATION 6/2002

1. TERMS AND REQUIREMENTS

Regulation 6/2002 presents a definition for EU design as follows:

"**Design**" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation.

And a definition for related terms ‘product’ and ‘complex products’:

- "Product" means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;
- "Complex product" means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

Almost any industrial or handicraft item can be eligible for design protection with one exception: computer programs.

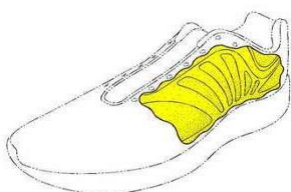
The European Union design (CD) can be a part of product, the trade product as a whole and/ or set of products.

Some examples of CDs:

¹ www.euipo.europa.eu; www.bpo.bg.



Packaging of products RCD 000785522-0001



Parts of products - RCD 229752-0001



A set of products RCD 000465679-0016



Logos RCD 000754098-0001



Computer icons RCD 000600184-0008

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Typefaces RCD 000108584-0001



Get-ups RCD 000521760-0001



Web design RCD 001100598-0009



Maps RCD 000197405-0001

Requirements for design protection:

1. A design shall be protected by a community design to the extent that it is new and has individual character.
2. A design applied to or incorporated in a product which constitutes
 - A component part of a complex product shall only be considered to be new and to have individual character:
 - If the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and
 - To the extent that those visible features of the component part fulfil the requirements as to novelty and individual character.
3. "Normal use" within the meaning of the Reglament shall mean use by the end user, excluding maintenance, servicing or repair work.

The requirement '**novelty**' shall be defined as:

A design shall be considered to be new if no identical design has been made available to the public:

(a) In the case of an unregistered community design, before the date on which the design for

which protection is claimed has first been made available to the public;

(b) In the case of a registered community design, before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.

Designs shall be deemed to be identical if their features differ only in immaterial details.

The requirement '**individual character**' shall be defined as:

1. a 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 a user by any design which has been made available to the public:
 - (a) In the case of an unregistered community design, before the date on which the design for which protection is claimed has first been made available to the public;
 - (b) In the case of a registered community design, before the date of filing the application for registration or, if a priority is claimed, the date of priority.
2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

There is specific regulation of the legal case under title ‘disclosure’ as following:

- A design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred., as the case may be, except where these events could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the community.
- The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

A disclosure shall not be taken into consideration for this purpose if a design for which protection is claimed under a registered community design has been made available to the public:

- By the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title; and
- During the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority.

Mentioned before shall also apply if the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.

The Regulation 6/2002 presents so called ‘**exception of registration**’ as following title ‘**Designs dictated by their technical function and designs of interconnections**’

- Designs dictated by their technical function and designs of interconnections;
- A community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.
- A community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.
- A community design shall not subsist in a design which is contrary to public policy or to accepted principles of morality.

2. SCOPE OF PROTECTION

Scope of protection of the registered design includes:

- (a) The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.
- (b) In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.

Commencement and term of protection of the unregistered community design

- (a) A design which meets the requirements under section 1 shall be protected by an unregistered community design for a period of three years as from

the date on which the design was first made available to the public within the community.

- (b) For the purpose of paragraph 1, a design shall be deemed to have been made available to the public within the community if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialized in the sector concerned, operating within the community. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

For the registered ECD /European Community design

Commencement and term of protection of the registered community design upon registration by the Office - EUIPO, a design which meets the requirements shall be protected by a registered community design for a period of five years as from the date of the filing of the application. The right holder may have the term of protection renewed for one or more periods of five years each, up to a total term of 25 years from the date of filing.

Renewal

1. Registration of the registered Community design shall be renewed at the request of the right holder or of any person expressly authorized by him, provided that the renewal fee has been paid.
2. The Office shall inform the right holder of the registered Community design and any person having a right entered in the register of Community designs of the expiry of the registration in good time before the said expiry. Failure to give such information shall not involve the responsibility of the Office.
3. The request for renewal shall be submitted and the renewal fee paid within a period of six months ending on the last day of the month in which protection ends. Failing this, the request may be submitted and the fee paid within a further

period of six months from the day referred to in the first sentence, provided that an additional fee is paid within this further period.

4. Renewal shall take effect from the day following the date on which the existing registration expires. The renewal shall be entered in the register.

Right to the Community design

1. The right to the Community design shall vest in the designer or his successor in title.
2. If two or more persons have jointly developed a design, the right to the Community design shall vest in them jointly.
3. However, where a design is developed by an employee in the execution of his duties or following the instructions given by his employer, the right to the Community design shall vest in the employer, unless otherwise agreed or specified under national law.

Right of the designer to be cited

The designer shall have the right, in the same way as the applicant for or the holder of a registered Community design, to be cited as such before the Office and in the register. If the design is the result of teamwork, the citation of the team may replace the citation of the individual designers.

Effects of the Community design

Generally, the registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it.

‘USE’ shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

An unregistered Community design shall, however, confer on its holder *the right to prevent the acts referred to this design only if the contested use results from copying the protected design.*

The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

Limitation of the rights conferred by a Community design

1. The rights conferred by a Community design shall not be exercised in respect of:

- Acts done privately and for non-commercial purposes;
- Acts done for experimental purposes;
- Acts of reproduction for the purpose of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.

In addition, the rights conferred by a Community design shall not be exercised in respect of:

- The equipment on ships and aircraft registered in a third country when these temporarily enter the territory of the Community;
- The importation in the Community of spare parts and accessories for the purpose of repairing such craft;
- The execution of repairs on such craft.

Exhaustion of rights

The rights conferred by a Community design shall not extend to acts relating to a product in which a design included within the scope of protection of the Community design is incorporated or to which it is applied, when the product has

been put on the market in the Community by the holder of the Community design or with his consent.

Rights of prior use in respect of a registered Community design

1. A right of prior use shall exist for any third person who can establish that before the date of filing of the application, or, if a priority is claimed, before the date of priority, he has in good faith commenced use within the Community, or has made serious and effective preparations to that end, of a design included within the scope of protection of a registered Community design, which has not been copied from the latter.
2. The right of prior use shall entitle the third person to exploit the design for the purposes for which its use had been effected, or for which serious and effective preparations had been made, before the filing or priority date of the registered Community design.
3. The right of prior use shall not extend to granting a license to another person to exploit the design.
4. The right of prior use cannot be transferred except, where the third person is a business, along with that part of the business in the course of which the act was done or the preparations were made.

Government use

Any provision in the law of a Member State allowing use of national designs by or for the government may be applied to Community designs, but only to the extent that the use is necessary for essential defense or security needs.

Transfer of the registered Community design

The registered Community design can be a subject of licensing or transferring
A Community design may be licensed for the whole or part of the Community. A license may be exclusive or nonexclusive.

II. FILING OF APPLICATION FOR COMMUNITY DESIGN

The right to file a Community design belongs to any natural or legal person.

Applications may be submitted by mail, fax, electronically or in person at the EUIPO. Several designs may be combined in one multiple application for registered Community designs. Except in cases of ornamentation, this possibility is subject to the condition that the products in which the designs are intended to be incorporated or to which they are intended to be applied all belong to the same class of the International Classification for Industrial Designs.

The filing is done by completing the application form by applying image design that is a quality that allows its reproduction.

The image may be graphic or photographic

The application for registration of a Community design in electronic form may be submitted in any official EU languages.

Representation of the design must be applied to the electronic application format .jpeg. The file size should not exceed 2 MB per image. Each application can contain only one image.

The applicant may submit as desired designs in a multiple application but only provided the products to which it is applied or which include design, belong to the same class of the International Classification of designs from Locarno.

Limit the number of designs in a multiple application is when the application is filed electronically. The number of designs in one application is limited to 99 designs.

III. ADVANTAGES OF THE COMMUNITY DESIGN REGISTRATION SYSTEM

The CD system gives *unified and stable protection* across the European Union, included overcome national differences and peculiarities of legislation on design for each of the 28 EC countries².

As summarised: The applicant /holder of RCD can obtain:

A. Realizing administrative effect

- It is necessary to know only one procedure for the application and registration of Community Design /instead of many specific national application and registration systems/;
- The applicant can submit only one application /instead of 28 different applications for each member state of the EU /;
- The applicant can use only one language for CD application;
- Communicates with only one Office during the procedure of registration of CD
- Only one file for preparation of registration of CD
- The applicant has the possibility of submit the multiple application of EU/ CD;
- The applicant has an ability to delay public disclosure of the design up to 30 months to avoid competition to learn about it.

² Markova, M (2008), *Protection of industrial design in the country and abroad*, publ. BPO and OHIM, Markova, M. (2010), *Design management*, UNWE pub. complex.

B. **Realizing financial effect**

- Fees for registration and publication of design amounts to € 350 for 5-year term of protection. Charging system is "decreasing" which means that in case of a multiple registration fee for the design of the second to tenth is equal to 50% of the basic fee and for each design from eleventh up less than 25% of the basic fee.

C. **Others:**

- ***Obtaining short terms for the publication*** of Community Design in the Bulletin of the EUIPO in Alicante³;
- ***Reducing of conflicts in trade*** between Member States arising from differences in national legislation in the field of design;
- ***Overcoming obstacles to competition*** in the Community and the free movement of goods caused by the huge number of applications, departments and procedures.

INSTEAD OF CONCLUSION:

At the European Union Intellectual Property Office are registered close to **85 000 designs per year. More than 90 % of CD has been registered under the e-system:** fast, easy and effective way of obtaining RCD from all natural and legal persons.

This effective system of CD is very useful and completely assessed as an appropriate legal instrument for the protection of industrial designs among the European Union.

³ Markova, M., *Intellectual Property Rights and Consumer Behavior*, Advances in Economics and Business, N1, 2017 <http://www.hrpub.org>; Markova, M, 'Intellectual property knowledge - a need in the contemporary higher education', report and published paper in a conference book, Future of education, PIXEL, Italy, 2017.

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