



# FORMAL AND SUBSTANTIVE EXAMINATION OF DESIGNS

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EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

## OVERVIEW

- 1. Forms of Protection**
  - Unregistered Community design
  - Registered Community design
- 2. Filing**
- 3. EUIPO formal examination**
  - Priority, languages, professional representation, fees
  - Representation
  - Product indication/Classification
- 4. EUIPO substantive examination**
  - Definition of a design
  - Public policy and principles of morality
- 5. Registration**
- 6. EUIPO Cancellation proceedings**
  - Novelty and individual character

## 1. FORMS OF PROTECTION

A design can be protected in the EU as:

- 1. UNREGISTERED Community Design (UCD)**
- 2. REGISTERED Community Design (RCD)**

## UNREGISTERED Community Design (UCD)

All new creations disclosed for the first time in the EU after this date are protected by that right **against copying**, throughout the EU.

- max. life: 3 years
- no registration procedure
- no cost
- no grace period
- invalidity only at Courts



## REGISTERED Community Design (RCD)

It confers on its holder the exclusive right to use the design and prevent others from using it, including the making, offering, putting on the market, importing, exporting or using any product in which the design is incorporated or applied to.



Administrative centre: *European Union Intellectual Property Office (EUIPO), Alicante*

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## 2. FILING

Applications can be filed directly to EUIPO by...

e-filing (electronic application)

Post

Hand delivery



or, through any IP National Office of the EU (filing date = the date of receipt in the National Office)

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## 3. EUIPO FORMAL EXAMINATION

### Formalities

- 2<sup>nd</sup> language of application
- Priorities
- **Fees**
- Professional representative
- Representation of the design
- Product indication/classification

## EUIPO formal examination - FEES

## EUIPO formal examination - FEES

	REGISTRATION	PUBLICATION		DEFERMENT OF PUBLICATION*
1 <sup>st</sup> DESIGN	230 EUR	+ 120 EUR	= <b>350 EUR</b>	40 EUR *
DESIGNS 2 TO 10	115 EUR	60 EUR	= 175 EUR	20 EUR *
DESIGN 11 AND ADDITIONAL	50 EUR	30 EUR	= 80 EUR	10 EUR *

## EUIPO formal examination - FEES

- **REGISTRATION fee**
- **PUBLICATION fee**
- **DEFERMENT fee** (*only in case of deferred publication*)
  
- Current account in EUIPO held by the applicant
- Transfer to a bank account held by EUIPO
  
- Credit card (only for applications by e-filing)



## **EUIPO formal examination – REPRESENTATION OF THE DESIGN**

## REPRESENTATION – means of representation and types of views

The representation can be photos, computer drawings or drawings by hand, in colour or BW.

Maximum *seven* different views per design.

- **Paper application form**
- **Electronic application**

*Image file format:* **JPEG format**, limited to a max. of **2Mb per view**. Only 1 image per electronic attachment.

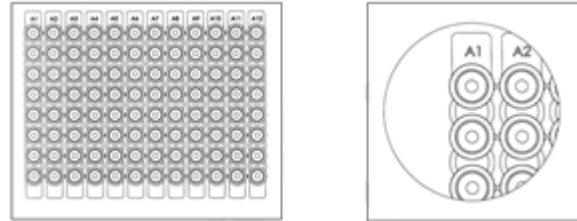
*3D dynamic image:* OBJ, STL, X3D format (max. 20Mb) for the extraction of static views.

## REPRESENTATION – types of views

Aspect views

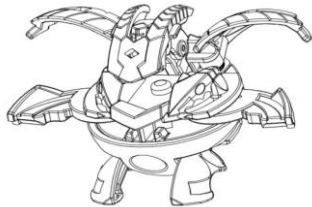
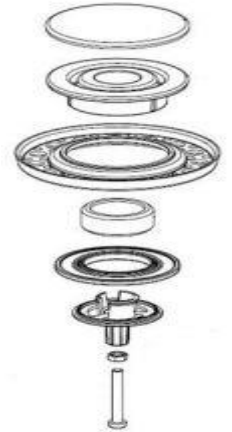


Views magnifying part of the design



Views showing alternate positions

Exploded views



## REPRESENTATION - types of views

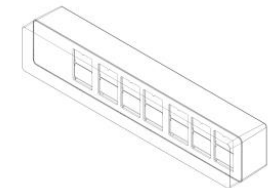
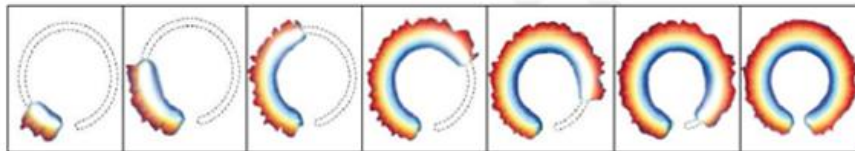
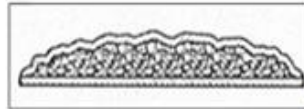
Partial views



Sectional views

Sequence of snapshots (animated designs)

Combination of different means of visual representation





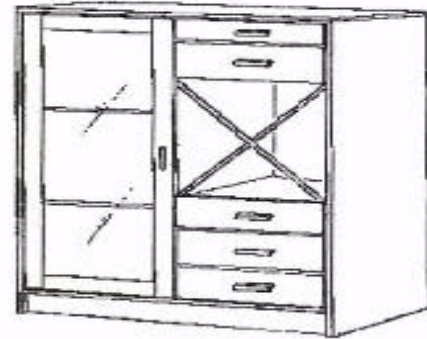
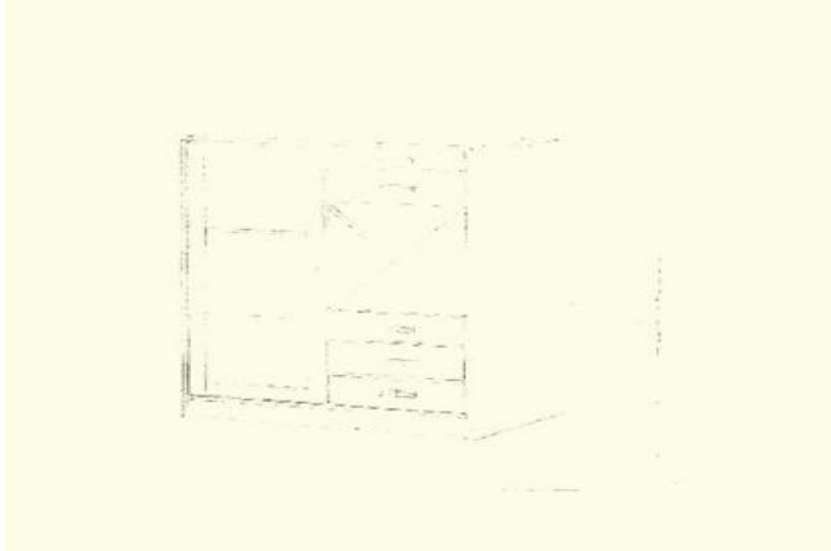
## EUIPO formal examination - REPRESENTATION

The representation of the design must be suitable for reproduction:

**Good quality** – all details of the design for which protection is sought should be visible

**Neutral background** – the design should be clearly identifiable in its environment

## REPRESENTATION – bad quality



## REPRESENTATION – (Non) neutral background



INDP: “Chair”



## REPRESENTATION – (Non) neutral background

Mast-Jägermeister SE vs. EUIPO



## REPRESENTATION – quality and (non) neutral background

**Filing date not granted**

If one of the conditions is not fulfilled a report is issued with 2 months deadline for the applicant to reply.

***Filing date:*** date of remedying the deficiency that caused the refusal of the filing date.

***If no remedy:*** the application is not dealt as Community design application - fees are reimbursed.

## **EUIPO formal examination – PRODUCT INDICATION**

## PRODUCT INDICATION

- Essential element for registration
- Does not affect the scope of protection
- Classification serves administrative purposes (fees and search)
- Applications must indicate product(s)
- One or more products may be indicated (unity of class requirements for multiple applications)

## PRODUCT INDICATION

The use of the Locarno alphabetical list will facilitate classification

Classes    Alphabetical    **Class And Subclass Headings**    General Remarks    Recommendations    Modifications    Search

### List of Classes and Subclasses with Explanatory Notes

#### Class 1

#### Foodstuffs

##### Note(s)

- a. Including foodstuffs for human beings, foodstuffs for animals and dietetic foods.
- b. Not including packages (Cl. 9).

01-01 BAKERS' PRODUCTS, BISCUITS, PASTRY, PASTA AND OTHER CEREAL PRODUCTS, CHOCOLATES, CONFECTIONERY, ICES

01-02 FRUIT, VEGETABLES AND PRODUCTS MADE FROM FRUITS AND VEGETABLES

01-03 CHEESES, BUTTER AND BUTTER SUBSTITUTES, OTHER DAIRY PRODUCE

01-04 BUTCHERS' MEAT (INCLUDING PORK PRODUCTS), FISH

01-05 TOFU AND TOFU PRODUCTS

01-06 ANIMAL FOODSTUFFS



## PRODUCT INDICATION



Correction of product  
indication

*“Sneakers”*

Change ex-officio to “Sports  
shoes” or “Trainers” 02-04

Correction of product indication

Set of: Add ex officio  
Furniture (set of-) 06-05



## PRODUCT INDICATION

Correction of product indication

Obvious mismatch



Lamps

Bulbs 26-04

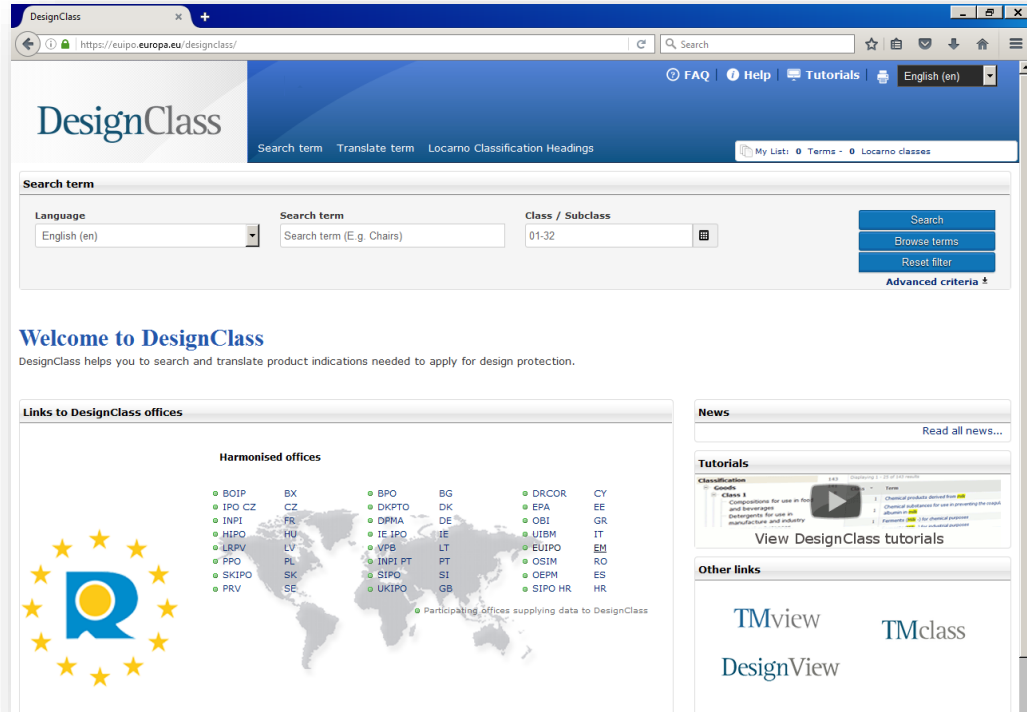


Bicycles

Motorcycles 12-11

# Designclass

<https://euipo.europa.eu/designclass/>



The screenshot shows the DesignClass website interface. At the top, there is a navigation bar with the DesignClass logo, search options, and language selection (English (en)). Below the navigation bar is a search form with fields for Language (English (en)), Search term (Search term (E.g. Chairs)), and Class / Subclass (01-32). There are buttons for Search, Browse terms, Reset filter, and Advanced criteria. The main content area features a "Welcome to DesignClass" section with a sub-header "DesignClass helps you to search and translate product indications needed to apply for design protection." Below this is a "Links to DesignClass offices" section, which includes a map of Europe and a list of participating offices. The right sidebar contains sections for "News" (Read all news...), "Tutorials" (View DesignClass tutorials), and "Other links" (TMview, DesignView, TMclass).

**Links to DesignClass offices**

Harmonised offices

• BOIP	• BX	• BPO	• BG	• DRCOR	• CY
• IPO CZ	• CZ	• DKPTO	• DK	• EPA	• EE
• INPI	• FR	• DPMA	• DE	• OBI	• GR
• HIPO	• HU	• IE IPO	• IE	• UIBM	• IT
• LRPV	• LV	• VFB	• LT	• EUIPO	• EM
• PPO	• PL	• INPI PT	• PT	• OSIM	• RO
• SKIPO	• SK	• SIPO	• SI	• OEPM	• ES
• PRV	• SE	• UKIPO	• GB	• SIPO HR	• HR

• Participating offices supplying data to DesignClass

**News**  
Read all news...

**Tutorials**  
View DesignClass tutorials

**Other links**  
TMview  
DesignView  
TMclass

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Definition of a design

Public policy and principles of morality

### 5. Registration,

### 6. Cancellation proceedings

## 4. EUIPO SUBSTANTIVE EXAMINATION

### GROUNDS FOR NON-REGISTRABILITY

- Not corresponding to the definition of “design”
- Against public policy and accepted principles of morality

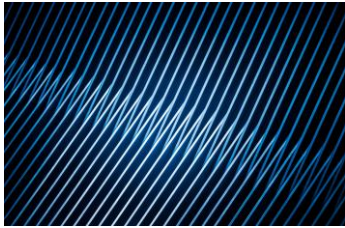
## EUIPO SUBSTANTIVE EXAMINATION

### **EUIPO does NOT examine (ex officio)**

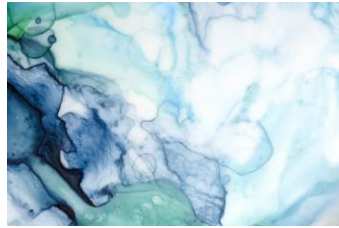
- Arts 4 to 8 CDR (novelty, individual character, visibility, technical function, interconnections)
- Relative grounds (conflicts with prior rights)
- Entitlement of the holder

## Definition of a design

**Design:** the appearance of the **whole or a part of a product** resulting from the features of, in particular, the



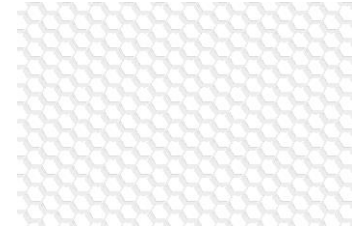
lines



colours



shape



texture



contours



materials

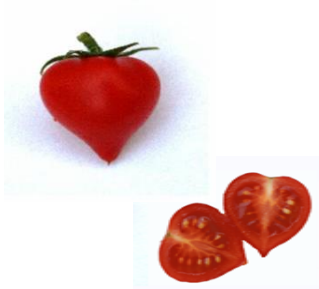


ornamentation





## No protection for



natural products,  
living organisms



colours per se

FLERGÅNGSFUKTSLUKAREN

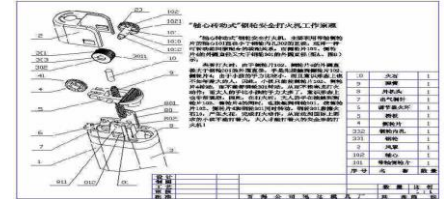
words



ideas, methods,  
processes



smells and fragrances



functions  
(patents)



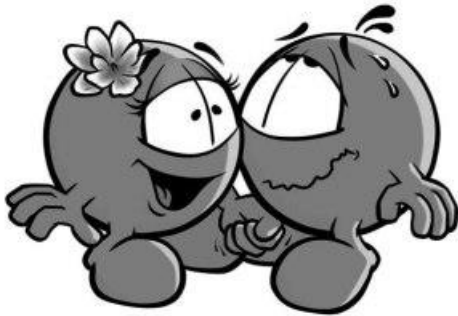
music and sounds

## Public policy and accepted principles of morality

- Racist images or messages, Nazi symbols and obscene or immoral images are not acceptable
- Flags and religious symbols are acceptable provided they are used in a proper and decent way
- Registering images of famous people without permission is not against public policy.



## Public policy and accepted principles of morality



**ACCEPTED**





**REJECTED**



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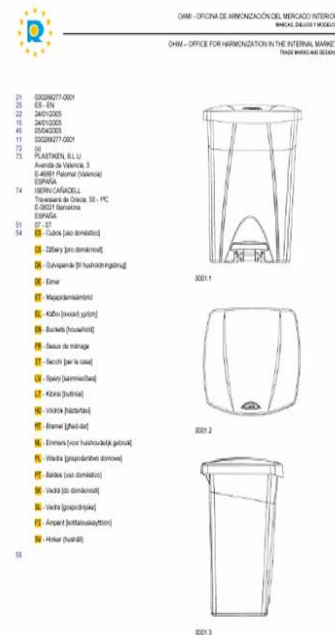
### Registration, Publication, Deferment

### Cancellation proceedings

## REGISTRATION, PUBLICATION, DEFERMENT

### Registration:

- Within 2 days of the filing date
- Electronic certificates
- Renewed in blocks of 5 years
- Maximum term of protection:  
25 years



## REGISTRATION, PUBLICATION, DEFERMENT

### Publication:

### Community Designs Bulletin

- daily publication
- only electronically

2011/250 001937301-0004

<b>21</b>	001937301-0004
<b>25</b>	PL EN
<b>22</b>	25/10/2011
<b>15</b>	25/10/2011
<b>45</b>	03/11/2011
<b>11</b>	001937301-0004
<b>73</b>	Fabryka Mebli Tapicerowanych Tombea Sp. z o.o. ul. Owocowa 4, Łowęcin 62-020 Swarzędz POLONIA
<b>74</b>	KANCELARIA PATENTOWA PATENTBOX ROMUALD SUSZCZEWIC ul. Piekary 6/17 61-823 Poznań POLONIA
<b>51</b>	06 - 01
<b>54</b>	BG - Мебели за сядане ES - Muebles de asiento CS - Sedací nábytek DA - Sæddemøbler DE - Sitzmöbel ET - Istmed EL - Καθίσματα EN - Seating furniture FR - Meubles pour s'asseoir IT - Mobili per sedere LV - Mēbeles sēdēšana LT - Sėdimieji baldai HU - Űlőbűtorok MT - Għamara biex wiehed joqghod bilqiegħda NL - Zitmeubilair PL - Meble do siedzenia PT - Mobiliário de assento RO - Mobilier pentru șezut SK - Nábytok na sedenie SL - Sedežno pohištvo FI - Istuinkalusteet SV - Sittmöbler





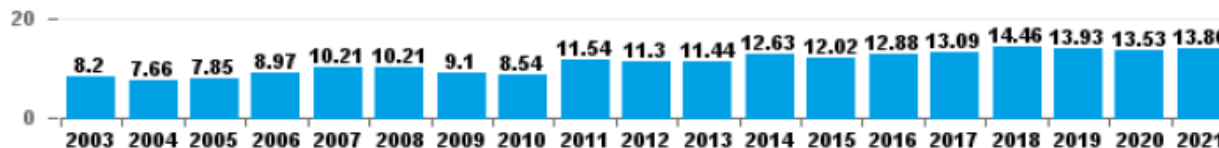
## REGISTRATION, PUBLICATION, DEFERMENT

- **DEFERMENT:** delay of the publication of a design for a period up to 30 months from the date of filing/priority, at the request of the applicant.
- Deferment can be requested only at the time of filing.
- An extra fee has to be paid for deferment.

2005/045 000317557-0001

21	000317557-0001
22	01/04/2005
15	01/04/2005
11	000317557-0001
73	Bang & Olufsen Holding A/S Peter Bangs Vej 15 DK-7600 Struer DINAMARCA
74	SANDEL, LØJE & WALLBERG Frederiksgade 7 DK-1265 København K DINAMARCA

The percentage of deferred publications



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### Novelty and individual character

**A Community design may be declared invalid if the design does not fulfil the requirements of Articles 4 to 9**

Article 4  
Requirements for protection

1. A design shall be protected by a Community design to the extent that it is new and has individual character.

## Different tests

### NOVELTY

**Objective test (matter-of-fact):**

**Does there exist, in the relevant prior art  
an identical design?**

**The later design:**

- exactly reproduced, or
- different only in immaterial details

**(insignificant  
details which  
may pass  
unnoticed)**



Decision of 28/07/2009, R 921/2008-3, 'Nail files'  
(left: contested RCD, right: examples from the state of the art)

### INDIVIDUAL CHARACTER

**Perception of the informed user:**

**Does there exist, in the relevant prior art, a design  
which does not differ in the overall impression?**

**Factors affecting perception of the informed user:**

- designer's freedom & technical features due to the purpose, function and nature of some types of products
- design corpus & saturation of the market
- visibility of some features during the normal use
- banal and common features to some types of products

## Disclosure

The RCD is protected to the extent it is new & has individual character (Article 4 CDR) over any design made available to the public prior to the RCD's filing or priority date

- design = the appearance of the whole or a part of a product
- made available to the public = any disclosure unless the holder proves that it could not have reasonably become known in the normal course of business
- the public = circles specialised in the sector concerned, operating within the Community (EU)

## Priority

## Grace period

## Matters excluded from the novelty & individual character tests

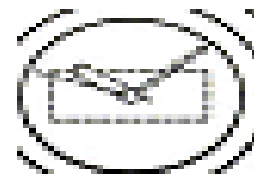
Invisible features of parts of complex products (Article 4(2) CDR)

Features solely dictated by technical function (Article 8(1) CDR)

Features of interconnections (Article 8(2) CDR)

Features not discernible (or clearly discernible) from the registration (Recital 11 DD and decision of 10/03/2008, R 0586/2007-3, Barbecues, § 23 26)

Features for which the protection is not sought and they are disclaimed in the RCD representation (judgment of 14/06/2011, T 68/10, 'Watches', § 59 64)



Judgment of 14/06/2011, T-68/10, „Watch attached to a lanyard“ (left: contested RCD and detail of disclaimed watch dial and hands, right: a prior design)

## Not new



Decision of 24/09/2018, ICD 101 839, Logos  
left: contested RCD, right: prior design disclosed following a trade mark registration

Since the contested design reproduces all the characteristic features of the prior design and its features differ only immaterially, the designs must be deemed to be identical within the meaning of Article 5(2) CDR.

## Not new



Decision of 23/11/2018, ICD 101 499, Keyboards  
left: contested RCD, right: prior design

In the present case, the Community design, as registered, seeks protection for the shape of the keyboard and its layout, without revealing a particular colour, material or key description. The absence of these features in the RCD is therefore not a new aspect conferring novelty on the design.

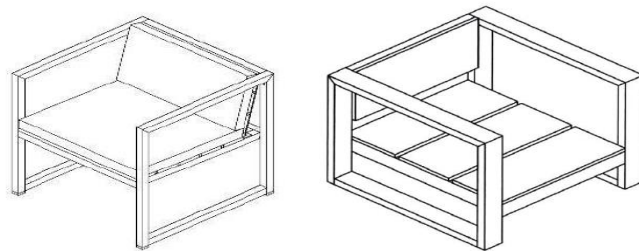


## INDIVIDUAL CHARACTER assessment

- 1. What is the sector to which the products related to the designs belongs?**
- 2. Who is the informed user of those products in accordance with their purpose? What is their degree of awareness of the prior art and the level of attention?**
- 3. What is the designer's degree of freedom in developing his/her design (Art. 6(2) CDR)?**
- 4. Comparison of the designs at issue, taking into account the sector in question, the designer's degree of freedom and the overall impression produced on the informed user by the contested design and by any earlier design which has been made available to the public.**

## Comparison of designs is not an imperfect recollection test

When the nature of the product in which the compared designs are incorporated makes it possible, the overall impression left by these designs will be assessed on the assumption that the informed user can make a direct comparison between them (judgment of 18/10/2012, joint cases C 101/11 P and C 102/11 P, Ornamentation, § 54-55).



Decision of 25/05/12, R 970/2011-3, Armchairs

left: contested RCD, right: prior design

Different overall impression

## The same overall impression



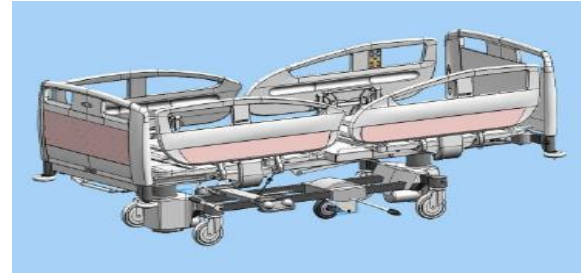
Decision of 15/01/2014, R 2232/2011-3, Shoes  
left: contested RCD, right: prior design

## Different overall impression



Decision of 04/01/2016, R 2298/2014-3, Boots  
left: contested RCD, right: prior design

## Different overall impression



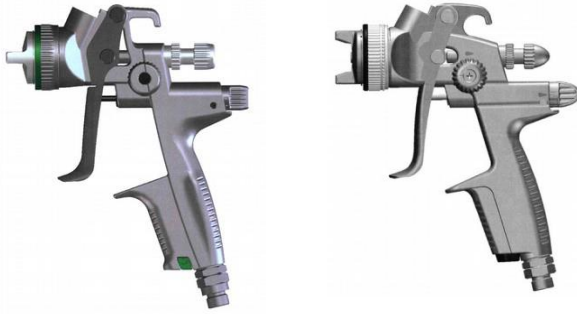
Decision of 17/12/2014, R 2091/2012-3, Nursing beds  
left: contested RCD, right: prior design

## The same overall impression



Decision of 13/05/2015, R 915/2013-3, Furniture legs  
left: contested RCD, right: prior design

## The same overall impression



Decision of 12/07/2017, R 914/2016-3, Spray guns for paint  
 left: contested RCD, right: prior design; on the right side examples from the market



Due to his knowledge of existing paint spray guns, the informed user is aware of the essential components a paint spray gun must possess and of the limitations of the design freedom in that respect.

The individual character of a design results from a different overall impression from the viewpoint of the informed user with reference to the existing design corpus taking into account the differences which are sufficiently pronounced to produce a different overall impression and discarding the differences which do not affect the overall impression.

## The same overall impression



Decision of 19/01/2018, R 945/2016-3, Kraftfahrzeuge  
2 left: contested RCD, 2 right: prior design

It is obvious that the vehicle pursuant to D1 shows a predecessor model of the contested CD, with the parties also being in agreement on this point.

The proprietor's reference to the unique design history of the Porsche 911 and the differences between the 997 series and 991 series, as they appear on the various images submitted by the former, does nothing to change this outcome. What needs to be assessed is the individual character of the contested CD on the basis of the views submitted.

It is true that the informed user is aware that vehicle models already launched on the market are regularly modernised in terms of their appearance, in order to accommodate for subsequent technical developments, on the one hand, and ever changing contemporary tastes, on the other.





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**THANK YOU**