



A GUIDE TO DESIGN REGISTRATION

REBECCA SANTANA DAVIES | 26 FEBRUARY 2021



CARIFORUM



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

www.caripi-hub.com

OVER 100.000 RCDS IN 2020

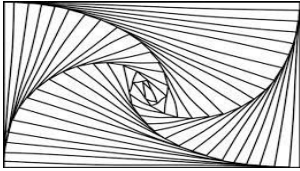


DOES YOUR DESIGN QUALIFY FOR REGISTRATION?

- THERE HAS TO BE A PRODUCT OR PART OF A PRODUCT
- COLOURS, VERBAL ELEMENTS AND SOUNDS **DO NOT QUALIFY** AS THEY DO NOT CONSTITUTE THE APPEARANCE OF A PRODUCT.
- LIVING ORGANISMS AND CONCEPTS **DO NOT QUALIFY** EITHER, FOR THE SAME REASON
- YOUR DESIGN SHOULD RESPECT PUBLIC POLICY AND (CERTAIN) MORALITY STANDARDS

What is a design? Article 3(a) CDR

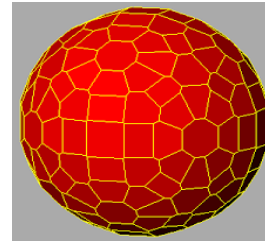
Design: the appearance of the whole or a part of a **product** resulting from the features of, in particular ...



lines



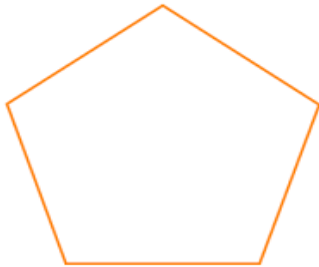
colours



shape



texture



contours



materials



ornamentation

What is a product? Article 3(b) CDR

... any industrial or handicraft item, including inter alia:

- Parts assembled into a complex product
- Packaging
- Get-up
- Graphic symbols
- Typographic typefaces

Excluded: “Computer programs”

Get-ups (32-00)



Foodstuffs(class 1)





Packaging and Get-up

caripi
Intellectual
Property Rights &
Innovation

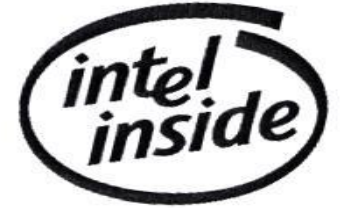


Logos (32-00)

ROHTO



City of
Manchester
Stadium

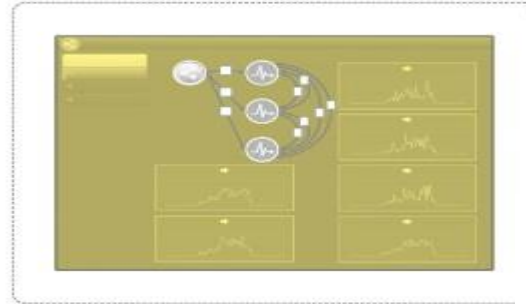


SOLE

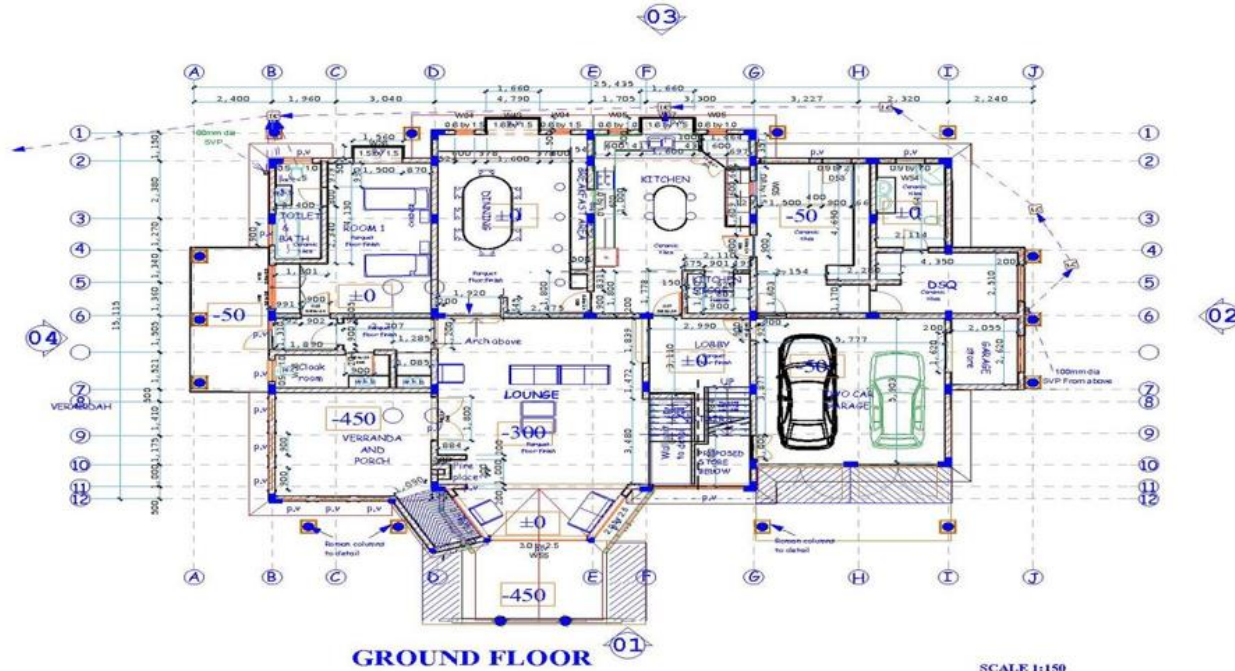
Dove



Animated graphical user interfaces (example: 3 views of the same design)



Plans, Blueprints (printed matter)



Plans, houses



House
Class 25-03

TYPOGRAPHIC TYPEFACES

Provisions of Article 4(4) CDIR for “*typographic typefaces*” 18-03

- All the letters of the alphabet in upper and lower case
- All the Arabic numerals
- A text of 5 lines produced using that typeface
- When only the text is missing the applicant can add it maintaining the original indication and filing date.
- If any of the other elements is missing the applicant can only change the indication to “Set of characters” in class 18-03, so that the requisites for typographic typefaces do not apply.

Type and typefaces
Typefaces
Type font
Alphabets

TYPOGRAPHIC TYPEFACES

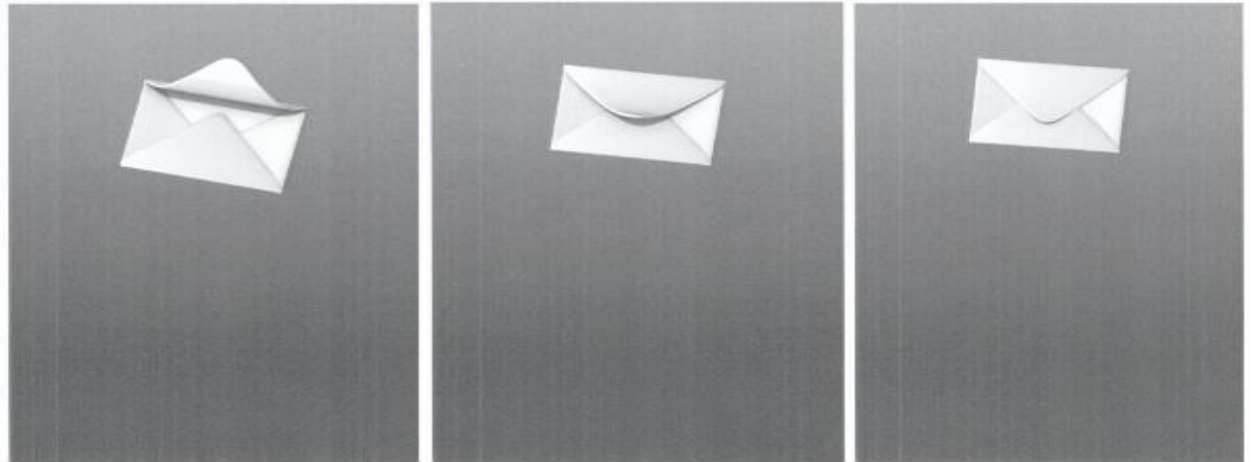
**a b c d e f g h i j k l m n o p q r s t u v w x y z A B C D
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**Stencil Moonlight LT Std Regular 42645 . Bei jeder
 Schriftgestaltung wird der Grundcharakter eines Al-
 phabets von einheitlichen Formmerkmalen der Buch-
 staben bestimmt. Bei jeder Schriftgestaltung wird der
 Grundcharakter eines Alphabets von einheitlichen**

ANIMATION

CLASS 14-04

- Graphical user interfaces
- Websites
- Animated displays
- Animated icons
- Animated images
- Animated characters

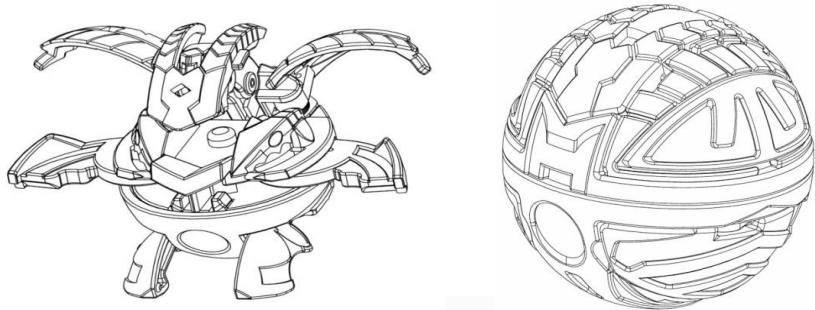


ANIMATION

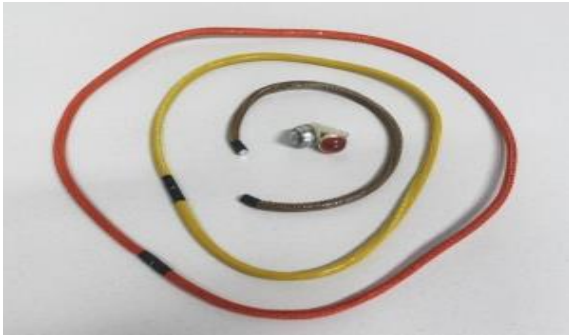


On-screen Language
Primary Audio
Secondary Audio
Subtitles
Hard of Hearing
Primary Subtitles
Secondary Subtitles

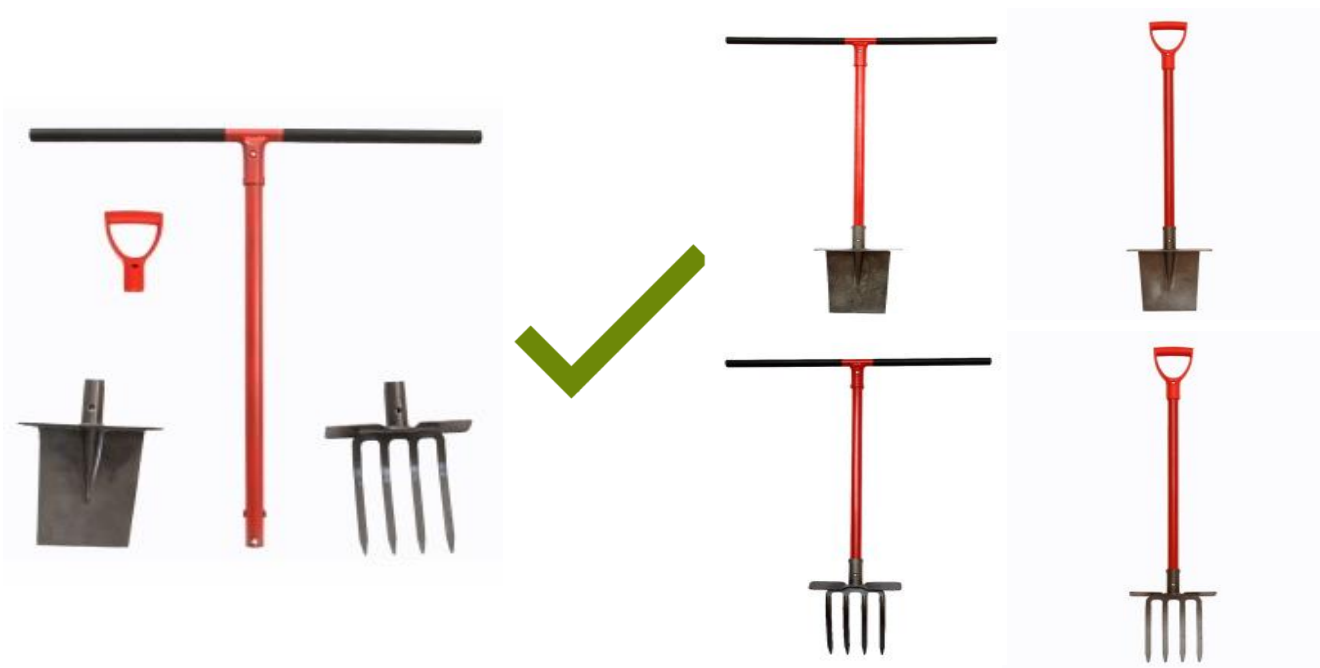
TRANSFORMABLE PRODUCTS



INTERCHANGEABLE PRODUCTS



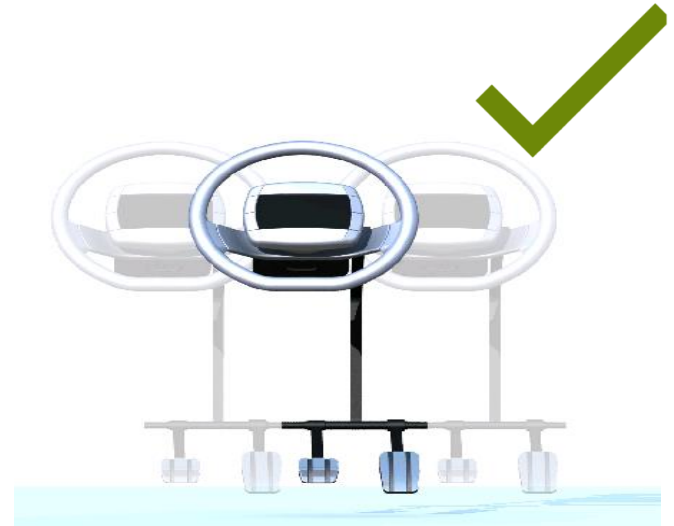
INTERCHANGEABLE PRODUCTS



REFLECTIONS

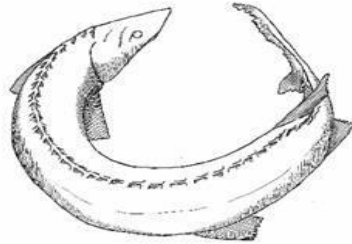


MOVEMENT



What isn't a design?

- Natural products, living organisms
- Words or sequences of letters without any figurative element
- Ideas, methods, processes
- Functions (patents)
- Colours per se
- Smells and fragrances
- Music and sounds



...do not constitute the appearance of a product and therefore do not comply with the definition of a design.



ROUTE TO REGISTRATION



CARIFORUM



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www.caripi-hub.com

WHO CAN FILE?

Any natural or legal person without any restrictions as to nationality or state of incorporation.

However:

If the applicant is not from the European Economic Area (EEA) a representative is required in further proceedings.

HOW TO FILE?

- DIRECT FILING WITH EUIPO.
- INDIRECT FILING WITH NATIONAL OFFICE.
- INTERNATIONAL REGISTRATION WITH WIPO DESIGNATING THE EU.

HOW TO FILE?

■ DIRECT FILING WITH EUIPO.

- e filing (electronic application) ~99%
- Post
- Hand delivery

e-filing 



When it is through any IP National Office of the EU (filing date = the date of receipt at the national office)

MULTIPLE APPLICATIONS

What are they?

The route to register more than one design within the same application.

Any requirements?

- All designs within a multiple application must have the **same owner(s) and the same representative(s)**.
- **All products** that are indicated for each and every design of a multiple application must **belong to the same class of the Locarno Classification**.

MULTIPLE APPLICATIONS: Article 37 CDR

Features:

- No limit for number of designs
- Cheaper for the applicant
- Each design included in the multiple application will have its own independent life (deferred, rejected, declared invalid, surrendered, renewed...)

Champion: Rieker Schuh AG, RCD 1381180: 552 designs (“Footwear”)

FEES

	REGISTRATION	PUBLICATION		DEFERMENT OF PUBLICATION*
1 ST DESIGN	230 EUR	+120 EUR	=350 EUR	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*

FEES

When to pay these?

All necessary fees relating to an application must be paid **at the time when the application is submitted** to the Office.

FEES

Fees are refunded when the application is withdrawn or refused **without a filing date having been granted.**

The Office also refunds amounts paid that are insufficient to cover the registration and publication (or deferment) fees for the design or at least one design of a multiple application.

DEFERMENT

REQUEST FOR DEFERMENT

- 30 Months from the date of filing or from the date of priority.
- **Request must be submitted together with the application.**
- Deferment fee.
- Publication fee may be paid later.

	REGISTRATION	PUBLICATION		DEFERMENT OF PUBLICATION*
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DESIGNS 2 TO 10	115 EUR	60 EUR	=175 EUR	20 EUR*
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IS YOUR DESIGN NEW? WHERE TO SEARCH?

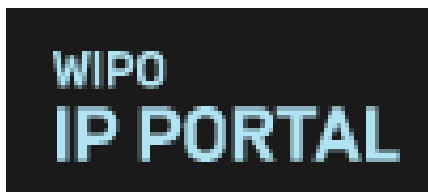
Registered Design:



..... EUIPO database



..... EUIPO + national Registries



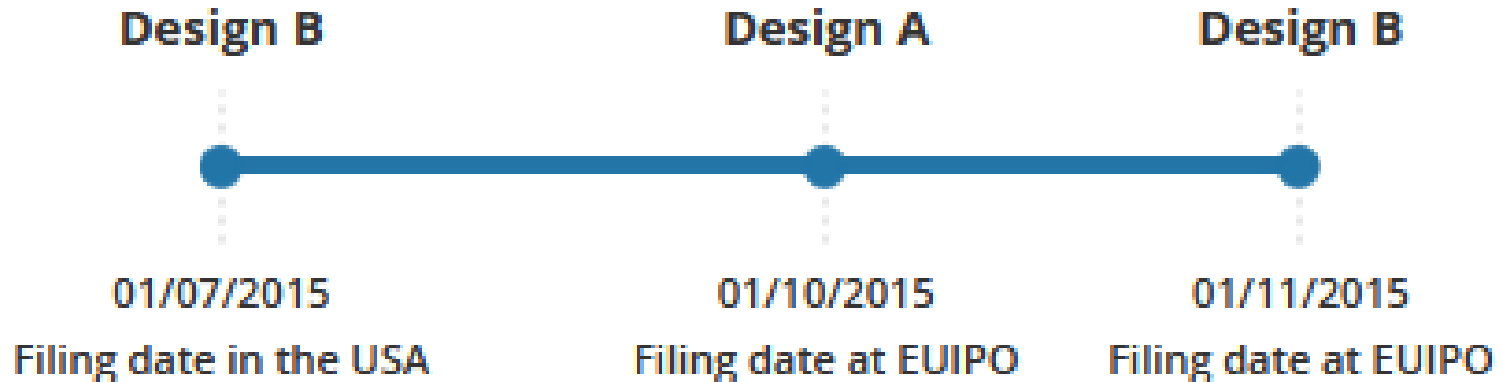
..... Global Design Database

WHAT IS PRIORITY RIGHT?

- Anyone who has filed a design application
- in any country that is party to the Paris Convention for the Protection of Industrial Property or to the Agreement establishing the World Trade Organization
- **may claim priority by using their design application as a basis for an RCD application.**

WHAT IS PRIORITY RIGHT?

In this example, the proprietor of design B can apply for design A to be declared invalid, even if in 'time-related' terms, design A was the first design to be applied for in the EU.



SUBMITTING A PRIORITY CLAIM

Examination stage: Only formal requirements

- Previous application not more than **6 months** ago.
- Priority claim **within 1 month** of the filing date.
- **File number, filing date and country of previous application** must be indicated.
- Complete copy of priority documents within 3 months, if necessary translated.
- Published as 'claimed'.

WHAT IS EXAMINED?

- **Request** for design registration
- Information identifying the **applicant**
- **Representation** of the design suitable for reproduction (Art. 4(1)CDIR):
 - **Good quality**
 - **Neutral background**
- **Compliance with the definition of a design**
- **Public policy & accepted principles of morality**

Public policy and 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.

WHAT IS EXAMINED? (Formalities)

- The representation can be photos, computer drawings or drawings by hand, in colour or BW.
- Maximum seven (7) different views per design.

Paper application

- The design must be reproduced on opaque white paper sheet A4 size, either pasted or printed directly on it
- The space used for the reproduction must be no larger than 26.2cmx17cm with a margin of 2.5cm on the left-hand side

Electronic application

- Image file format: **JPEG format**, limited to a maximum of 5Mb
- **Only 1 image** per electronic attachment

WHAT IS NOT EXAMINED?

- **Absolute requirements** (novelty, individual character, visibility, technical function, designs of interconnections).
- **Earlier rights** (conflict with a prior design right, unauthorised use of an earlier distinctive sign in the design, unauthorised use of the copyright or improper use of items listed in Art. 6ter of the Paris Convention or other emblems of public interest in a Member State).
- Whether the applicant is **entitled to the design**.



QUALITY OF THE REPRESENTATION

All details of the design for which protection is sought should be visible.

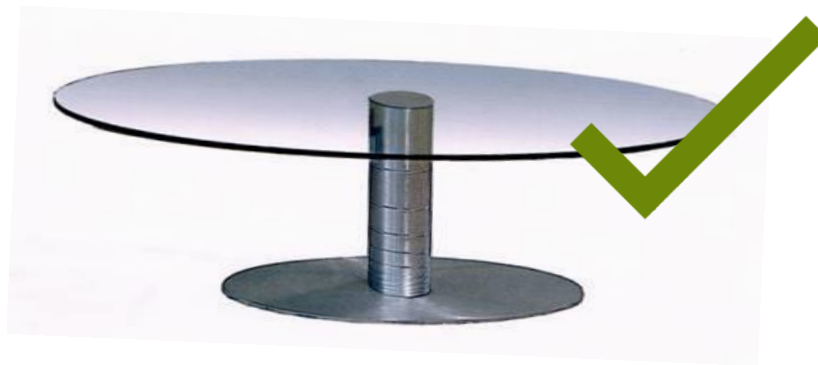
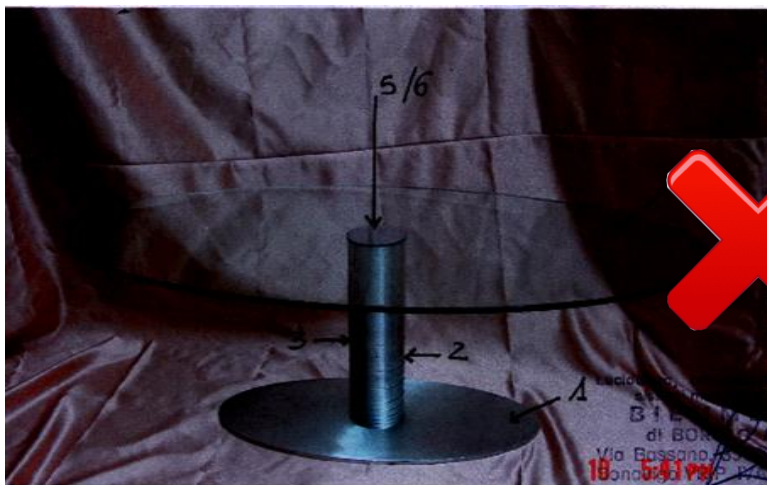


QUALITY OF THE REPRESENTATION

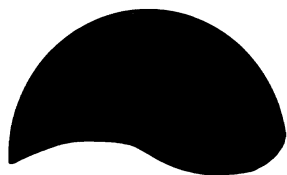
All details of the design for which protection is sought should be visible.



QUALITY OF THE REPRESENTATION



QUALITY OF THE REPRESENTATION



NEUTRAL BACKGROUND

What is neutral background?

'The background in a view is considered neutral as long as the design shown in this view is clearly distinguishable from its environment without interference of any other object, accessory or decoration, whose inclusion in the representation could cast doubt on the protection sought'.

(Decision of 25 April 2012, R 2230/2011-3 – *Webcams*, para. 11-12).

'In other words, the requirement of a neutral background neither demands a 'neutral' colour nor an 'empty' background. It is instead decisive that the design stands out so clearly from the background that it remains identifiable'.

(Decision of 25 January 2012, R 284/2011-3 – *Tool chest*, para. 13).



NEUTRAL BACKGROUND

Jägermeister

General Court

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=187688&pageIndex=0&doclang=en&mode=req&dir=&occ=first&part=1&cid=856363>

Court of Justice

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=203609&pageIndex=0&doclang=EN&mode=req&dir=&occ=first&part=1&cid=494293>

NEUTRAL BACKGROUND

RCD 2238071
INDP: Drying Racks



NEUTRAL BACKGROUND



RCD 2067900-0001
INDP: "Vendors' carts"

NEUTRAL BACKGROUND

RCD 2513598

INDP: “Luggage carriers for cycles”



RCD 1792623

INDP: “Balustrades”

What corrections are allowed?

NOT ALLOWED:

Substitution of the applicant(s) with other natural or legal person(s)

Addition or withdrawal of views

Replacement of original views

Replacement of BW views with the same ones in colour and vice-versa

Addition of an overall view in case of a set of articles or a complex product where that overall view was not included originally in the application

Late request for deferment

Exceptions:

Replacement of views /addition of new views is allowed in case of deficiencies where no filing date is granted (bad quality/not neutral background...)

Addition of an assembled view if it has not been filed together with an exploded view

Withdrawal of views in order to remedy deficiencies

NO FILING DATE

If all the views of the design are of bad quality or reproduced on not neutral background:

The applicant must replace the views with new ones / modify the views (in case of background)

Filing date = the date when the new/modified views are received

If some of the views of the design are of bad quality or reproduced on not neutral background:

The applicant can replace the deficient views with new ones/ modify the views (in case of background)

Filing date = the date when the new/modified views are received

or

Withdraw the deficient views and maintain the original date of filing but only for the correct views

If no response to the deficiency letter:

Design is refused (Final Status: *“Not to be dealt as a Community Design”*)

Fees are refunded

Changes AFTER registration

Art. 12.2 CDIR

“Only the name and address of the applicant, errors of wording or of copying, or obvious mistakes may be corrected, **at the request of the applicant** and **provided that such a correction does not change the representation of the design**”.

- ✓ the name of the designer or team of designers;
- ✓ errors attributable to the Office
- ✓ partial surrender

Partial surrender

A registered Community design may be partially surrendered provided that its amended form complies with the requirements for protection and the identity of the design is retained (Article 51(3) CDR).

Partial surrender will therefore be limited to cases in which the features removed or disclaimed do not contribute to the novelty or individual character of a Community design, in particular:

- **where the removed or disclaimed features are so insignificant in view of their size or importance that they are likely to go unnoticed by the informed user.**



How to indicate I do not want protection for certain features of my design?

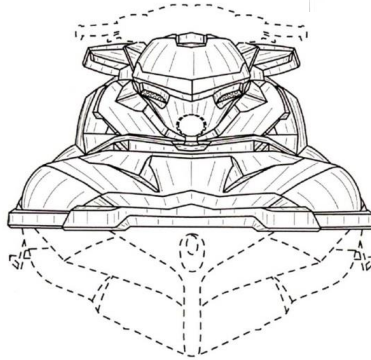
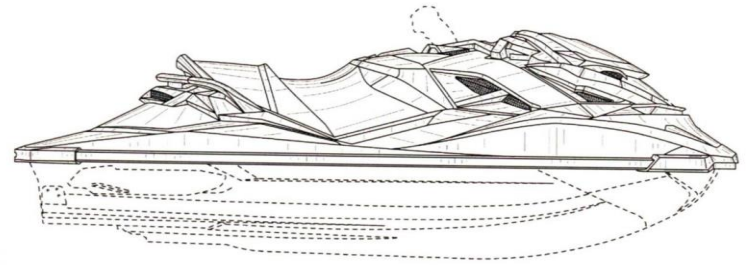
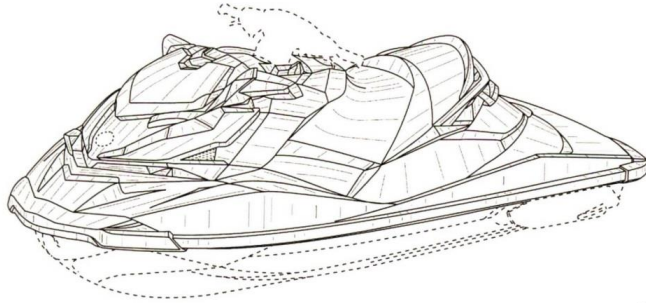
***Visual disclaimers** indicate that protection is not being sought for, and registration has not been granted for, certain features of the design shown in the representation. Thus, they indicate what is not intended to be protected.*

Requirements of disclaimers:

Visual disclaimers will only be accepted when:

- They **clearly indicate** that protection is not being sought for certain features of the design shown in the representation.
- They are **shown consistently** in all the views where the disclaimer appears.

Broken lines



Shading



Boundaries



REPRESENTATION OF THE DESIGN

Other requirements

- All views must show the **same design/product**
- All views must show the **same colour**
- **Only 1 view per electronic attachment**
- Views should not contain **explanatory text, wording, numbers or symbols**
- **Detail views of portions** of the design should not be shown together with the design in the same view

REPRESENTATION OF THE DESIGN

(Other requirements)

- **Set of articles** & **complex products** must contain in the representation a global view of the design
- **Exploded views** must be filed together with the assembled view
- **Typefaces** must contain all the capital and small letters of the alphabet, Arabic numerals and a text of 5 lines written in that typeface
- **Disclaimers** are acceptable provided they are shown on the views

ONE DESIGN?



ONE DESIGN?



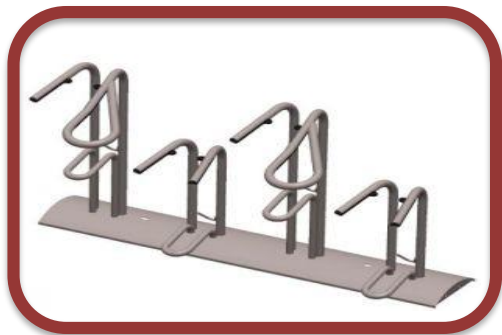
ONE DESIGN?



ONE DESIGN?



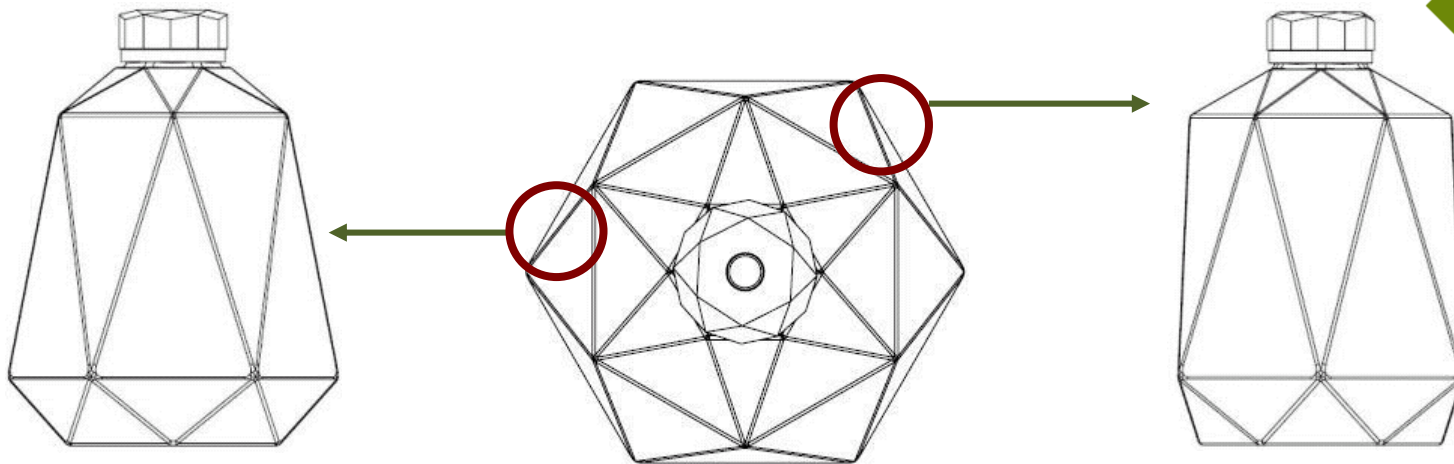
ONE DESIGN?



ONE DESIGN?



ONE DESIGN?

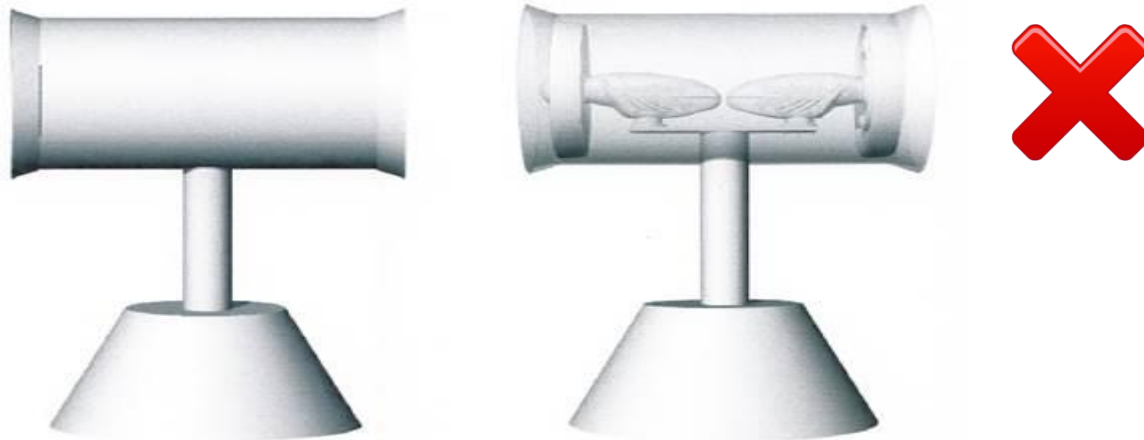


ONE DESIGN?



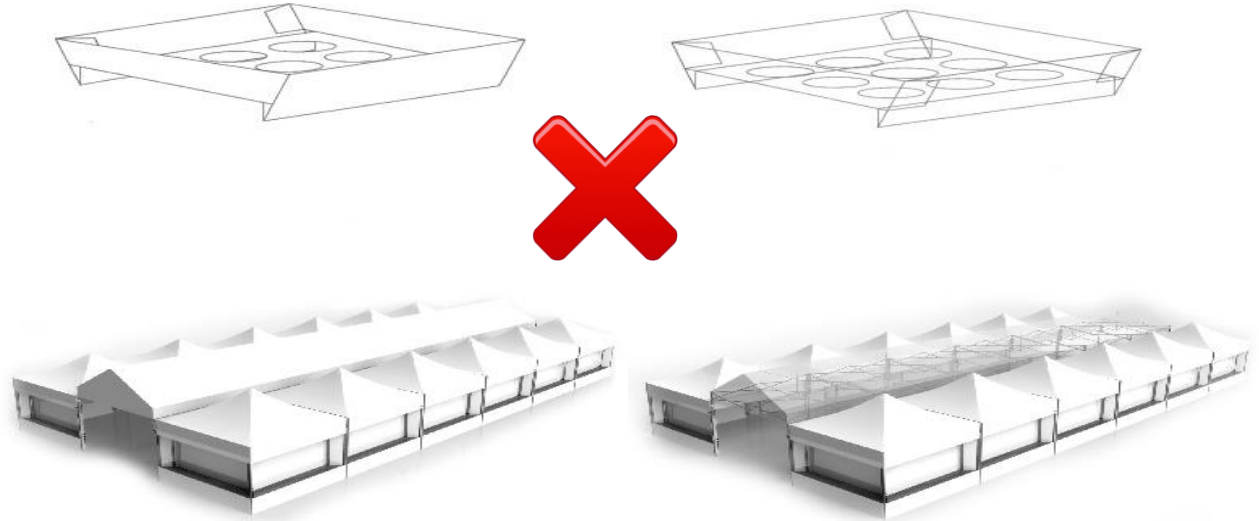
ONE DESIGN?

Transparent version = Different design



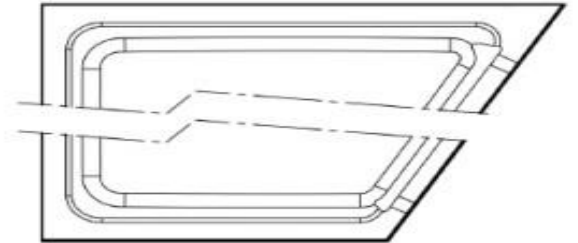
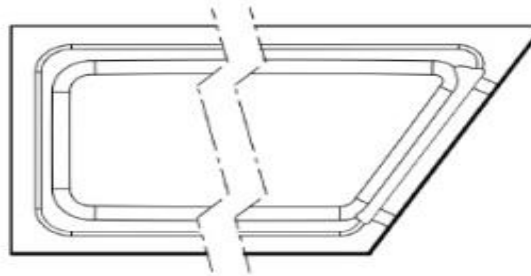
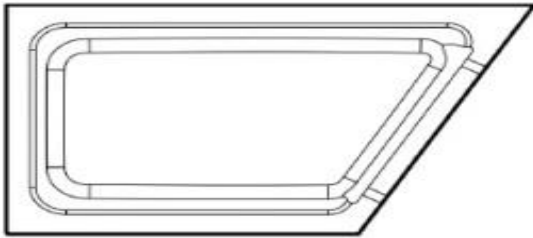
ONE DESIGN?

Transparent version = Different design



Separation lines

Separations can be used to indicate that, for ease of illustration, the precise dimension of the design is not claimed (indeterminate length).



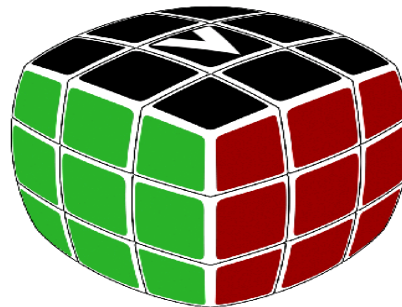
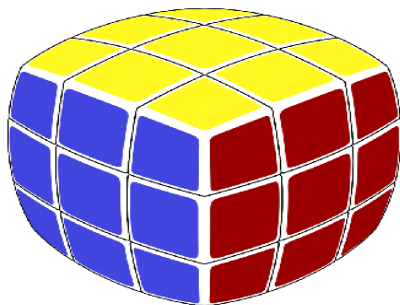
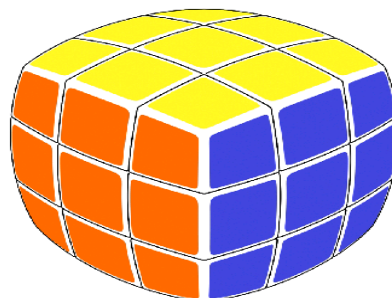
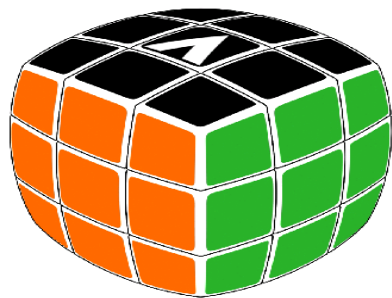
Views in colour?

Views of the same product showing different colours do not relate to the same design.

Art 3(a)CDR: *“Design is the appearance of a product resulting from the features of, among others, its colours ...”*



DIFFERENT COLOURS?



B&W + Colour

Colour views CANNOT be combined with BW views



Combinations of shades of grey

... is a deficiency only in case of photos, not in case of drawings.



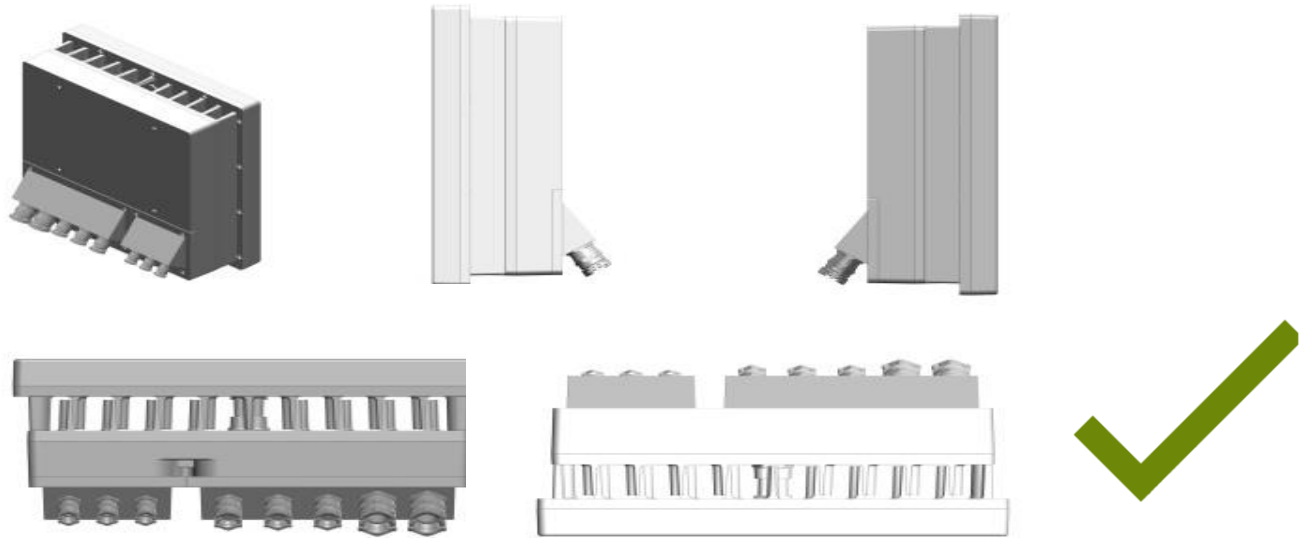
Combinations of shades of grey

When comparing drawings or photo and drawing the difference in grey shades is not important

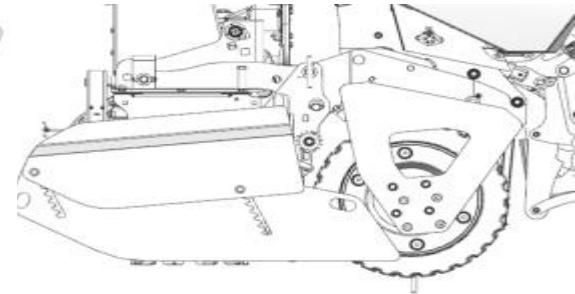
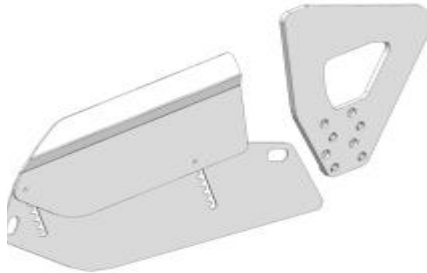
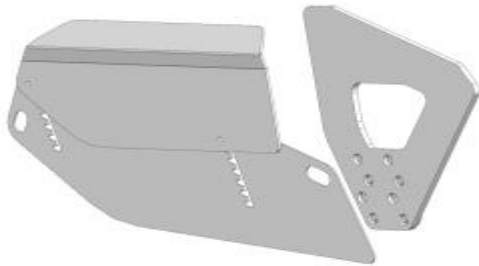
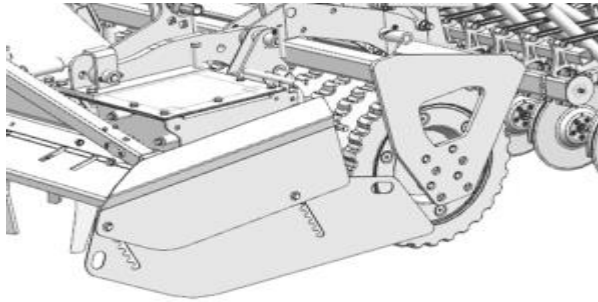
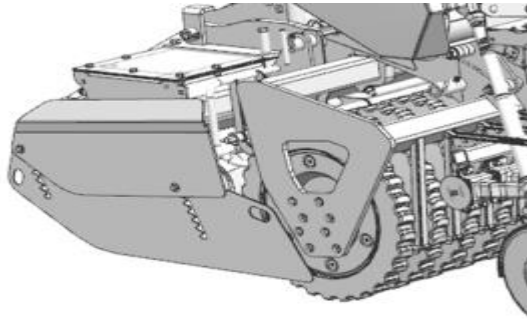


DIFFERENT COLOURS?

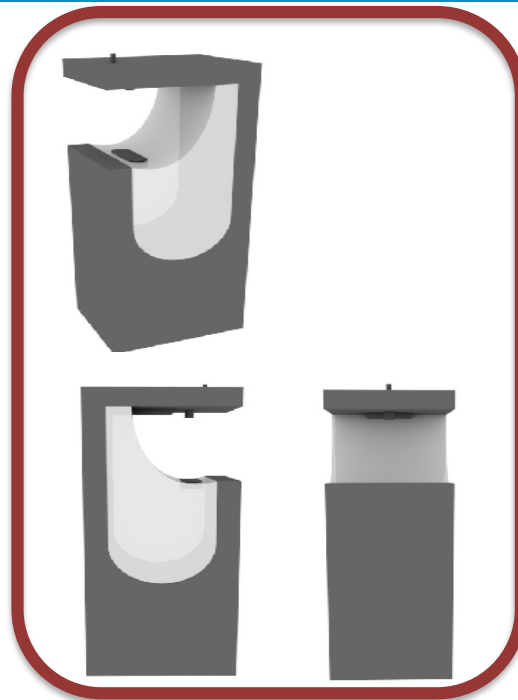
When comparing computer drawings the difference in grey shades is not important



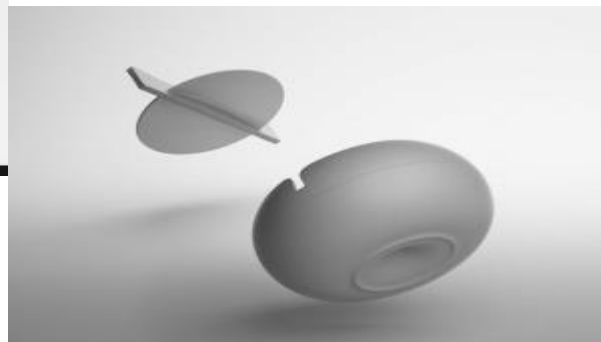
DIFFERENT COLOURS?



DIFFERENT COLOURS?



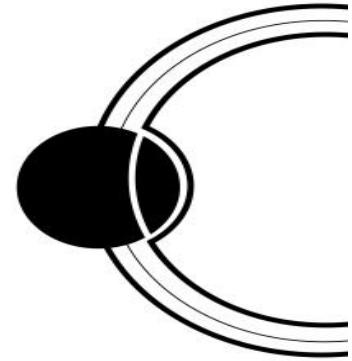
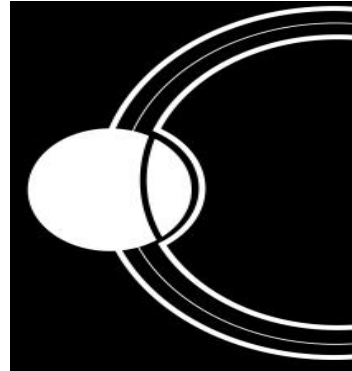
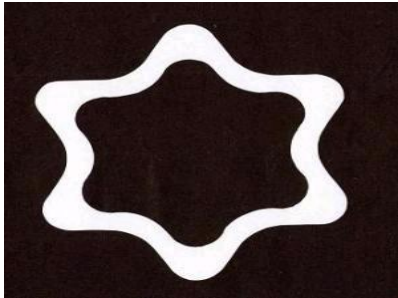
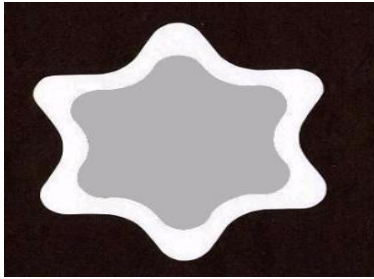
Light effect



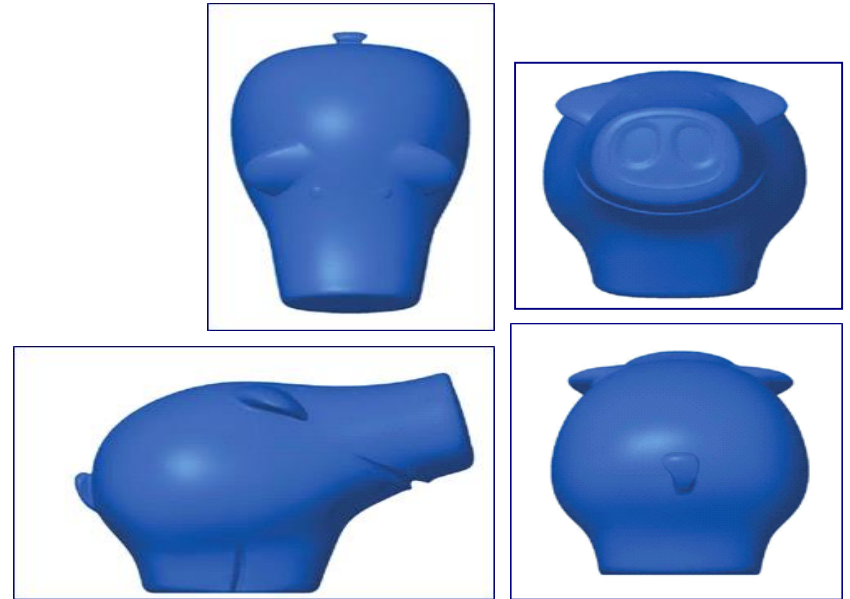
Is that a light effect?



Positive - negative

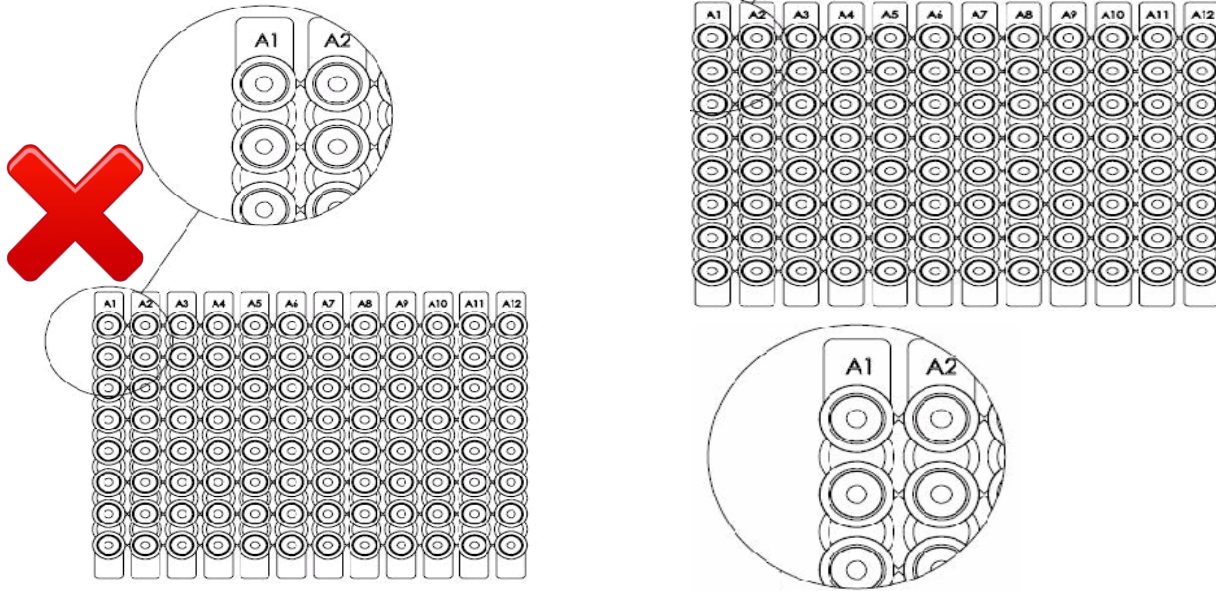


ONLY 1 VIEW PER ELECTRONIC ATTACHMENT



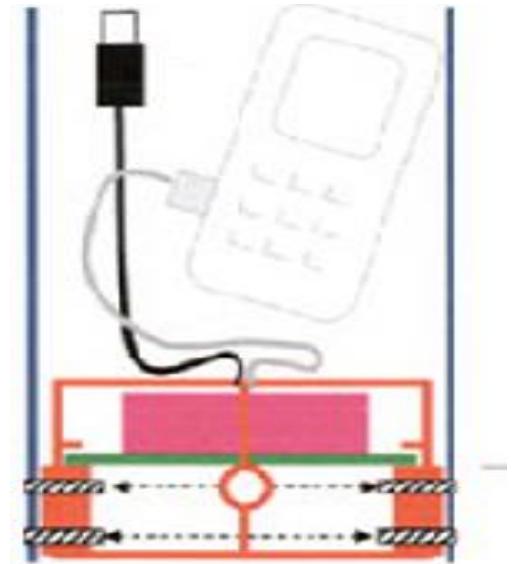
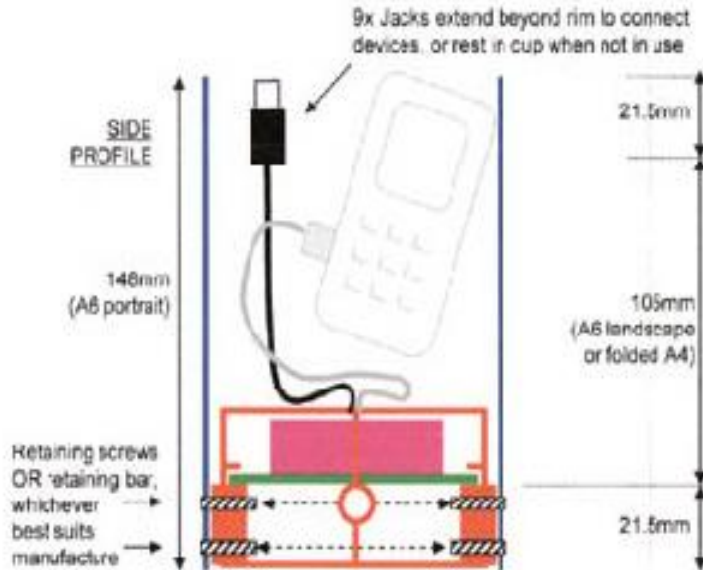
DETAILS VIEWS

Detail views of portions of the design cannot be included in the same view

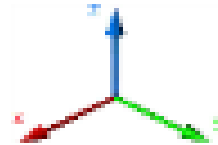
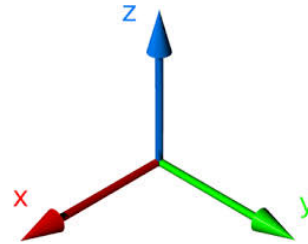
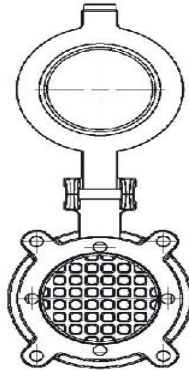
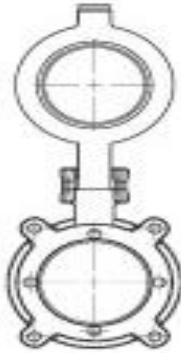


EXPLANATORY ELEMENTS

Views should not contain explanatory text, wording, numbers or symbols



SYMMETRY LINES, AXES XYZ



SET OF ARTICLES

A set of articles is accepted as one design, provided the articles making up the set are linked by **aesthetic and functional complementarity** and are, in normal circumstances, sold altogether as **one single product**.

It should be clear that the **protection** is sought for a design resulting from the **combination of the articles**.

At least one view must show the set of articles together.



SET OF ARTICLES

If the overall view is missing the applicant is requested to **divide** the design into separate designs for each article and pay the corresponding fees **or** **withdraw** the application and **file** again including the overall view



SET OF ARTICLES

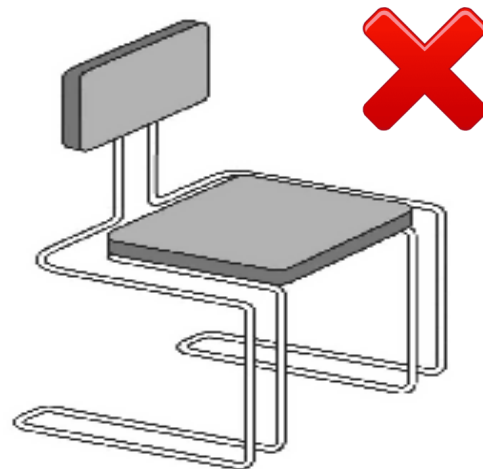
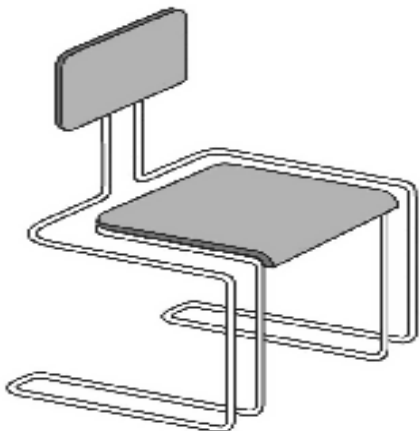


SET OF ARTICLES



SET OF ARTICLES OR DIFFERENT EMBODIMENTS (VARIATIONS)?

Sets of products should also not be confused with **variations of a design**. The different embodiments of a same concept cannot be grouped in a single application because each embodiment is a design on its own.



SET OF ARTICLES OR DIFFERENT EMBODIMENTS (VARIATIONS)?

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SET OF ARTICLES?



Complex products

A complex product is a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

At least one view must show the complete product.

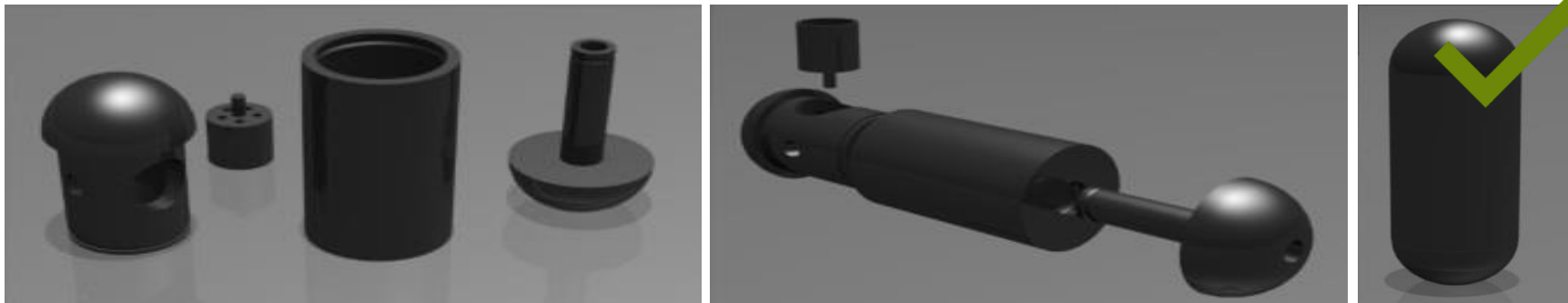


EXPLODED VIEWS

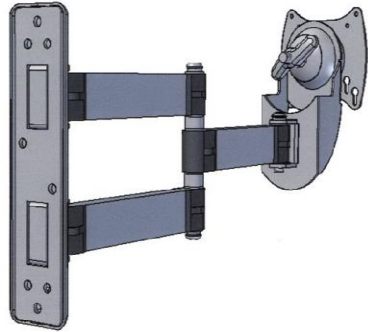
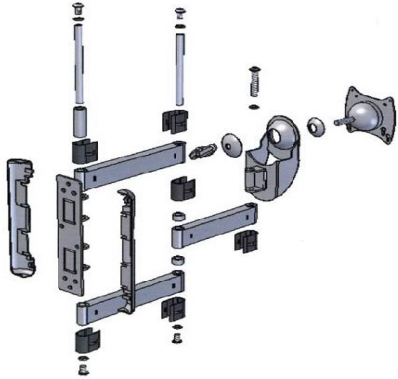
Exploded views must be accompanied by an assembled view.

- If not submitted at filing stage, the applicant will be invited to **add an assembled view** provided that this view does not disclose features that were not present in the original representation.

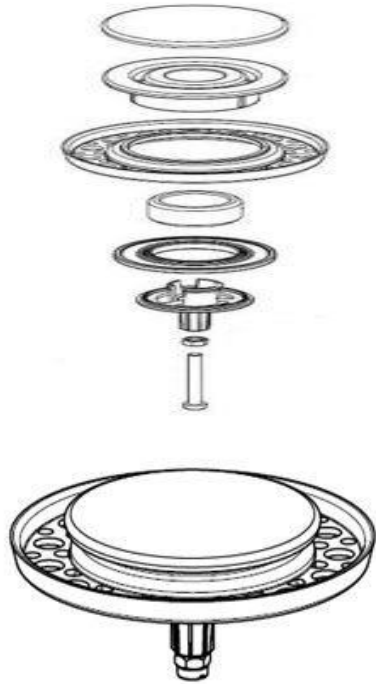
- This addition does not affect the filing date of the design.



EXPLODED VIEWS



EXPLODED VIEWS

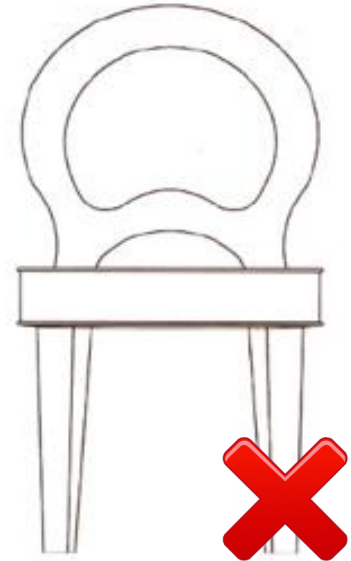


COMBINATION OF VIEWS IN DIFFERENT FORMATS

- Regarding the combination of several means of visual representation, it is recommended that a **design be represented using only one visual format** (e.g. a drawing or a photograph).
- Where different visual formats are used, each must **clearly relate to the same design and be consistent** when comparing the features disclosed.
- When the different visual formats show aspects that are inconsistent with one another, they are not considered to represent the same design.

- A combination of a drawing and a photograph will usually reveal inconsistencies between
- representations in different visual formats.

COMBINATION OF VIEWS IN DIFFERENT FORMATS



LOCARNO

- The **Locarno Classification** is based on a **multilateral treaty administered by WIPO** (the Locarno Agreement which was concluded in 1968). The Agreement is open to States party to the Paris Convention for the Protection of Industrial Property.
- According to **Article 40 CDR and Article 3(1) CDIR classification of the RCDs has to be done in accordance with the Locarno Classification** and is a mandatory element of the RCD Register, the RCD publication and the RCD Registration Certificate.
- However, **neither classification nor the INDP (Indication of Products) shall affect the scope of protection of the design** as such (Article 36(6) CDR) and both shall serve administrative purposes only (Article 3(2) CDIR).
- The classification of the RCDs is done within the registration procedure and is part of the duty of EUIPO design examiners. It shall contain the applicable class and subclass of the Locarno Classification.
- Examination Guidelines, Section 6.2.3.1: Where the applicant has given the wrong classification or the classification is missing, the examiner will assign the correct one *ex-officio*.



GENERAL PRINCIPLES OF LOCARNO:

Designs are classified according to the **purpose of the product**; subsidiarily according to the **object** that they represent.

Multi-purpose products (except composite pieces of furniture, class 06-05) are classified in all the classes and subclasses of the intended purposes.

Products that **form part of other products** are classified in the same class and subclass as the products which they are part of, unless they are normally used for another purpose covered by a different class.

As offered during the meeting....

Extra 1 – 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)

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 all the designs of
the type of a product

Extra 2 – 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 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 impressions produced on the informed user by the contested design and by any earlier design which has been made available to the public.

Extra 3 – technical function (Article 8 (1) CDR

- The RCD shall not subsist in features of appearance of a product which are solely dictated by its technical function. If all essential features are solely dictated by technical function, the RCD is invalid.
- The RCD related to a product features of which are solely dictated by its technical function is assessed on novelty & individual character to the extent that such features are excluded.



THANK YOU



CARIFORUM



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

www.caripi-hub.com