

European Union

Contributing firm
Best Rechtsanwälte



Authors

Michael Best and Udo Pfleghar

In a globalised world, where products and production processes are becoming increasingly standardised and therefore in many ways interchangeable, many consumer goods are distinguished from those of competitors by their exterior – be it by shape, pattern, colour or any combination thereof of the goods themselves or their packaging.

These exterior features are important marketing tools, as they influence consumers' purchasing decisions; consumers may not even need to look at the brand to recognise and choose a particular product. The exterior of goods or their packaging has thus become part of the product's image and has considerable goodwill and reputation attached to it.

As a direct consequence, it has become increasingly important to protect these exterior features and their associated commercial value. Such protection can seldom be achieved through trademark registrations, as three-dimensional trademarks are almost impossible

to register, since many exterior features are not *per se* distinctive. Their recognition is often the result of considerable advertising expenditure and marketing efforts. Prominent examples include Adidas's three-stripes mark and the shape of the Coca-Cola bottle.

Community design

An alternative to trademarks is provided through the protection of designs. In the European Union, it became possible more than 10 years ago to obtain protection throughout all member states on the basis of one single right: the Community design.

Registered designs

When the first registered Community design applications were filed on April 1 2003, no one anticipated how successful the system would become during the following years. In fact, no more than 20,000 applications a year were expected. However, the first year alone saw some 40,500 applications for registered Community designs filed with the Office for Harmonisation in the Internal Market (OHIM). Some 10 years later, approximately 700,000

“Exterior features are important marketing tools, as they influence consumers’ purchasing decisions; consumers may not even need to look at the brand to recognise and choose a particular product”

applications have been filed (see *Alicante News*, January 2013, p2).

The legal basis for the registered Community design is laid down in the EU Community Design Regulation (6/2002), which came into force on March 6 2002. Like the Community trademark, which was introduced some six years earlier, this marked a revolution in the protection of intellectual and industrial property rights in Europe.

Community designs grant an exclusive right in the external appearance of a product or part thereof, to the extent that this appearance results from the features of the product itself and/or its ornamentation. Such features include in particular lines, contours, colours, shapes, textures and materials. The product concerned can be any industrially manufactured or manually produced item, including packaging, graphics, symbols and typefaces.

In order to obtain protection for a Community design, the design must be novel and possess individual character. This means that no identical design can previously have been made available to the relevant public in the European Union, and the overall impression created by the design on the informed user must differ from that of any design already made available to the public. However, taking into account commercial realities, the regulation allows for a one-year period from disclosure of a design (eg, in advertising, at trade fairs, through sales), during which the application for a registered Community design may still be filed without novelty being lost.

Protection is granted by OHIM. Applicants need file only one single application, and may then communicate in one language with one office and make payments for only one right

which is valid throughout the European Union for up to 25 years.

In addition to granting the possibility to file an application for design protection within one year of the design entering the public domain, the regulation takes into account the development of future products. Such designs must normally be kept strictly confidential before launch of the products concerned. For this purpose, the regulation allows for deferred publication. An application can thus be filed and publication of the registered design be deferred for up to 30 months. This gives designers and their clients the possibility to obtain protection without divulging their latest designs to third parties in general and competitors in particular.

Unregistered designs

In addition to the registered Community design, the regulation created the unregistered Community design, which affords protection for three years following disclosure to the public without any administrative steps. Unlike the registered Community design, for which OHIM issues a registration certificate, the existence of an unregistered Community design must be established by evidence, if proceedings against infringers are based on the unregistered right.

Enforcement

The strategic value of design rights has been clearly demonstrated in recent high-profile court cases, such as those between consumer electronics giants Apple and Samsung concerning the design of smartphones and tablets (see www.zdnet.com/apple-v-samsung-timeline-the-guide-to-whats-happening-7000002625/). Interim injunctions

“ Design rights holders should work closely with their legal advisers from an early stage in order to develop efficient strategies to make the best possible use of what is in fact a low-cost, but effective tool for defending their IP rights ”

prohibiting the sale of tablets were based, among other things, on their external appearance having infringed the rights in a registered Community design. Regardless of whether one agrees with the decisions taken by various courts in numerous countries in this conflict, the cases highlight the value of registered design rights in protecting a company's intellectual property, and the fact that major players have begun to use this instrument alongside patents and trademarks to defend not only their intellectual property, but also their market share.

This has led to increasing numbers of cases before the national Community design courts and the EU courts in recent years. In an important 2012 decision, the General Court held that in cases involving designs, the informed user on whose impression decisions are based must be understood as a particularly observant one, either because of personal experience or due to extensive knowledge of the sector concerned. However, this does not mean that the informed user is automatically able to differentiate between elements of the appearance of a product which are merely dictated by its technical function and those which are pure design elements (November 13 2012, Joined Cases T-83/11 and T-84/11, para 39-40).

Protection and defence measures

DesignView

A further important step in the use of design rights as a tool to protect and defend IP rights is the development of an efficient search tool. In 2012 OHIM launched DesignView as part of the Cooperation Fund Programme, which aims to promote harmonisation, modernise EU IP offices and facilitate working methods

for users of the EU trademark and design systems. DesignView is an online platform that allows users to search the databases of those national offices participating in the programme, as well as that of OHIM, for design registrations. Like the TMView database (an online trademark search tool, also maintained by OHIM), DesignView is available in all official EU languages and is updated daily. To date, it is possible to search designs registered in Bulgaria, Benelux, Estonia, Spain, Greece, Latvia, Portugal, Slovakia and with OHIM. However, the selection of search criteria is limited.

Search Image project

Also in the context of the Cooperation Fund Programme, OHIM is developing the Search Image project, which aims to make it easier to search for images in databases. It is intended to be used for trademarks, as well as registered designs. The complexity of the shapes and forms which designs can take makes this a demanding project. However, if successful, it should make searching much easier and far more reliable. This would create further certainty for both holders of earlier rights and applicants.

Conclusion

Overall, it is likely that designs will continue to become more important and there is no reason why the Community design system and its users should not benefit from this. Design rights holders should work closely with their legal advisers from an early stage in order to develop efficient strategies to make the best possible use of what is in fact a low-cost, but effective tool for defending their IP rights and financial value.

Technological developments, such as the three-dimensional printer, may well mark new

and critical possibilities for mass infringement of design rights. It is the purpose of such printers to scan existing objects and reproduce them in as exact a copy as possible. Design rights holders must protect their interests against such threats.

In view of the above, it is now up to design rights holders and their legal advisers to develop the correct strategies for developing, protecting and enforcing design rights. During the development stage, it is important to ensure that no third-party rights are infringed by the finished design, and that designs are not made public too early, as this could have detrimental effects on protection. At the time of protecting the rights, it is important to find the right balance between different types of right and obtaining the necessary protection without incurring unnecessary costs. Finally, at the enforcement stage, possible doubts about the validity of the rights should be addressed and resolved internally before action is taken.

After more than 10 years in practice, there can be no doubt that registered Community designs are an important tool in the protection and defence of a company's IP portfolio. They can be used to obtain comprehensive protection of design rights throughout the European Union without putting unreasonable strains on the available budget. [WTR](#)

Best Rechtsanwälte

Hostatostr 26, 65929 Frankfurt am Main
Germany

Tel +49 69 8700 200 30

Fax +49 69 8700 200 40

Web www.best-ip.eu



Michael Best

Partner

Michael.Best@best-ip.eu

Michael Best studied law in Mainz, Germany and Dijon, France. He first became involved with intellectual property as a scientific assistant at the University of Mainz in 1987, where he wrote a doctoral thesis on trademark and unfair competition law. He then worked at a large German auditing firm for two years before becoming in-house counsel in the trademark department of chemical and pharmaceutical company Hoechst AG in 1992; he went on to become deputy head of that department in 1997. Mr Best is a founding partner of BEST Rechtsanwälte and has counselled clients worldwide in all aspects of trademark, unfair competition, copyright and domain matters for more than 20 years. Mr Best is a member of numerous IP and legal associations.



Udo Pflégghar

Partner

Udo.Pflegghar@best-ip.eu

Udo Pflégghar studied and trained in Melbourne, Australia and Regensburg, Germany. From an IP boutique in Munich he joined the Office for Harmonisation in the Internal Market (OHIM) in 1999, where he worked as a Community trademark examiner and an instructor. He also represented OHIM in proceedings before the European courts in Luxembourg. In 2004 he joined Boehringer Ingelheim to become head of the domain and trademark group, where he was responsible for the group's international trademark, design and domain portfolios, including major name creation projects. In 2009 he joined BEST Rechtsanwälte as a partner. He deals with all questions relating to trademark, design and domain law, as well as data protection issues.