

PRACTICAL ASPECTS OF REGISTERED EUROPEAN COMMUNITY DESIGNS

A European Community design system enabling the obtaining of protection with a single application for all states of the European Community has been established with a Community Design Regulation¹ (CDR) which entered into force on March 6, 2002. On December 24, 2002, the Community Design Implementing Regulation² (CDIR) and the Regulation for the Fees for Community Designs³ (CDFR) entered into force. The latter Commission Regulations are in complement to the CDR and now provide a complete system for the application of registered Community designs (rCD).

The administrative board of the OHIM set the first possible effective application date for rCDs as April 1, 2003. While it is possible to file applications at the Office as from January 1, 2003, they will be deemed to have been filed on April 1, 2003.

1. Filing Requirements

The application can either be filed with the Office for Harmonization of the Internal Market (OHIM) or with a central Industrial Property Office of a member state. We can file any application received within a short time with the German Patent and Trademark Office.

To obtain an effective application date, we need to know: (a) the name and address of the applicant, (b) representations of the design, preferably three copies of each, and (c) an indication of priority (date, country, application number) and a certified copy of the priority application (Art. 36, 41 CDR). The copy of the priority application can be filed within three months of the date of filing (Art. 8 CDIR).

The representation may contain no more than seven different views of the design. The representation of the design shall consist of a graphic or photographic reproduction of the design either in black-and-white or in colour. The design shall be reproduced on a neutral background.

2. Multiple Applications

Several designs may be combined in one multiple application for registered Community designs provided that they all belong to the same class of the international classification for industrial designs. Each additional design shall be subject to the payment of an additional registration fee and an additional publication fee (Art. 37 CDR). The additional fees shall correspond to a percentage of the basic fees for each additional design, so multiple applications shall be less costly than filing individual applications for each design.

Each of the designs contained in a multiple application or registration may be dealt with separately from each other and, in particular, may be enforced, licensed, the subject of a right in rem, levy of execution, surrendered, renewed or assigned, be the subject of deferred publication or be declared invalid, separately from the others.

3. Publication and Deferment of Publication

The design shall be published upon registration (Art. 49 CDR). However, it is possible to request, when filing the

1 cf. http://oami.eu.int/en/design/pdf/reg2002_6.pdf

2 cf. <http://oami.eu.int/en/design/pdf/Official Regulation21102002.pdf>

3 cf. <http://oami.eu.int/en/design/pdf/Fees regulation.pdf>

application, that the publication be deferred for a period of 30 months from the date of filing the application or its priority, if any. In this case, only a mention of the deferment shall be published in the Community Designs Bulletin, together with the name of the holder, the date of filing and registration, and the file number of the application (Art. 50 CDR). Neither the representation of the design nor any particulars identifying its appearance shall be published (Art. 14 CDIR). With the request for deferment of publication, a deferment fee is to be paid instead of the publication fee. Before the expiry of the 30 months deferment period, the applicant shall, at the latest three months before the requested date of publication, pay the publication fee. In case of multiple applications, the publication and the deferment thereof need only be applied to some of the designs included therein (Art. 50 CDR).

The deferment of a publication is a useful tool for maintaining secrecy of the application for a maximum duration of 30 months.

4. Examination

The Office shall automatically examine the application as to formal requirements for filing but the major substantial requirements of novelty and individual character shall not be examined and examination thereof cannot be requested (Art. 45 CDR, Art. 10 CDIR). Likewise, the Office shall not conduct official searches.

If the formal requirements are fulfilled, it is expected that the design shall be registered within two to three months after filing. Upon registration, the CD shall be published unless a deferment of publication has been requested, as explained above.

5. Fees

The official fees to be paid to the Office are set out in the Annex to the CDFR. Compared with the costs for filing and prosecuting a number of national applications, the costs of a Community design application are very advantageous.

Taking into account the attorney fees, it can be estimated that a Community design shall be less costly than the registration of two to three national designs.

6. Term of Protection

A registered Community design shall be protected for a period of five years from the date of filing of the application. The term can be extended in steps of five years each up to a total term of 25 years from the date of filing (Art. 12 CDR).

7. Validity

The validity of a registered Community design can be challenged centrally by submitting to the Office an application for invalidity (Art. 24, 52 CDR). There are some substantial grounds for invalidity, including novelty and individual character (Art. 24 CDR).

Likewise, the Community design can be declared invalid by a Community design court on the basis of a counter-claim in infringement proceedings (Art. 24 CDR).

8. Summary

Now that all the regulations relating to Community designs have entered into force, it is to be expected that the Community design shall become a successful protective right which provides the opportunity for the applicant to obtain protection for all member states of the European Community in a cheaper way than filing three or more national applications. The examination is restricted and the Office is encouraged to conduct it rapidly, so that applicants shall get the benefit of an early registration and can then enforce it against infringers.

If you have any further questions, please do not hesitate to contact us at info@grunecker.de.