

Impact of the New Community Regime for Designs on Trade Marks

There are three rights:

- A **Community registered design** for all 15 Member States of the EU under the Community Design Registration of December 2001. Applications deposited at OHIM from **1 Jan 2003** will be given the first possible filing date of 1 April 2003.
- This Regulation also introduced on **6 March 2002** a **Community unregistered design right** covering all 15 Member States as from the date it is first made available to the public in the Community.
- The **UK registered design**, with the UK Registered Designs Act 1949 amended in December 2001 to harmonize with the Community Regulation.

An outline of the basic provisions is attached to this note. Of most importance from the perspective of trade marks:

1. Two-dimensional features of appearance of products, such as logos, icons used in websites, labels, as well as packaging and get-up, may enjoy protection as designs *as well as* trade marks.
2. Official fees are considerably less than for trade mark registration.
3. Time charges are also likely to be less, since examination for absolute grounds is only cursory and there is no provision for opposition.
4. **There is an express provision that the scope of protection will not be limited to only the products listed in the application. This leaves open the chance for one registration to provide infringement rights covering all products. There is also no requirement of a bona fide intention to use the design on applying for it, nor is there is any provision for cancellation if it has not subsequently been brought into use. Design registration is accordingly a cost-effective method of reserving a clients' options on line extensions.**

Any trade mark practitioner now needs to consider both trade mark and design rights when advising a client on European law. **The important effects are:**

- The need to search both the designs and trade marks registers when clearing a visual mark for use, since it might infringe rights to a design.
- Consider, if a device is not likely to qualify for trade mark registration because it is devoid of distinctive character, seeking registration as a design. This can still be done even if the client has started to use the mark, **provided the application is filed within twelve months of the date the designer first made it available to the public.**
- Even if the device will qualify for trade mark registration, consider design registration too, to supplement trade mark infringement rights.
- It is not advisable, until such time as case law determines the extent of the infringement rights arising from the new design law, to apply for design registration *instead* of registration as a trade mark unless cost constraints are an overriding factor.

Official fees due on applying for a Community registered design are **1)** the registration fee of Euros 230 [approx US\$ 240] **and 2)** the publication fee of Euros 120 [approx US\$ 140] **but** this can be deferred on payment of Euros 40 [approx US\$ 50] to request that, when the design is registered, publication of the design be deferred for up to 30 months. This is to give the proprietor the commercial advantage of keeping his design secret until he is ready to launch it onto the market with no delay in obtaining his infringement rights. One community registration can cover more than one design [the extra fees are Euros 195 [approx US\$ 205] per design] if all fall in the same class of the Lacarno classification. As for the UK, the official registration fee due on applying is £60[\$US80]. There is no provision for deferment of publication of a UK design. Its publication would destroy the novelty of any later application as a registered community design. Both the UK and Community registrations need to stay in common ownership so as to avoid a risk of invalidity proceedings.

As my firm does not charge standard service fees, the only other charges will be for miscellaneous disbursements such as preparing of drawings and time spent at the hourly rate of £100 [\$US 150].

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