



EUROPEAN PATENT AND
TRADEMARK ATTORNEYS

Intellectual Property

Designs





Designs

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You have developed a product, devoting great attention to the design.
You wonder what steps you need to take to protect this design. Or perhaps you have already registered a design, and now you want to protect it in other countries as well. Can you use that design without any risks, for example? Anyway, if you want to find out more about the backgrounds of design rights.

QUESTION 1

What is a design?

A design is about appearance. According to the law, design is the 'appearance of a product or part thereof' where product is taken to mean 'any item manufactured industrially or traditionally.' The appearance is largely determined by features such as lines, outline, colours, shape, texture and materials of the product or its decoration. Examples include toys, tools, packaging, (domestic) appliances, furniture, clothing, fabric designs, etc. Less widely known is the fact that fonts, graphic symbols, interiors and logos can also be considered designs. Features of designs which only have a technical function are not protected by design rights.

QUESTION 2

How do I protect a design?

A design registration is the best way to qualify for protection. You may apply for design registration in each country. By filing one application, you can also obtain a right in different countries.

Examples include:

- › The Benelux countries.
- › The European Union, where registration offers protection in all member states (the EU model).
- › A so-called international registration, where you can single out those countries in which you seek protection.

QUESTION 3

What requirements must a design meet?

A design must be novel

That means the design is not yet known to the public. In some countries, designs will also be considered novel if they are published or shown to third parties within one year prior to the date on which protection was requested. To determine the novelty of both the Benelux and EU designs, it is important to know whether the designs involved have come to the attention of insiders in the relevant sector within the region that consists of the European Economic Area (European Union, Norway, Iceland and Liechtenstein).

A design must have its own character

That means that the general impression which the design has made on the informed user is unlike the general impression which the user has of existing, publicly available designs. Who the 'informed user' is often depends on the circumstances of the case. The design must visibly deviate from existing designs. What matters here is the designer's freedom while developing the design. In this process, the designer must bear in mind the functional requirements of a product, which may limit his creativity. This can vary according to the branch of industry in question.

QUESTION 4

What does the registration procedure involve?

The application must be carefully prepared before it can be submitted. Applying for design registration is subject to the following requirements:

- › The name of the proprietor;
- › The proprietor may be a natural person (e.g. the designer) or a company;
- › The street address of the proprietor;
- › One or more images of the design in the form of drawings or photos.

It is very important that the features of the design are prominent in these images. In the event of a conflict, the design will be compared using these images.

Once the administrative and payment requirements have been met, the design will be registered. Usually, a design registration is valid for five years and may be extended four times by a period of five years. The maximum protection is thus 25 years. After registration, the design will be published in a publication of the official authority. The proprietor will generally only be entitled to take measures against infringers after registration and publication.

What is a multiple application?

It is possible to include several designs in one application for registration. The advantage of a multiple application is that after the first design, a discount rate will apply to the subsequent designs.

In the European Union, a multiple filing may include an unlimited number of designs, provided all the designs fall into the same category. For example, different musical instruments may be included in one application, but watches and jewellery may not be combined in the same application.

QUESTION 5

How much does it cost to register a design?

Costs depend on several factors, like the country or country group of your choice, the number of designs, supply of suitable images of the design by you or drawings or pictures made by us that meet the requirements. A design registration in the European Union starts at € 1.500 for a five-year registration. Please contact NLO Shieldmark for a specific cost estimate.

QUESTION 6

How do I know whether a design already exists?

During the registration procedure, there will be no official investigation into previous registrations of conflicting designs. However, it is possible to screen the design registers to find out whether any previous design registrations exist. Current applications for registration cannot be reviewed as these are not public. An investigation can be performed using an image of the design in question. An investigation into design trademark registrations in the name of a particular proprietor can also be performed.

QUESTION 7

What do I do if others infringe my design rights?

If anyone infringes your design right, then we will find a solution together. First, we will send the infringer a notice seeking to negotiate. If these efforts do not pay off, legal proceedings can be instigated. In order to proceed on time, we advise you to keep a close eye on the market and engage us at the earliest possible opportunity.

QUESTION 8

How do I expand my protection?

Time is of the essence. After the first application for registration, for example in the Benelux countries or in the European Union, a priority right will follow. In most countries, it is possible to invoke the priority right of the first application of your design. You will then be protected with retrospective effect as from the date on which you filed your first application. However, you will need to file any subsequent applications within six months following the filing date of your first application. After this six-month period, a valid application will no longer be possible in many countries, as the design involved is no longer considered to be new.

QUESTION 9

I am a designer and I need someone to manufacture my design. What should I bear in mind?

The safest way is to register the design in your name before you introduce it to third parties. Bearing the novelty requirement in mind (see question number 3), during the application for registration of an EU design you will have one year to find a manufacturer before you decide to register the design. Precautionary measures during these twelve months can be the following:

- › Have a declaration of confidentiality signed (we can draw this up for you).
- › Have a date stamp affixed (e.g. by a civil-law notary) on an image of the design.

QUESTION 10

What is the connection between design rights and copyright?

In some cases a product is not only protected by means of the design rights, but also by the copyright. This only applies if the product is seen as a “work” within the meaning of copyright and meets the requirements, namely: is it the author’s own intellectual creation?

The copyright follows automatically upon creation. But until a judge pronounces judgement, it is uncertain whether this right prevails. It should therefore not be taken for granted that a product is protected by copyright. The advantage of a design is that it is registered and published in an official register.



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