

## Irish, UK & Community Design Registrations

An industrial design is the ornamental or aesthetic aspect of an article. The design may consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or color.

To be protected under most national laws, an industrial design must appeal to the eye. This means that an industrial design is primarily of an aesthetic nature, and does not protect any technical features of the article to which it is applied.

Industrial designs are what make an article attractive and appealing; hence, they add to the commercial value of a product and increase its marketability.

When an industrial design is protected, the owner - the person or entity that has registered the design - is assured an exclusive right against unauthorized copying or imitation of the design by third parties. This helps to ensure a fair return on investment. An effective system of protection also benefits consumers and the public at large, by promoting fair competition and honest trade practices, encouraging creativity, and promoting more aesthetically attractive products.

Protecting industrial designs helps economic development, by encouraging creativity in the industrial and manufacturing sectors, as well as in traditional arts and crafts. They contribute to the expansion of commercial activities and the export of national products.

## Irish Design Registrations

The maximum period of protection for designs is 25 years. You may file a multiple application, which may consist of up to 100 designs, provided they all belong to the same class of the Locarno system of International classification. In cases of ornamentation then they are not restricted to the same class. The applicant may permit publication of the design upon registration or request deferment of publication for up to 30 months from the filing date or where priority is claimed from the priority date. Where a deferment is requested, the request must be accompanied by the prescribed fee.

The applicant must be the proprietor of the Design. The proprietor can be the author of the Design or the employer of the person who created the design if this was done in the course of the employment (subject to any contract or agreement to the contrary).

## Filing Requirements

Representation/s of the design/s:

- Size (min) 9cm X 12cm, (max) 18cm X 24cm. These should be on an A4 page.
- Any number of representations may be submitted but must be suitable for reproduction.
- Where more than one view submitted, each must be on separate page and identified as perspective view, front view, side view, etc.
- In the case of multiple applications the design identification numeral must be written on the back of each representation.

## Community Design Registrations

The objective of the Community Design is to fulfil the recognised need by which an applicant can, by means of one procedural system, obtain a single registration to which uniform protection is given and which has effect throughout the entire area of the European Union.

The regulations governing the Design Regulation follows the successful model of the Community Trade Mark Regulations and many of the procedural aspects are similar. The Office for Harmonisation in the Internal Market (OHIM) based in Alicante, Spain, which administers the community trade mark system, will also administer the Community Design.

Article 1(3) – "A Community Design should have a unitary character. It shall have equal effect throughout the community. It shall not be registered, transferred or surrendered or be the subject of a decision declaring it invalid, nor shall its use be prohibited, save in respect of the whole community".

The Design Regulation does not replace national design or copyright laws. It provides an alternative cost effective and streamlined system to national design filings in the EU.

## Main Points

- Administered by the office for harmonisation in the internal market (OHIM) – Alicante, Spain.
- Single registration - all countries of the European Union.
- Unitary character (all or nothing).
- Registration for up to 25 years.
- Criteria for registration – novelty and individual character.
- One year grace period.
- Availability of multiple designs.
- No novelty search or opposition procedure.

## Who may apply?

There is no restriction as to the type of nationality of applicant. Registration is available to nationals of non Paris convention countries.

## What may be registered as a design?

Article 3(a) – "The appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or the ornamentation". A product embraces any industrial or handicraft item, including parts intended to be assembled into a complete product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs. The design itself will be protected rather than the product to which it is applied. However, it will be necessary to identify the product illustrated for classification purposes.

## Requirements for protection

In order to be eligible for protection, a design has to be 'new' and have 'individual character'. A design shall be considered new if no identical design has been 'made available to the public'. It will be deemed to have been made available to the public if it has been published, established, used in trade or otherwise disclosed except where these events could not reasonably have become known in the normal course of business to those specialised in the sector concerned operating within the EU. Individual character will subsist if the overall impression the design produces on the informed user is different from that which already exists. Grace period - the definition of 'made available to the public' includes a 12 month grace period for disclosures by, or deriving from, the designer.

## Exclusions from protection

A Community Design shall not subsist in features of appearance of a product which are solely dictated by its technical function or which must be reproduced in an exact form and dimension in order to perform the function ('must fit'). Also excluded from protection are designs which are contrary to public policy or to accepted principles of morality.

## Scope of protection

The scope of the protection conferred by a Community Design shall include any design which does not produce on the informed user a different overall impression. In assessing the scope of protection, the degree of freedom of the designer in developing the design shall be taken into consideration.

## Unregistered Community Design

Designs that came into being after March 6, 2002, are protected without application or registration as an unregistered Community Design. An unregistered Community Design right subsists for a period of three years as from the date on which the design was first made available to the public within the community.

## Registered Community Design

The term of a registered Community Design is a maximum of twenty-five years renewable at five yearly intervals.

## Rights conferred by the Community Design

A registered Community Design confers on the holder the exclusive right to use the design. This includes the right to prevent any unauthorised making, offering, putting on the market, importing, exporting or use of a product in which the design is incorporated or to which it is applied. An unregistered design only allows the right holder to prevent acts resulting from copying the protected design.

## Filing Requirements

- A request for registration.
- Full details of the applicant.
- A representation of the design suitable for reproduction.
- An indication of the products in which the design is intended to be incorporated or to which it is intended to be applied.
- Priority claim, if any.
- It is not necessary to file a Form of Authorisation or Power of Attorney.

In addition, the application may contain the following:

- A description explaining the representation or the specimen.
- A request for deferment of publication.
- Classification in accordance with the Locarno classification.
- The citation of the designer or a statement that the designer has waived the right to be cited.
- It is possible to include several designs in one multiple application if the designs belong to the same Locarno class and in the case of ornamentation, Locarno class restriction is not imposed.

## Examination

Examination is restricted to formalities including compliance with the definition of a design. There is no examination based on novelty and individual character.

## Opposition/Invalidity

There are no opposition proceedings. An invalidity action against a registered Community Design is taken before OHIM or to a court in the case of a counter claim in infringement proceedings. An unregistered Community Design cannot be declared invalid by OHIM. A registered Community Design may be the subject of invalidity proceedings before OHIM or as a counter claim to infringement proceedings in a court. Unlike the Community Trade Mark, there is no provision for conversion of a registered Community Design to national design(s).

## Deferment of publication

An applicant can defer publication of a registered Community Design for up to thirty months from the date of filing or the priority date. This gives a designer the advantage of keeping a design secret until actually putting the design on the market yet enjoying the priority of the original application.

## Assignment/licensing/security

A registered Community Design may be assigned, licensed or given as security. Until such time as an assignment has been recorded on the register, the successor in title cannot invoke the rights conferred by registration.

## Languages

The application for a registered Community Design shall be filed on one of the official languages of the Community. The applicant must designate a second language being English, French, Spanish, German or Italian.

## Advantages of the Community Design

- Broad protection even against innocent infringement.
- A single application with a single examination resulting in a single registration embracing the twenty five countries of the European Union. This includes a substantial cost saving over national filings.
- Speed of registration with examination only as to formalities.
- No opposition procedure.
- Easier administration. Only one renewal is required and recordals of assignments, changes or name, licenses, etc. can all be done centrally before OHIM.
- A Community Design registration may provide an option as to the country in which to institute infringement proceedings.
- Applicants can combine in one single application, multiple variations of same design.

- Deferment of publication for up to thirty months.

## **Please Note**

While this guide has covered several topics, it is intended as a very basic introduction to Designs and Copyright, and certain procedures surrounding them, and as such, it is no substitute for consulting with a qualified attorney.

If you have any further questions please [contact us](#).

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