

Spring 2003

The Community Design: European Union-Wide Protection for Your Design Portfolio

Christopher M. Aide

Recommended Citation

Christopher M. Aide, *The Community Design: European Union-Wide Protection for Your Design Portfolio*, 1 NW. J. TECH. & INTELL. PROP. 35 (2003).
<http://scholarlycommons.law.northwestern.edu/njtip/vol1/iss1/2>

This Perspective is brought to you for free and open access by Northwestern University School of Law Scholarly Commons. It has been accepted for inclusion in Northwestern Journal of Technology and Intellectual Property by an authorized administrator of Northwestern University School of Law Scholarly Commons.

The Community Design: European Union-Wide Protection for Your Design Portfolio

Christopher M. Aide*

I. INTRODUCTION

¶1 There is a new and cost-effective form of intellectual property protection available for design portfolios (including those belonging to American and Canadian companies and individuals) that cover the entire European Union (“EU”) – the Community Design.¹ The Community Design system arose from the Council Regulation (EC) No 6/2002 of December 12, 2001 on Community Designs (hereinafter “Regulation”). It is designed to create a uniform legal regime to protect industrial designs and creations across the EU. Such protection is vital for numerous key sectors of the economy, including -but not limited to- clothing, textiles, shoes, cars, jewelry, furniture, tableware, and ceramics.

¶2 Previously, gaining design protection across the EU involved navigating a patchwork of different types of national legislation for each of the current fifteen EU member states. The level and quality of protection this situation afforded varied greatly and resulted in a lack of legal security, which proved detrimental to investment.² Although, the European Directive on the legal protection of designs³ requires EU member states to harmonize their design protection laws, until now obtaining protection was costly, because this Directive did not harmonize the procedure for obtaining protection it thereby required the filing of national applications to obtain registered protection.

¶3 The Regulation now makes EU-wide design protection cheap and simple to obtain. There are two forms of protection that the Regulation provides: the *Unregistered* Community Design (“UCD”) and the *Registered* Community Design (“RCD”).

¶4 Since March 6, 2002, qualifying designs have *automatically* had protection as UCDs across the EU. As of January 1, 2003, applications for RCDs, whose scope of

* Christopher M. Aide practices with the Intellectual Property Group of Baker & McKenzie’s Toronto office and is a partner in the firm’s Canadian offices. He was previously a member of the German and Austrian offices’ Intellectual Property Group in Frankfurt am Main, Germany from 1999-2003 and was also a partner in those offices. He is a barrister and solicitor in Ontario, Canada, as well as a solicitor in England & Wales. The author is indebted to his colleague, Ms. Jenni Rutter, of Baker & McKenzie’s London office, whose November 2002 Legal Briefing on the Community Design provided both content and motivation for this article.

¹ The Community Design arose from the Council Regulation (EC) No 6/2002 of December 12, 2001 on Community Designs (“Regulation”), which was adopted on that date by the Council of the European Union, *available at* http://oami.eu.int/EN/design/pdf/reg2002_6.pdf (last visited Nov. 12, 2003).

² Press Release, Office for Harmonization in the Internal Market, Trade Marks, and Designs CP/01/02 (Dec. 14, 2001) (Alicante, Spain), *available at* <http://oami.eu.int/es/office/press/pdf/141201.pdf> (last visited Nov. 12, 2003).

³ Directive 98/71/EC of European Parliament and of the Council of October 13, 1998 on the legal protection of designs, *available at* <http://oami.eu.int/EN/design/propdir.htm> (last visited Nov. 12, 2003).

protection is considerably broader than that of UCDs, have been accepted by the same institution, that handles Community Trade Marks, namely, the Office of Harmonization in the Internal Market (“OHIM”). This is the case even though the RCD system did not officially go live until April 1, 2003.

¶5 This perspective is designed to provide a practical guide for business people and lawyers who are aware of, but not fully familiar with, the Community Design system to assist them in evaluating the advantages, options, and strategies available in registering and enforcing their own or their clients’ design rights under this system.

¶6 To provide such practical advice, this perspective begins with a summary of the differences between a UCD and an RCD and discusses when it may be appropriate to seek registered as opposed to unregistered protection for your designs. It follows with a discussion of the RCD registration process, as well as a summary of the means to declare an RCD invalid. This perspective then discusses enforcement, as well as assigning and licensing, of both a UCD and an RCD. Finally, a sample sheet for the technical specifications required for filing an RCD is provided to assist the reader in preparing and filing RCD applications.

II. UCD vs. RCD

A. UCD: Scope of Protection

¶7 As noted, since March 6, 2002, qualifying designs (i.e., designs for clothing, textiles, shoes, cars, jewelry, furniture, tableware and ceramics) automatically have protection as a UCD across the EU. However, UCD protection only lasts *three years* from the date the design was first disclosed. More specifically, the UCD right will come into existence automatically when the products incorporating the designs are made available to the public within the EU (i.e., if the design has been published, exhibited, used in trade or otherwise disclosed in such a way that it could reasonably have become known to those specialists in the sector concerned).⁴

¶8 Also, a UCD is only infringed where the infringing junior design has been *copied* from the senior design. The applicant should be alert to the fact that the purported infringer of a UCD can defend by successfully arguing that the design he or she uses results from an independent creation.

¶9 Although a UCD provides limited protection, for certain industries that renew their design collections seasonally (e.g., the clothing or shoe industries), such UCD protection provides an initial important layer of protection across the EU against counterfeiting and other infringing copies without any formality or cost involved.⁵

¶10 UCD protection may be entirely acceptable for a short-term design portfolio. The RCD, on the other hand, provides much broader and longer protection. The applicant’s new product designs that are intended to have a long shelf life could benefit greatly from the EU-wide protection an RCD provides.

⁴ Press Release, Office for Harmonization in the Internal Market, Trade Marks and Designs CP/01/02 (Dec. 14, 2001) (Alicante, Spain), *available at* <http://oami.eu.int/es/office/press/pdf/141201.pdf> (last visited Nov. 12, 2003). It is not entirely certain whether the date of first disclosure means first disclosed anywhere and thereby reasonably could have become known to the relevant public in the EU or first disclosed in the EU itself. That is a matter for clarification by either the courts or legislators.

⁵ *Id.*

B. RCD: Registration Benefits, Procedures and Costs

1. Key Benefits of an RCD

¶11 An RCD is quick, simple and cheap to register. RCD applications, as noted, could be filed with OHIM beginning January 1, 2003, even though the system did not officially go live until April 1, 2003. OHIM will not examine RCD applications except to make sure the design is in fact a design and does not offend public morality. OHIM anticipates that RCD applications not subject to objections and not deferred should be registered and subsequently published in the Community Designs Bulletin within a few months (considerably faster than is the case for Community Trade Marks to issue registration). The cost of obtaining registered protection will be a fraction of what it would cost to get national design registrations throughout the EU.

¶12 The wide definition of a design means that one can gain registered protection for logos, packaging, graphic symbols, typefaces, computer icons and other things as an RCD but not computer programs. An RCD for a single design could cover all classes of goods throughout the EU. The applicant can claim its RCD has been infringed even if the person infringing did not copy or know about the applicant's RCD. EU-wide injunctions and damages will be available for infringement. A designer or owner of a design can disclose a new design to the public (e.g., to investors, or at a trade show) and still apply for an RCD up to twelve months later. This should only be a safety net. It will still be important to apply for an RCD promptly. The applicant can keep its design a secret from the market by deferring disclosure through publication of your RCD application for up to thirty months after it is filed or from the priority date, whichever is first. The applicant can also interrupt such deferment at any time and allow publication. The applicant must state that you are deferring publication of the RCD upon filing: a subsequent request for deferment will not be accepted by OHIM. Many different designs can be included in the same application (a "multiple application").

2. Overlap Between RCDs and Registered Trademarks: Broadening Your Protection

¶13 Given the wide definition of a design under the Regulation,⁶ RCDs, which consist of graphic symbols (e.g., stylized words and logos), will overlap to an extent with registered trademarks. RCDs have a number of benefits over registered trademarks, making it worthwhile to register both. Benefits include the following:

- (1) There is no requirement to use a design, so it cannot become vulnerable to cancellation proceedings for non-use.⁷
- (2) Unlike a trademark, a design can be descriptive and/or non-distinctive.
- (3) One registration for a single design conceivably could cover all goods.

⁶ Article 3(a) of the Regulation defines "design" to mean "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 its ornamentation."

⁷ This provision could be particularly valuable for new, non-distinctive design trademarks. Registering a trademark as an RCD could gain the mark some type of protection during the time that a non-distinctive mark is initially being used and advertised. This would allow the mark to build up acquired distinctiveness sufficient to be registered as a trademark on that basis.

- (4) Anyone can file an RCD, regardless of nationality or country of incorporation.
- (5) The ability to keep an application secret for up to thirty months could be important for a new product launch.

¶14 The drawbacks of RCDs as compared with registered trademarks include:

- (1) RCDs last for twenty-five years, requiring renewals every five years, whereas registered trademarks can potentially be renewed indefinitely.
- (2) There is a novelty test (i.e., whether the design is “new,” as discussed below), which does not exist for registered trademarks.
- (3) RCDs protect only goods and *not* services.⁸
- (4) RCDs may be more vulnerable when challenged, given that OHIM will not examine applications except on limited grounds.
- (5) There is already settled law and guidance on registered trademarks. RCDs are a “whole new game.”

3. Geographical Coverage

¶15 An RCD would provide protection in all fifteen of the current EU member countries, namely: Austria, France, Italy, Spain, Belgium, Germany, Luxembourg, Sweden, Denmark, Greece, The Netherlands, United Kingdom, Finland, Ireland, and Portugal.

¶16 Furthermore, when the EU expands, coverage of existing RCDs will automatically be extended to the EU’s new member states. It currently appears that such extension will include Cyprus, the Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta, Poland, Slovakia and Slovenia in 2004, with Bulgaria and Romania scheduled to join the EU in 2007. In addition, Turkey also remains a potential (unscheduled) candidate country for EU enlargement. Thus, by 2007, each RCD could potentially cover twenty-seven or more countries.

4. Costs

¶17 OHIM’s official fees would total €350 for a single RCD application, and €390 if publication is deferred (including €230 for official OHIM registration fees and €120 for publication fees, plus an additional €40 for deferred publication). The fees are to be paid in their entirety upon filing. A multiple application will incur additional OHIM fees, depending on the number of designs covered in such an application.

¶18 The costs for preparing, filing and registering an RCD vary, depending on who does it. While this matter is new, EU-based attorneys anticipate that their costs for preparing and filing an RCD application covering one design, assuming that there are no objections, should range between €1250 and €1500, and may be higher depending on complexity.

⁸ However, since a registered design may, for example, be printed on brochures, advertisements, and the like, as in jurisdictions that do not allow service marks, there are ways of extending protection of an RCD to cover goods that, in turn, necessarily support services.

5. Which Designs May be Registered

¶19 A “design” that may be registered is some aspect of a product’s visible appearance (i.e., its external form). A design can be registered as an RCD if it is both new and has individual character.

¶20 To be new, the design cannot have been made available to the public anywhere in the world before the RCD application was filed or get its priority date. It is therefore important to file an RCD as soon as possible after a new design is finalized (although in some cases, there may be a twelve month grace period, as explained in greater detail below). A design has individual character if an informed user would have a different overall impression of the design as compared with other designs in the market. This test will need to be developed over time, as it is specific to the RCD regime.

¶21 Designs that are not protectable as either a UCD or an RCD are designs that are immoral or contrary to public policy, designs of the shapes of mechanical interfaces, designs of shapes of component parts that are hidden in normal use, and designs which are dictated by the function to be performed (i.e., the design could not be made in any other shape for such function).

¶22 Note that a design for spare parts used to repair a complex product, upon whose appearance the design is dependent, so as to restore the original appearance is not protectable (thus, for example, certain car spare parts designs might not be protectable).⁹

6. Term

¶23 An RCD registration lasts for five years from the date of application and can be renewed up to four times upon request, accompanied by payment of the prescribed fee, thus providing a maximum of twenty-five years of protection.

7. Who May Apply

¶24 Again, anyone may apply for an RCD.

8. Who is the Owner?

¶25 The right to a Community Design (both RCD and UCD) vests in the designer or his or her successor in title. If two or more persons have developed a design, the right to the Community Design shall vest in them jointly.¹⁰ However, if an employee develops a design in the course of his or her duties or following instructions given by his or her employer, the right to the Community Design shall vest in the employer, unless otherwise agreed or otherwise specified under national law.

⁹ To give a specific example, car manufacturer X who produces its own design of hubcaps for its X series sports car could not prevent an unauthorized third party from making the same design of hubcaps to replace any damaged or worn-out hubcaps on the X series car. However, if car manufacturer X registers its hubcap design as an RCD, it could prevent its competitor, car manufacturer Y, from using the X series design hubcap on the competitor’s Y series sports car in the EU (even if car manufacturer Y did not copy or even know about car manufacturer X’s RCD).

¹⁰ It is strongly recommended that the joint owners of a design contract in writing as to what happens to ownership of the design should one of the joint owners die, what steps must be followed to have all parties agree to an assignment. For simplicity, joint ownership is discouraged.

9. RCD Application Procedure

¶26 An RCD application will only be subject to a short examination process. Substantive issues generally will not be examined. Following a check that the formalities have been met (e.g., that the correct fees have been paid, the proper priority claim made, if applicable, and the like), a minimal substantive examination will be made, as noted, to determine whether the application is plainly not a design (e.g., because it is a word, smell, or sound) and that the design is not immoral. The applicant may respond to any objection raised at this point.

¶27 Assuming the RCD application is accepted for registration, it will then proceed to publication in the Community Designs Bulletin. No power of attorney is required to file an RCD application. In certain circumstances, OHIM may request that such a power of attorney be filed following the receipt of the RCD application. For ease of reference in preparing an RCD application, the required technical specifications are provided in Section 4.

10. Deferment of RCD Publication

¶28 The applicant may also choose to keep your design a secret by deferring publication of your RCD application for up to thirty months after it is filed or after the priority date, whichever is first. The advantage of such deferment is that the applicant can apply for the greater protection, that an RCD provides, and at the same time keep the applicant's design a secret until it is on the market. Potential competitors will not be able to look at your design during this deferment period, and your competitive edge is thereby maintained.¹¹ Again, the applicant may also interrupt such deferment at any time and allow publication. The applicant must, however, state that it is deferring publication of the RCD upon filing – a subsequent request for deferment will not be accepted by OHIM.

11. Multiple Application

¶29 As noted, several designs can be combined in one RCD application, subject to the condition that the products to which the designs apply or are incorporated all belong to the same class within the Lorcano Classification,¹² except in cases of ornamentation. There is no upper limit on the number of designs a multiple application may cover. If multiple classes are used, a multiple application or subsequent multiple registration may be divided into separate applications or registrations. Finally, each of the designs covered in a multiple application or registration will have its own independent life. Thus, each covered design may separately be deferred for publication, renewed, be declared invalid, be surrendered, assigned, licensed, etc.

¹¹ Press Release, Office for Harmonization in the Internal Market, Trade Marks and Designs CP/01/02 (Dec. 14, 2001) (Alicante, Spain), *available at* <http://oami.eu.int/es/office/press/pdf/141201.pdf> (last visited Nov. 12, 2003).

¹² Locarno Agreement Establishing an International Classification for Industrial Designs, October 8, 1968, Annex, *available at* <http://www.wipo.int/classifications/fulltext/locarno/en/loc.htm> (last visited Nov. 12, 2003).

12. Grace Period

¶30 A twelve-month grace period exists so that disclosure of a design by the designer, his or her successor(s) in title, or third parties who have stolen the subject design does not invalidate a subsequent RCD registration, providing such disclosure took place within a year before the filing date or priority date, whichever is earlier.

13. Languages

¶31 The OHIM's official languages are German, Spanish, French, Italian and English. However, an application may be filed in any one of the eleven official languages of the EU,¹³ although an applicant must also nominate a "second language," which must be one of OHIM's five official languages. As with Community Trade Marks, it is anticipated that English will be the most popular language for RCDs. Furthermore, since RCD applications probably will involve little text, the language provisions will likely create fewer issues than is the case with Community Trade Marks.

14. Invalidity

¶32 An RCD may be declared invalid for various reasons, including:

- (1) The design does not meet the criteria for a protectable design.
- (2) The design is not new.
- (3) The design lacks individual character (in other words, it creates the same overall impression as an earlier design).
- (4) The design does not belong to the alleged proprietor.
- (5) The design conflicts with an earlier right (e.g., an earlier copyright, national design, trademark or sign protected under national or international law).

¶33 Anyone may bring a claim for invalidity against an RCD, except where the claim is based on an earlier right, in which case only the relevant proprietor may do so. The Invalidity Division within OHIM may hear such invalidity claims. Alternatively, an appointed Community Design Court in each EU member state may also consider an invalidity claim, but only in an infringement action on the basis of a counterclaim, or in certain instances, as a defense made by a defendant. A declaration of invalidity will apply for the entire EU, and rights in the subject design may be deemed never to have existed.

III. COMMUNITY DESIGNS: ENFORCEMENT, ASSIGNMENT AND LICENSING

A. *Enforcement*

¶34 Enforcement of an RCD, as well as a UCD, will be a matter for an appointed Community Design Court in each EU member state. Such Courts will have jurisdiction to impose both EU-wide injunctions and damages. Proprietors will generally have a choice of forum for any given act of infringement. Unless special reasons exist to the contrary, if infringement is found, the Court must grant an order to stop the infringement. The

¹³ Danish, Dutch, English, Finnish, French, German, Greek, Italian, Portuguese, Spanish, and Swedish.

Court may also order seizure of the infringing products and the materials used to make them, as well as other remedies available in the country where the infringement has occurred.

¶35 It is clear that there are a number of civil remedies available to enforce Community Design rights whether as a UCD or an RCD. Whether Community Design rights may be enforced through criminal provisions is not yet clear, but is certainly an interesting subject. The enforcement of Community Design rights through criminal provisions may depend on the national laws of the individual EU member states. As far as the Regulation is concerned - as well as the Commission Regulation implementing Council Regulation (EC) No 6/2002 of October 21, 2002 - there is no specific provision regarding criminal sanctions against infringement of a Community Design. However, Article 89(1)(d) of the Regulation allows for sanctions to be imposed in accordance with the laws of the EU member states in which the threatened infringement takes place.¹⁴

¶36 We can comment on what the foregoing might mean for the United Kingdom and Germany. Naturally, these comments are academic in nature only – at the time of this writing, there is no case law or legislation yet which substantiates or refutes these comments.

1. UK

¶37 Since Article 89(1)(d) of the Regulation allows for sanctions to be imposed in accordance with the laws of the Member State in which the threatened infringement takes place, it is at least arguable that if infringement is committed in the United Kingdom (because the substance of UK registered designs law is the same as registered Community Design law), the court could impose the same criminal sanctions that would apply under the Registered Designs Act 1949.¹⁵

¶38 However, the wording of Article 89(1)(d) of the Regulation is not very specific on this matter, as noted. It may be that all that was intended is that the Community Design

¹⁴ Specifically, it reads:

Article 89, Sanctions in actions for infringement, (1) Where in an action for infringement or for threatened infringement a Community design court finds that the defendant has infringed or threatened to infringe a Community design, it shall, unless there are special reasons for not doing so, order the following measures: . . . (d) any order imposing other sanctions appropriate under the circumstances which are provided by the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law.

Council Regulation No 6/2002 of Dec. 12, 2001 on Community Designs, art. 89(1)(d), *available at* http://oami.eu.int/en/design/pdf/reg2002_6.pdf (last visited Nov. 12, 2003).

¹⁵ Criminal offences created by the Registered Designs Act 1949, as amended by the Copyright, Designs and Patents Act 1988 and the Registered Designs Regulations 2001 (the “Act”), are set out in sections 33 to 35A of the Act. To summarize: Breach of section 5 is an offence with a maximum 2 years imprisonment and/or a fine (on indictment) or maximum 6 months imprisonment and/or fine not exceeding the statutory maximum (on summary conviction) (§ 33). Falsification of the register of designs is an offence with the same maximum sentences as breach of section 5 (§ 34). False representation that a sign is registered is an offence with a maximum fine of level 3 on the standard scale (§ 35(1)). Marking (directly or indirectly) any product with the word “registered” (or words implying the same), after the right in a registered design has expired, is an offence with a maximum fine of level 1 on the standard scale (§ 35(2)). Please also note that pursuant to § 35A, a corporate body can also commit and be liable for the above offences. Registered Designs Act 1949, as amended by the Copyright, Designs and Patents Act 1988 and the Registered Designs Regulations 2001, §§ 33-35A, *available at* <http://www.patent.gov.uk/design/legal/act.pdf> (last visited Nov. 12, 2003).

Court (e.g., the English High Court) could apply whatever remedies it is generally entitled to award such as damages, an injunction or an account of profits.

2. Germany

¶39 At the time of this writing, Germany is currently amending its national design legislation to come into line with the Regulation. In this respect, on March 26, 2003, the German federal cabinet approved the proposed new draft of the German Design Act. The new German Design Act must now go through three readings in the federal parliament before it is enacted as law. Assuming no changes are made and everything proceeds smoothly, the new German Design Act could be in force within a year or so.

¶40 Interestingly, the present German Design Act, which was first enacted some 125 years ago, does provide for criminal sanctions of German registered designs, with maximum prison sentences of up to three years for infringement. There is also, in exceptional cases (e.g., when the infringer is a repeat offender whose business is simply the pirating of products), the possibility of a maximum prison sentence of up to five years. Another possible criminal sanction is the imposition of a fine.

¶41 Notably, the new German Design Act draft approved on March 26, 2003 now specifically refers to Community Designs. This version also retains the criminal sanctions noted above. Thus, a Community Design should be accorded the same protection as a registered German design. It would therefore seem that criminal sanctions would be possible for infringement of a Community Design in Germany.

¶42 Political significance lies in the fact that the approved new German Design Act draft was the subject of intensive lobbying, particularly by the automotive industry, to cover spare parts (which are specifically excluded from the Regulation). Initially, such lobbying proved to be successful; the approved draft specifically covers registration of (visible) spare parts.

¶43 Not until the new German Design Act actually comes into force can it be stated with certainty whether or not spare parts may be granted design protection. However, if such spare parts protection is finally a part of this new legislation, that form of protection may also be a very interesting prospect for applicants.

¶44 The bottom line is that there appears to be a good possibility that criminal sanctions against infringement of a Community Design, and particularly a registered Community Design, will exist in the future, at least as far as Germany is concerned. Naturally, matters will only become somewhat clearer when the new German Design Act comes into force.

B. Assignment and Licensing

¶45 An RCD (or a UCD) may not be assigned, but not for only part of the EU territory. As a unitary right, an RCD (or a UCD) must be assigned for the full territory of the EU. Assignments of an RCD (or a UCD) may be recorded at OHIM; the registered owner then benefits from the presumption that he or she is entitled to the RCD (or a UCD). Such a presumption may only be challenged by a court action.

¶46 An RCD (or a UCD) may be licensed for all or part of the designs or products within its scope, as well as for all or part of the EU territory. As always, with respect to the licensing of an RCD (or a UCD) for only part of the EU, you should be alert to the

anti-competition issues under the Rome Treaty¹⁶ this Act may entail. An RCD (or a UCD) license may also be recorded. Note that an RCD (or a UCD) license *must* be recorded in order for the licensee to be able to sue for damages.

¶47 Again, each of the designs in a multiple RCD (or UCD) application or registration may be dealt with separately, including being separately assigned or licensed. Recordation of assignments, licenses and other interests (e.g. security interests) for an RCD with OHIM is strongly recommended, since such recordation is generally necessary to ensure that the rights acquired thereby may take effect vis-à-vis third parties.

IV. APPLICATION FOR A REGISTERED COMMUNITY DESIGN: REQUIRED TECHNICAL SPECIFICATIONS

¶48 In order to file your RCD application promptly and completely, you should be alert to the following technical specifications:

- (1) **Applicant's Name and Address:** The full name, address, nationality, state or province of incorporation, fax number, telephone number, and email address of the company or person who is to be the applicant for the RCD is required. If the RCD application is to be jointly owned, the full name and address of *each* applicant must be provided. Note that if there is more than one applicant and the RCD application does not name a common representative, the first applicant named in the joint application shall be considered the common representative.¹⁷ It is therefore strongly recommended that if you are one of the applicants for a jointly owned application, you should have your name listed first as the common representative in order to have control over the conduct of proceedings concerning such RCD.
- (2) **Design Representation:** A representation of the design suitable for reproduction must be provided. The representation may be a graphic or photographic representation in monochrome or color. The representation may contain no more than seven different views of the applied-for design (any additional views will be ignored by OHIM). The representation should not be larger than approximately 10.3 inches x 6.9 inches (26.2 cm x 17 cm).¹⁸
- (3) **Specimen:** If your RCD application is for a *two-dimensional* design and you wish to defer its publication, the representation of the design may be replaced by a specimen pasted on a sheet of paper. Please note that such specimen should not exceed approximately 10.3 inches x 6.9 inches in size, 1.75

¹⁶ Treaty Establishing the European Community as Amended by Subsequent Treaties, (Mar. 25, 1957), available at <http://europa.eu.int/abc/obj/treaties/en/entoc05.htm> (last visited on Nov. 12, 2003).

¹⁷ Commission Regulation 2245/2002 of 21 October 2002 implementing Council Regulation No 6/2002 on Community Design, art. 61, available at <http://oami.eu.int/en/design/pdf/Official%20Regulation21102002.pdf> (last visited Nov. 12, 2003).

¹⁸ If an RCD application is for a *two-dimensional repeating surface pattern*, the design representation must show the complete pattern and a sufficient portion of the repeating surface in length and width. If an RCD application is for a *typographical typeface*, all letters in both upper and lower case, as well as all numerals must be given, together with a text of five lines produced using that typeface. Both letters and numerals must be in font size 16.

ounces in weight, or 0.0118 inches in thickness (26.2 cm x 17 cm in size, 50 grams in weight or 3 mm in thickness). The specimen must be capable of being stored in an unfolded fashion. For an application covering one design only, five copies of each specimen of the applied-for design are required. For a multiple application, five copies of the specimen are required for each design covered by such application.¹⁹

- (4) **Indication:** An indication (i.e., a brief description) or, better yet, the appropriate Lorcano Classification, of the product or products in which the applied-for design is intended to be incorporated, or to which it is intended to be applied, should be provided. The Lorcano Classification approach is recommended, as it should avoid OHIM having internally to translate such product indication/description into the eleven official EU languages, thereby speeding up the processing of the applicant's RCD application.
- (5) **Claiming Priority:** If applicable, you should provide the file number of *and* the country in which the *original* prior filed design application(s) was/were made *within the last six months* based on which priority is to be claimed for your RCD application. A copy of each prior application must also be provided. A copy (or copies) must be filed no later than *three months* after your RCD application is filed (together with an English language translation, if applicable).
- (6) **Exhibition Priority:** If the applicant disclosed products that incorporated the applied-for design, or to which it was applied, at an exhibition officially recognized by the World Intellectual Property Organization ("WIPO") under the Convention on International Exhibitions *within the last six months*, you may claim exhibition priority from the date of disclosure. In this case, an RCD application should provide the name of the exhibition, *and* the date of the first disclosure of the products in which the applied-for design is incorporated or to which it is applied. However, *within three months* of filing an RCD application, a certificate issued by the authority responsible for the protection of industrial property at that exhibition must also be filed.²⁰ Practically speaking, since WIPO only recognizes very few conventions, this form of priority claim should rarely arise.
- (7) **Publication Deferment:** If, for example, for reasons of keeping the applied-for design secret to the market, the applicant may wish to make a request to defer publication of an RCD application, it is important that the applicant *must* make this request at the time of filing an RCD application. It is *not* possible to request deferment after filing. The applicant can defer publication of an RCD application for up to thirty months after it is filed or from the priority date (whichever is first). The applicant can also interrupt such

¹⁹ If your RCD application is for a *two-dimensional repeating surface pattern*, and you wish to use a specimen, the specimen must also show the complete pattern and a sufficient portion of the repeating surface in length and width.

²⁰ That certificate shall declare that the applied-for design was incorporated in or applied to the product and disclosed at the exhibition, and shall state the opening date of the exhibition and, where the first disclosure of the product did not coincide with the opening date of the exhibition, the date of such first disclosure. The certificate shall be accompanied by an identification of the actual disclosure of the product, duly certified by the authority.

deferment at any time and allow publication. For a multiple design application, the applicant can also choose to have some or all of the applied-for designs deferred.

- (8) **Citation of Designer(s) or Waiver:** Designers have a legal and moral right to be cited as such in an RCD application. It is possible, but not required, under the Regulation to provide *either* the citation of the designer or of the team of designers (even if the applicant(s) is/are different person(s) in the RCD application), *or* a statement signed by the applicant(s) to the effect that the designer or team of designers has waived the right to be cited. Practically speaking, if a parallel design (design patent or utility patent) is being filed in the U.S. where designers *must* be named, it is recommended that you also name them in the RCD application. Furthermore, since a designer or team of designers have the right to be named (or conversely not to be named) in an RCD application, it is best to determine from the designer(s) whether or not they wish to be so named. If *yes*, the name(s) and address(es) of the designer(s) should be provided. If *no*, a written waiver of such right from the designer(s) should be obtained. Then the applicant(s) could make a statement to the effect that the designer or team of designers have waived the right to be cited. Alternatively, if no written waiver can be obtained from any or all of the designer(s), the RCD application could remain silent on this point. If required, the designer(s)' name(s) could be provided subsequently.
- (9) **Power of Attorney:** Again, if the applicant's RCD application is being filed through an agent, a power of attorney is *not* needed to file an RCD application. In certain circumstances, OHIM may subsequently require that a power of attorney be filed. In that case, the applicant's agent may readily arrange for such power of attorney to be executed and filed.²¹

V. CONCLUSION

¶49

The unitary concept of the Community Design, just like the unitary concept of the Community Trade Mark, is an obvious direction to take in supporting the principle of the EU as an internal market without frontiers. Such a borderless internal market only makes sense if intellectual property owners, including American and Canadian companies and individuals doing business in the EU, may easily and (one hopes) inexpensively obtain unitary protection for their intellectual property and, of course, also effectively enforce such rights. The Regulation means that qualifying designs join registered Community Trade Marks as forms of intellectual property subject to such unitary protection for the EU. Questions for the future remain as to whether enforcement under the Regulation of such qualifying design rights will work in practice, and whether other forms of intellectual property (e.g., patents) will also eventually be subject to such unitary EU protection. The Regulation is, however, clearly a victory for the EU's free trade concept.

²¹ For further information on the RCD system, see OAMI-Online *available at* <http://oami.eu.int/en/design/default.htm> (last visited Nov. 12, 2003).