



**OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
TRADE MARKS AND DESIGNS**

REGISTERED COMMUNITY DESIGNS

Application and invalidity procedures

Sandra Ibañez, Information Centre, OHIM

Cluj-Napoca 20 June 2011



What we are going to look at

- **Registered versus Unregistered CD**
- **Registered Community Design (RCD): examples**
- **Practical Aspects: Fees, Priority, Publication, Certificate, Deferment**
- **Registration procedure**
- **Invalidity & case studies**



Difference between a trade mark and a design

TM = distinctive sign to identify products
and services

Design = appearance of a product,
new and with individual character

An applicant may protect the same item
both as a TM and as a design



The Community Design: a two tier protection system

- The **Un**registered Community Design (UCD)
automatic creation as from first disclosure
- The Registered Community Design (RCD)
creation by registration at OHIM



Registered or Unregistered Community Design

Common elements (1)

- Unitary character
(equal effect throughout the EU)
- Definitions
(*design; product; complex product...*)
- Protection requirements
(novelty + individual character)



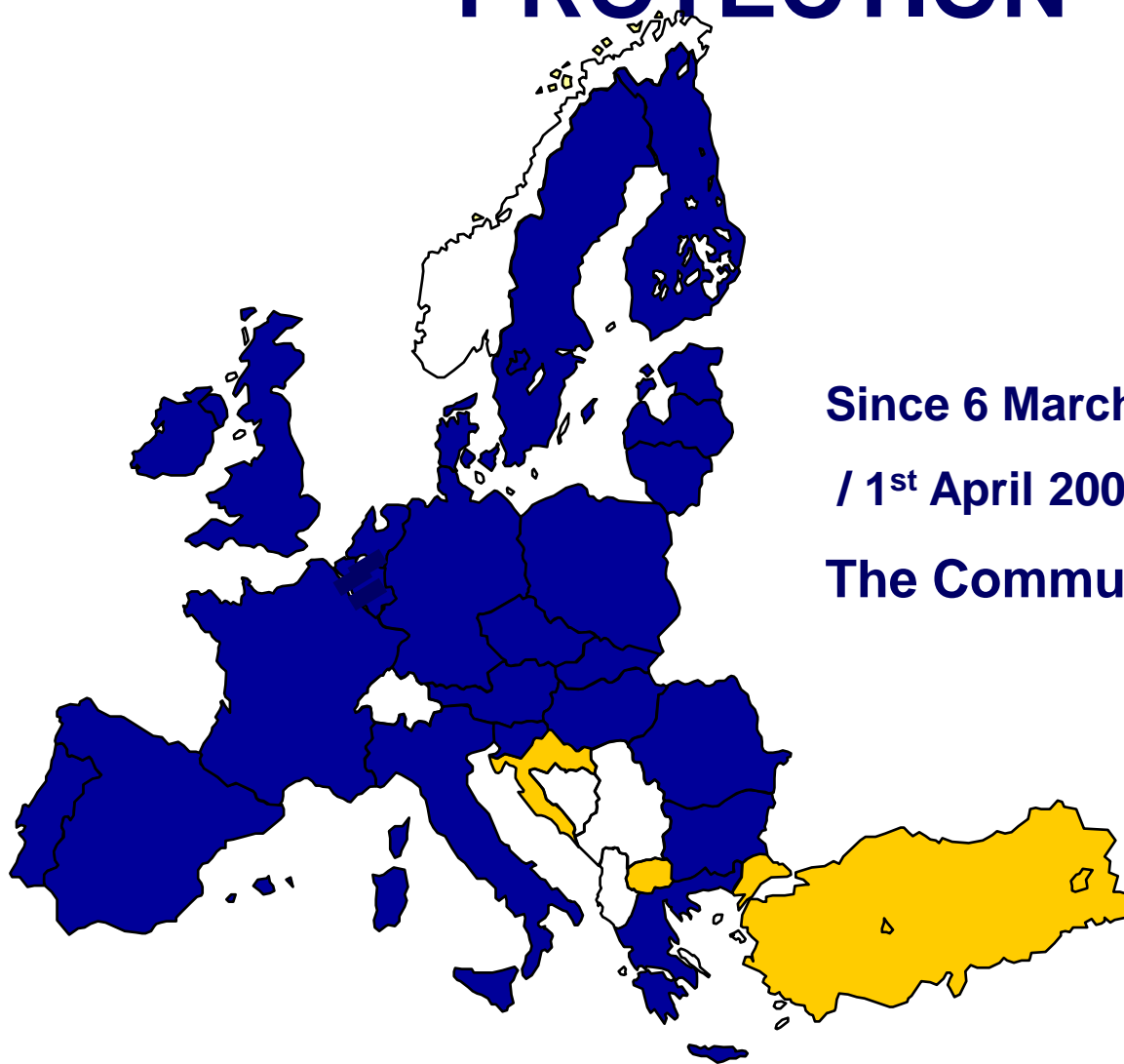
Registered or Unregistered Community Design

Common elements (2)

- Exclusion of protection
(non visible parts, technical functions,
interconnections, against public policy or
morality)
- Scope of protection



COMMUNITY WIDE DESIGN PROTECTION



Since 6 March 2002 (UCD)

/ 1st April 2003 (RCD):

The Community design



Registered or Unregistered Community Design

Differences (1)

- Birth of right
 - RCD ← application for registration
 - UCD ← making available to the public within the Community
- Term of protection
 - RCD ← 5 years renewable 4 times

**Max. 25
years**

- UCD ← 3 years from disclosure



Registered or Unregistered Community Design

Differences (2)

Rights conferred:

(Art 19)

- RCD - exclusive right to use and prevent: making, offering, putting on the market, importing, exporting, using or stocking for such purposes, products incorporating the design
- UCD - right to prevent only if use results from **copying**



Registered or Unregistered Community Design

Unitary character

(Art 1⁽³⁾)

- CD has equal effect throughout the EU
- Registration, transfer, surrender, invalidity, prohibited use always for the entire EU



Advantages of the Registered Community Design

- A **stronger** right with a unitary character in the entire EU
- **Easy, flexible and affordable** filing and registration procedure (one filing language, one application, one fee system, no upper limit to designs in one application)
- **Long term** of protection (up to 25 years)



Weaknesses of the Unregistered Community design

- If first **disclosure in non EU** country, UCD not available
- **Uncertainty** as to disclosure and therefore existence of right
- Problems of **proof** (date, extent, first disclosure, etc)
- Right only against “**copies**”
- **Limited term** of 3 years

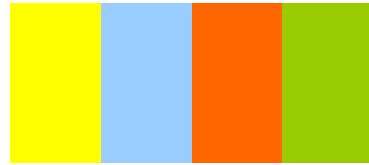


What is a design?

(Art 3 (a))

the appearance of the whole or a part of a product resulting from the features of, in particular, the ...

lines



colours



shape



texture

contours



materials



ornamentation



What is a product?

(Art 3 (b))

“Product”: any industrial or handicraft item, including inter alia

- Parts intended to be assembled into a complex product
- Packaging
- Graphic symbols
- Typographic typefaces

Excluded - computer programs



RCD: Examples

Graphic symbols



RCD 4213 - 0001
(CTM 2705770)



RCD 211 - 0001
(CTM 2995736)



RCD 4502 - 0001
(CTM 1838846)



Registered Community Design

Only big companies protect ?



RCD 307947-0007

Mulberry



RCD 346911-0003

Ruby Wax

NO



RCD 355516-0001

Joakim Liljedahl



Registered Community Design

Only unusual designs can be protected ?



RCD 89354-0001
Rikke Ullersted



RCD 59449-0004
Camper S.L.



RCD 59514-0001
Nike International Ltd.

NO



RCD 95534-0001
Triple Juicy Ltd



Registered Community Design

Remember

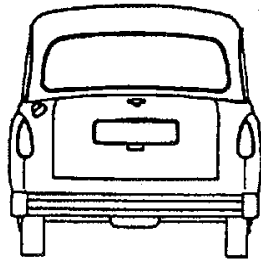
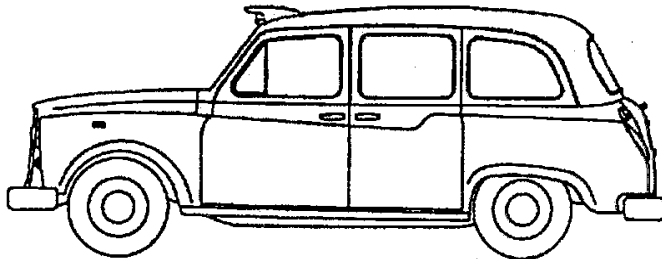
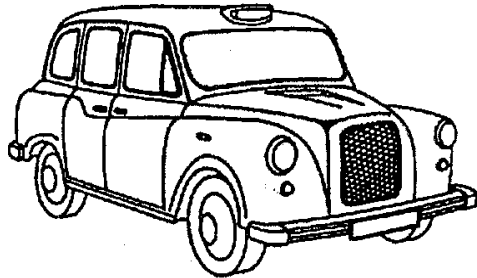
What is protected is the **appearance** of the product and **NOT** :

- the product **itself**
- the technical **function** of the product
- the capacity of a sign **to be distinctive** etc.



Registered Community Design

CTM or RCD?



Application number

000951871

Filing date

05/10/1998

Type of Mark 3 D

Acquired

distinctiveness Yes

Legal status of mark

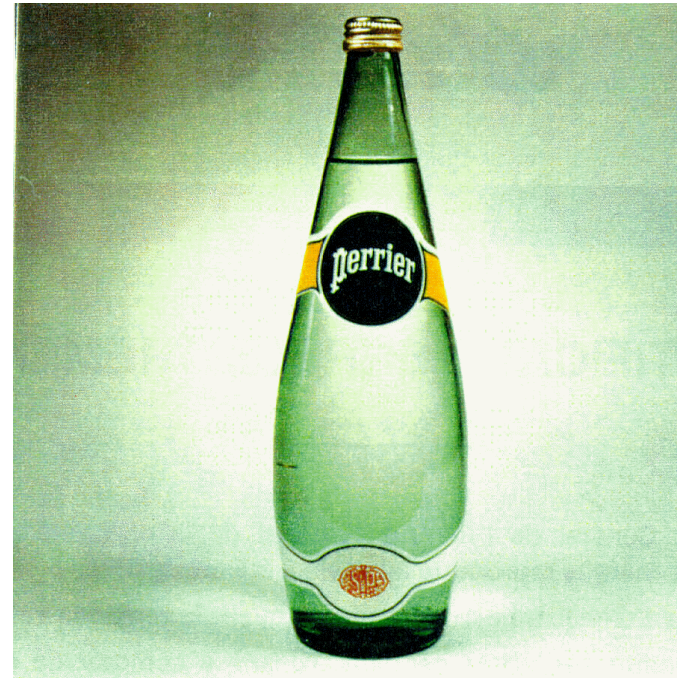
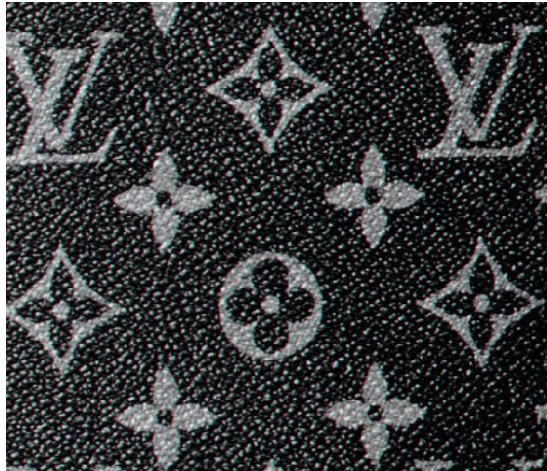
Registration

published



Registered Community Design

Trade marks registered by
OHIM





Registered Community Design

Published in RCD Bulletin 2003-06

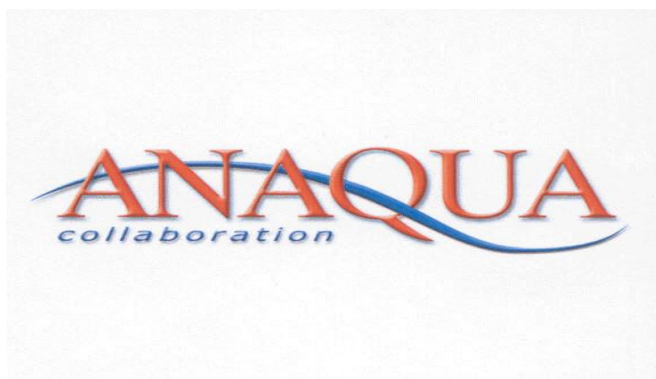


21 000022371-0001
25 EN FR
22 01/04/2003
15 01/04/2003
45 24/06/2003
11 000022371-0001
51 99 - 00

54 ES - Símbolos gráficos
DA - Grafiske symboler
DE - Grafische Symbole
EL - Γραφικά σύμβολα
EN - Graphic symbols
FR - Symboles graphiques
IT - Simboli grafici
NL - Grafische symbolen
PT - Símbolos gráficos
FI - Graafiset merkit
SV - Grafiska symboler



Registered Community Design



CTM

Status Accepted application

First language EN

Second language FR

File No. 003126265

Filing date 09/04/2003

Nice class 9, 35, 38, 42

Trade mark Individual

Type Figurative

Date registration 23/09/2004



RCDS - FEES

Registration fee

- first design 230 €
- from 2nd to 10th design 115 €
- from 11th onwards 50 €

Publication fee

- first design 120 €
- from 2nd to 10th design 60 €
- from 11th onwards 30 €

Deferment fee

- first design 40 €
- from 2nd to 10th design 20 €
- from 11th onwards 10€



RCD – Deferred publication

(Art 50)

- To be requested when application is filed
- Maximum 30 months as from filing or priority date
- Deferment may be interrupted at any time
- Possibility of filing a specimen if two dimensional design
- Except for very limited information, the designs remain secret until holder decides to publish

Registration fee	230 €
Additional registration fee 2-10	115 €
Additional registration fee >11	50 €

Publication fee	120 €
Additional publication fee 2-10	60 €
Additional publication fee >11	30 €

Deferment publication fee	40 €
Additional deferment publication fee 2-10	20 €
Additional deferment publication fee >11	10 €

Fee Calculator

Application

A. How many designs does your application contain?	<input type="text" value="0"/>	<input type="text" value="0"/>	€
B. How many designs do you want to publish immediately?	<input type="text" value="0"/>	<input type="text" value="0"/>	€
C. For how many designs do you wish to defer publication?	<input type="text" value="0"/>	<input type="text" value="0"/>	€
Total		<input type="text" value="0"/>	€

Post-Deferment

D. How many deferred designs do you wish to publish?	<input type="text" value="0"/>	<input type="text" value="0"/>	€
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RCD – Renewal Fees

- Renewal (first) €90
- Renewal (second) €120
- Renewal (third) €150
- Renewal (fourth) €180
- Late Renewal 25% of late fee (per design)



RCDs – Publications

- **The “Community Designs Bulletin”**
 - Periodic editions
 - Only electronic
 - Contains registrations and entries in the Register
- **Data base of registered Community Designs: RCD-ONLINE**



RCDs - Publication

Bulletin View - Microsoft Internet Explorer provided by O.H.I.M.

File Edit View Favorites Tools Help Google Search Web Search Site News PageRank Page Info Up Highlight

Back Forward Stop Refresh Home History Favorites Mail Print Print Preview Edit Full Screen

Address http://oamitest/bulletin/rcd_bulletin_en.htm

Community Designs Bulletin

Contact Home Help

ES DA DE EN EL FR IT NL PT FI SV


bulletin 2003/010 05/08/2003

- Introduction
- A
 - A 1
 - 000018304-0001
 - 000018304-0002
 - 000018304-0003
 - 000018320-0001
 - 000018353-0001
 - 000018411-0001
 - 000018411-0002
 - 000018411-0004
 - 000018411-0005
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 - 000018411-0007
 - 000018452-0001
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 - 000018452-0009
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 - 000018452-0011
 - 000018452-0012
 - 000018452-0013
 - 000018452-0014
 - 000018452-0015
 - 000018478-0001**
 - 000018528-0001
 - 000018668-0001

2003_010/000018478_0001

54 ES - Sillas [asientos]
DA - Stole [siddemøbler]
DE - Stühle
EL - Καρέκλες (καθίσματα)
EN - Chairs [seats]
FR - Chaises [sièges]
IT - Sedie
NL - Stoelen
PT - Cadeiras (assentos)
FI - Tuolit [istuintimet]
SV - Sittmöbler

55 0001 . 1



Done Local intranet

Start Deleted Items - Microsoft E... RCD bulletin - dos boletine... Bulletin View - Micros...

WWW.OAMITEST.ORG.EU



- 000006440-0009
- 000006440-0010
- 000006440-0011
- 000006440-0012
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- 000006440-0014
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- 000006440-0016
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- 000006440-0018
- 000006481-0001
- 000007349-0001
- 000007364-0001
- 000007364-0002
- 000009345-0001
- 000009345-0002
- 000009345-0003
- 000009345-0004
- 000009345-0005
- A.2
- 000001607-0001**
- 000001946-0001
- 000002829-0001
- 000003157-0001
- 000003819-0001
- 000004890-0001
- 000004908-0001

21 000001607-0001

22 01/04/2003

15 01/04/2003

11 000001607-0001

**73 Venus Laboratories, Inc.,
855 Lively Boulevard
Wood Dale, Illinois 60191
ESTADOS UNIDOS (DE AMÉRICA)**

**74 TOMKINS & CO.
5 Dartmouth Road
Dublin 6
IRLANDA**

Publication of a deferred design

+ B

+ C



RCD - Certificate



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Administration of Trade Marks and Designs Department
Register and related databases

Alicante, 15/04/2003

Name and address of applicant or representative

Please find enclosed the certificate of registration for registered Community design No. 000003736-0001.

The registration is published in the Community Designs Bulletin N° 2003/002 of 15/04/2003 at the Internet-address www.oami.eu.int.

The certificate reflects the information as held in the Register of Community designs on the day of issue. Requests for amendment remitted to the Office but not yet processed on the day of issue of the certificate will lead to separate notification, but no new certificate will be issued. The exact status of a design in the Register on any given date (excluding unprocessed applications for amendment) may only be ascertained from an excerpt from the Register.

In the event of an objection relating to the enclosed certificate, we ask you not to return the original. All documents submitted with an objection, including the certificate, will form part of the file and consequently be retained.

Claudio Martinez Möckel

Design N° : 000003736-0001
Your reference : MU609RS/bb
Applicant : Dr. Ing. h. c. F. Porsche AG
Porscheplatz 1
D-70435 Stuttgart
ALEMANIA



OHMI - HARMONISIERUNGSMITTEL FÜR DEN INNENMARKT	MARKEN, MUSTER UND MODELLE TRADE MARKS AND DESIGNS
OHMI - OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET	

EINTRAGUNGSRUKUNDE

CERTIFICATE OF REGISTRATION

Diese Eintragungsurkunde wird für das unten genannte eingetragene Gemeinschaftsgeschmacksmuster ausgestellt. Die entsprechenden Einträge sind in das Register für Gemeinschaftsgeschmacksmuster aufgenommen worden.

This Certificate of Registration is hereby issued for the registered Community design identified below. The corresponding entries have been recorded in the Register of Community designs.

N° 000003736-0001

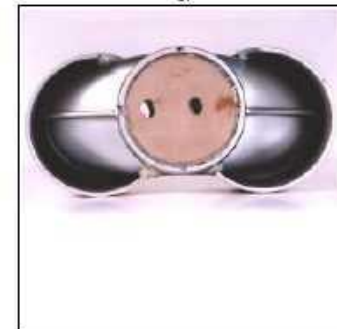
1.



2.



3.





RCD - Certificate



HMW - HARMONISIERUNGSGAMT FÜR DEN BINNENMARKT	BRAND- MUSTER UND MODELLE FRAGE MARKA UND DESIGN
OHMI - OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET	

4.



5.



6.



7.



Registered 01/04/2003

The President.

Wubbo de Boer

N° 000003736-0001

15/04/2003

2 / 3



HMW - HARMONISIERUNGSGAMT FÜR DEN BINNENMARKT	MARKEN- MUSTER UND MODELLE FRAGE MARKA UND DESIGN
OHMI - OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET	

21 000003736-0001

25 DE - EN

22 2003-04-01

15 2003-04-01

45 2003-04-15

11 000003736-0001

73 Dr. Ing. h. c. F. Porsche AG

Porscheplatz 1
D-70435 Stuttgart
ALEMANIA

74 Dr. Ing. h. c. F. Porsche AG

Rüdiger Schwarz
Porscheplatz 1
D-70435 Stuttgart
ALEMANIA

51 12 - 16

54 ES - Tubos de escape

DA - Udstødningsrør

DE - Auspuffrohre

EL - Εξαρτησεις

EN - Tailpipes

FR - Tuyaux d'échappement

IT - Tubi di scappamento

NL - Uitlaatpijpen

PT - Tubos de escape

FI - Pakoputket

SV - Åndrör

57

N° 000003736-0001

15/04/2003

3 / 3



The Registered Community Design system

Registration Procedure



IMPORTANT ASPECTS WHEN FILING AN APPLICATION

Means of filing

- E-filing
- Post
- Fax
 - Risk of bad quality representation
 - Confirmation copy



FILING OF A DESIGN APPLICATION

- 70% on paper
- 30% via e-filing



IMPORTANT ASPECTS WHEN FILING AN APPLICATION

Payment of the fee

- No request for payment sent out
- Fee calculator
- When to do the payment
- Effects on the filing date



EXAMINATION OF AN APPLICATION

(Art 45)

Mainly formalities

- elements provided in application
- priorities
- whether professional representation is required

Grounds for non-registrability

- not a design application
- against public policy and morality



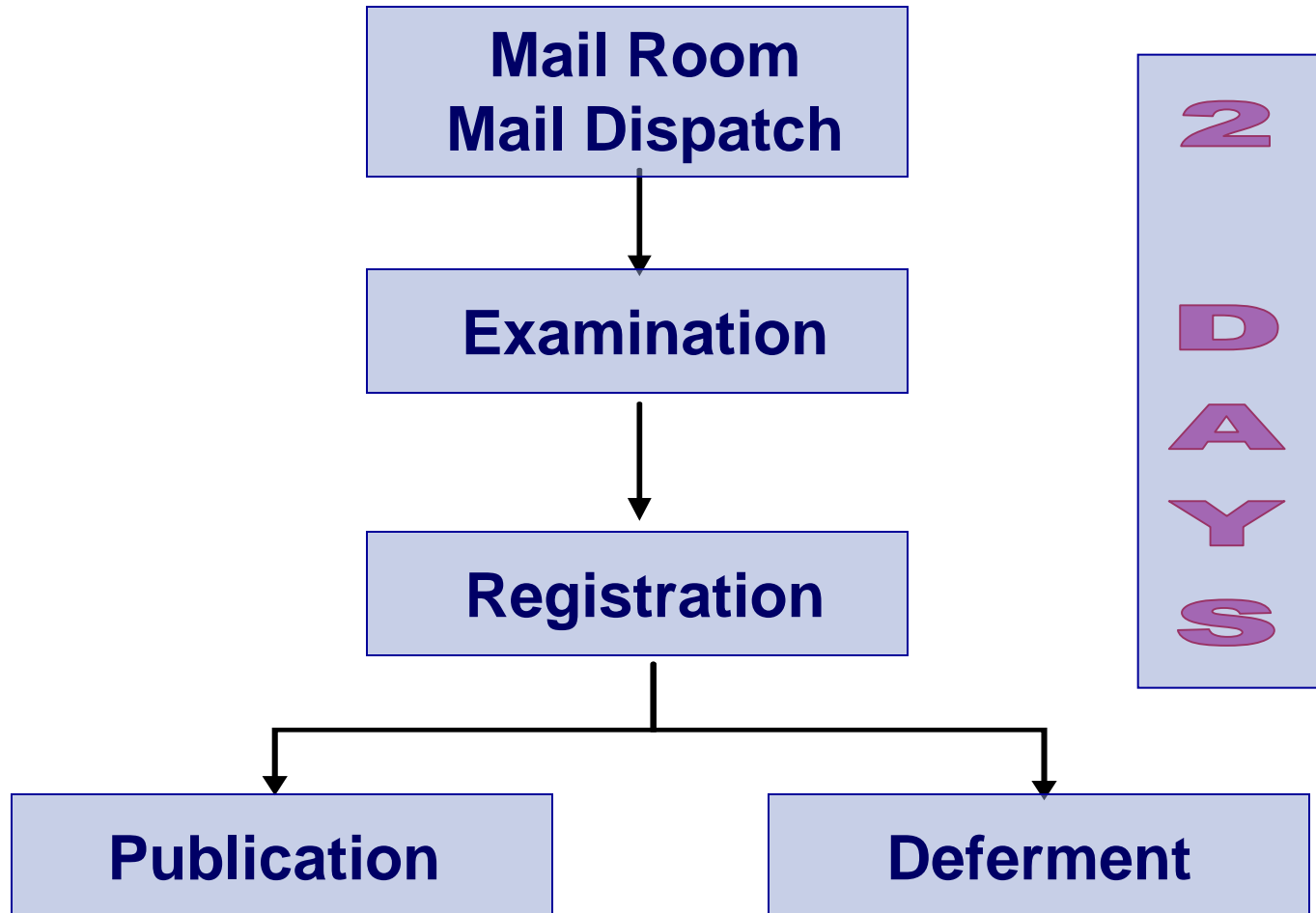
EXAMINATION OF AN APPLICATION

No examination on
verification of protection requirements
relative grounds
whether the applicant is entitled

Objective: Fast and user-friendly procedure



EXAMINATION OF AN APPLICATION





IMPORTANT ASPECTS WHEN FILING AN APPLICATION

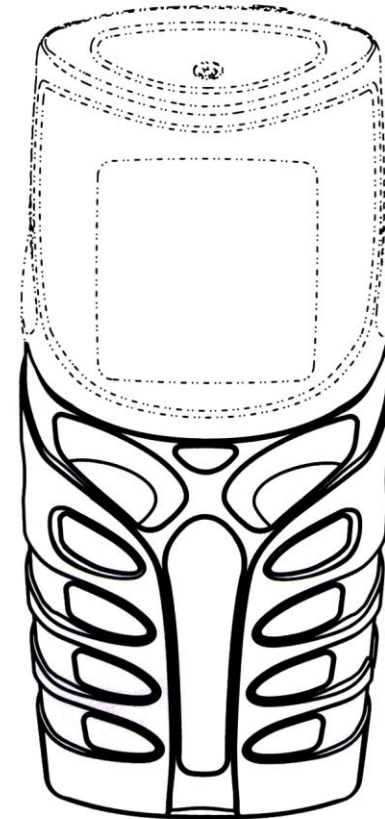
- What is a multiple application?
 - Identity of class
 - Ornamentation
- Deferred publication?
 - Why
 - How long
 - What to observe?



Examination of an Application: Representation

The Office accepts

- Dotted lines to indicate the elements for which no protection is sought or to indicate portions of the design which are not visible in that particular view, i.e. non-visible lines

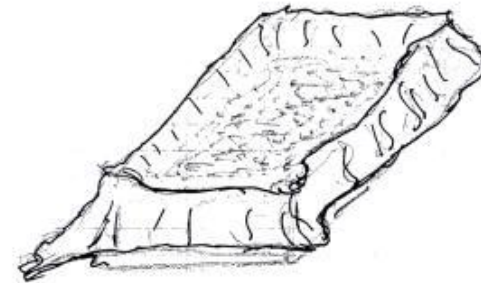
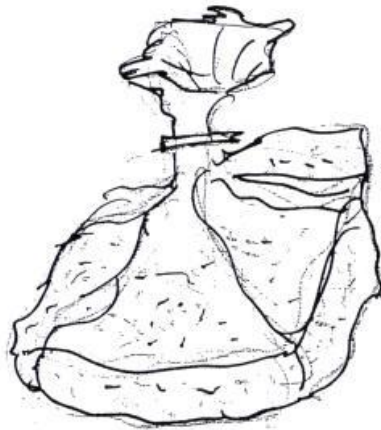


CD 30606-0005



Examination of an Application: Representation

**Designs drawn by hand are
acceptable**



CD 51560



Examination of an Application: Representation

**One product (a toy),
accepted as one design**



CD 293006-0002



Examination of an Application: Representation

**Views relate to the same
design**



CD 231873-0001



Examination of an Application: Representation

- **Implementing Regulation:**
the design must be reproduced on a neutral background.
- **Examination Guidelines:**
a background is considered neutral as long as the design is clearly discernible on it.
e.g.: acceptable



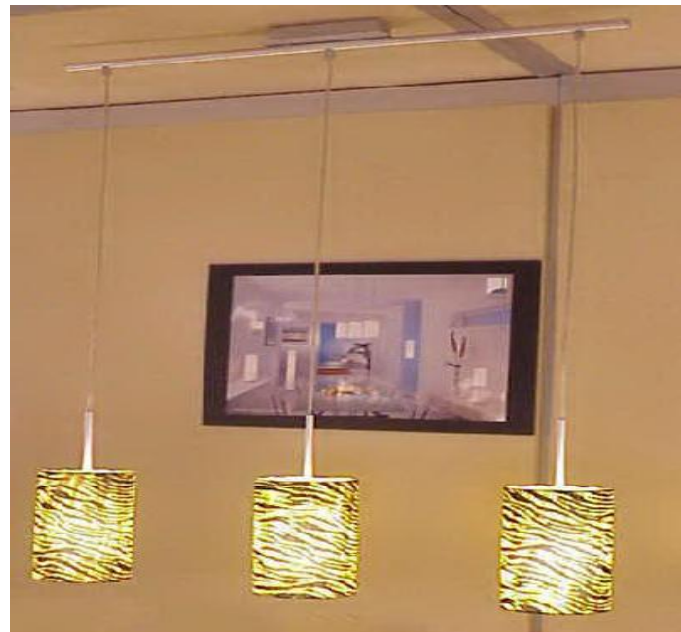


OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
TRADE MARKS AND DESIGNS

**Not acceptable, new view
necessary**



CD 312210



CD 313150



Examination of an Application: Representation

Views relate to the same design



CD 238092-0001

WWW.DAMI.EUROPA.EU



Examination of an Application: Sets

The Office accepts



CD 63664



CD 88562



CD 187018



Examination of an Application

Public policy

- Obscene and/or immoral images are against public policy or accepted principles of morality
- The difference between these and images which are simply in bad taste is often hard to define



Examination of an Application: Multiple application

Example (class 06)





Examination of an Application: Exception of unity of class

OAMI-ONLINE - EUROLOCARNO-ONLINE - Windows Internet Explorer provided by OAMI

File Edit View Favorites Tools Help

Address http://oami.europa.eu/search/eurolocarno/la/en_el_search.cfm?

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OHIM THE TRADE MARKS AND DESIGNS REGISTRATION OFFICE OF THE EUROPEAN UNION

Home | Trade Marks | Designs | **Quality plus** | About OHIM

You are here: [Home](#) > [Quality plus](#) > Databases

Quality plus

- ▶ Quality management system
- ▶ Service charter
- ▶ User satisfaction survey
- ▶ Complaints unit
- ▶ Technical Cooperation agreements with National offices
- ▶ Networks and Users' Groups
- ▶ Links
- ▶ MyPage
- ▶ Databases**
 - Search a Community trade mark
 - Search a Community design
 - Search classification for trade marks - EURONICE/EUROACE
 - Search classification for designs - EUROLOCARNO**
 - Search for representatives - FindRep
 - EuroClass

Search facility for Locarno classification and/or Eurolocarno indication of product

Please enter your search criteria below

Language: English

Indication of product:

Locarno classification: Any . Any

[Search](#) [Clear](#)

OHIM Header | Local intranet

EuroLocarno online



FAQs received by Information Centre

Q: How many views may be filed? Can I write on them?

A: A maximum of 7 views. You cannot write on them.



FAQs received by Information Centre

Q: Does OHIM perform a search on earlier rights?

A: No, novelty and individual character is not checked by OHIM.



FAQs received by Information Centre

Q: What does grace period mean and what is it good for?

A: Within 12 months from first disclosure you may file an RCD without destroying novelty. It allows you to decide whether or not to register your design within one year.



INVALIDITY

Two ways to invalidate a registered CD

- Application to the OHIM

(Art 24 (2))

- Counterclaim in infringement proceeding
before a Community design Court

(Art 24 (3))



INVALIDITY

Consequences of invalidity

(Art 26)

- the RCD is invalidated “ex tunc”
- invalidity is for the whole EU territory
- invalidity can be partial
- effects can be limited subject to national provisions



INVALIDITY

Grounds for Invalidity (Art. 25(1) CDR)

- not a design (a)
- **does not fulfil requirements of Art 4-9 novelty, individual character, offends public policy or morality etc. (b)**
- holder not entitled (c)
- anticipated by prior design (d)
- interfering earlier rights (f)
- improper use of certain emblems etc. (g)



Requirements for protecting a design:

- **Novelty (= no prior identical design exists)**
and
- **Individual character (= no prior design that gives a similar overall impression exists)**
and

**NOT examined by the OHIM during registration
process**



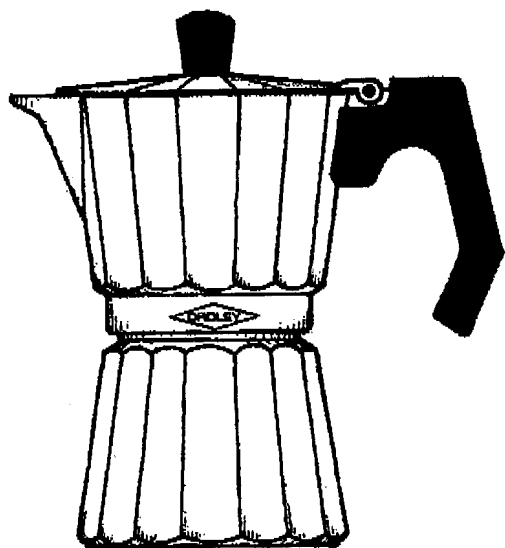
INVALIDITY

decisions of OHIM



INVALIDITY: Decisions

8 November 2006, R 0216/2005-3



prior design
(CTM 998450)



RCD 5269-0001

identical
(Invalidity Division confirmed)

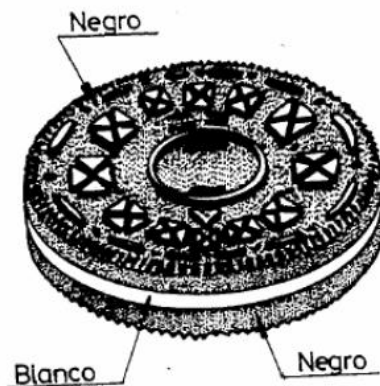


INVALIDITY: Decisions

28 November 2006, R 1310/2005-3



Marca nº 2.516.524



Marca nº 1.997.588

prior design
(Spanish trademark)



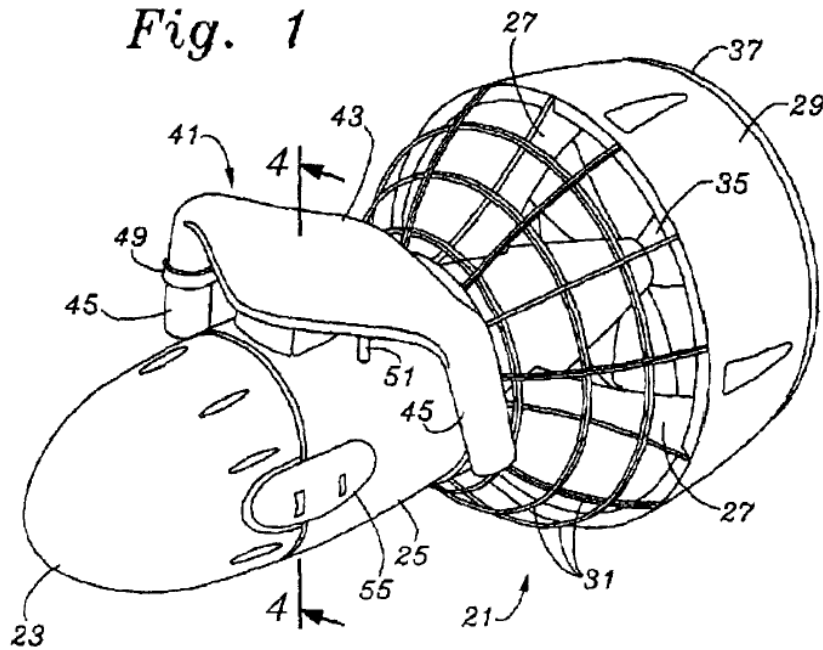
RCD 58334-0001

same overall impression
(Invalidity Division confirmed)

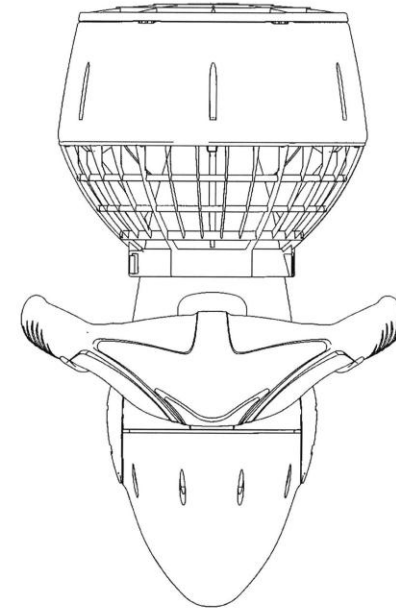


INVALIDITY: Decisions

22 November 2006, R 196/2006-3



prior design



RCD 225073-0001

same overall impression
(Invalidity Division confirmed)



INVALIDITY: Decisions

3 April 2007, ICD 2772



prior design



RCD 212097-0006

same overall impression



INVALIDITY: Decisions

5 April 2007, ICD 2566



prior design
(RCD 258546-0001)



RCD 341748-0009

different overall impressions



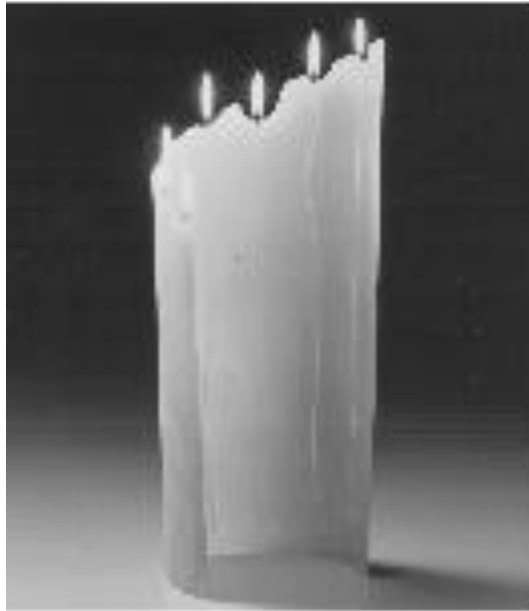
INVALIDITY: Decision

23 April 2007, ICD 2707

3.1



3.2



prior design
(International Registration)

RCD 425608-0015

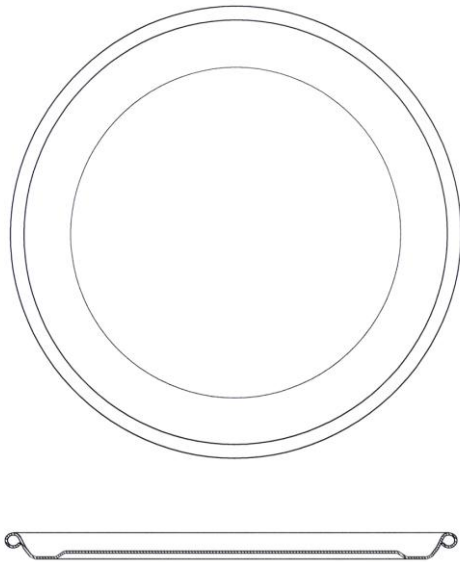
different overall impressions



INVALIDITY: Decision

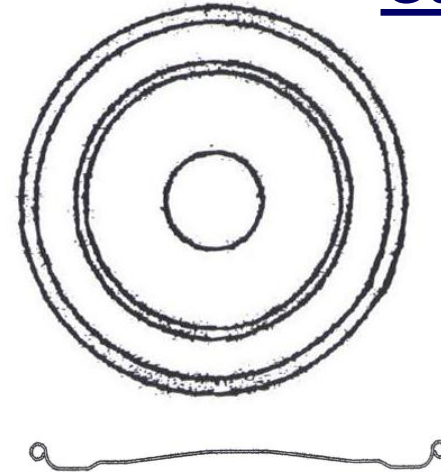
27 October 2006, R 1001/2005-3

METAL
RAPPERS
Case



prior design

(Spanish registered design)



RCD 74463-0001

OHIM : same overall impression

3rd Board of Appeal : different overall impression

Court of Justice: same overall impression

Invalidity Division FINALLY CONFIRMED



**OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET**
TRADE MARKS AND DESIGNS

OHIM Contact Information:



(+ 34) 96 513 9100



(+ 34) 96 513 1344



information@oami.europa.eu



Office for Harmonization in the Internal
Market (Trade Marks and Designs)
Avenida de Europa, 4
E-03008 Alicante
SPAIN