

The Law and Economics of Design Protection in Europe

The basic structure of European legal protection of design

- ☉ The term design is one particularly difficult to define precisely, either for theoretical, practical, or for legal purposes
- ☉ Design might be considered the arrangement, layout, or external appearance of a product
- ☉ Prior to the EU legislative initiatives, legal protection of design was extremely fragmented:
 - i** Some countries had a *sui generis* protection for design, sometimes based on registration, sometimes even if unregistered (UK)
 - ii** Design could also be protected under Copyright Law if achieved the status of *applied art*
 - iii** Some countries (D, E, I, etc.) have *utility model protection* typically running for 10 years (similar to the US design patent) for functional design with a pure *technical function*, but failing the patentability requirements

iv Certain designs (shapes, packages, etc. that identify a brand of a given product) can also be protected by trade marks, if fulfilling the required conditions

☐ Following a 1991 Green Paper, the EU decided to intervene with legislative measures on the legal regulation of design: Directive 98/71 on harmonisation of the Law of registered design, and Regulation 6/2000, on Community design (both registered and unregistered)

☐ Not very differently from trademark Law, design Law in Europe is also multi-layered

i. National registered design systems: independent, with their own rules, requirements and procedures, although heavily harmonized by Directive 98/71

ii. The European Union level: Regulation 6/2002 40/94 created a Community Design of 2 different kinds

iii. National unregistered design and alternative means of protection remain untouched (trade marks, utility models, *sui generis* unregistered design protection)

iv. International level:

- Some provisions in the Berne and Paris Conventions

- Hague Agreement: Create international application mechanisms, through WIPO

sends application to designated national authorities

- **WTO Agreement:** artt. 25 and 26 provide for protection of new or original industrial designs

- ☐ The 1998 **Directive** contains the **main rules common to all EU national registered design systems**, and also to the registered Community Design
- ☐ **Directive** defines design as the appearance of the whole or a part of a product (any industrial or handicraft item, except computer programs) resulting from the features of the lines, contours, colors, shapes, texture and/or material
- ☐ **Requirements** for protection
 - i. Registration:** registered design has to be registered, and is awarded to the **first to file**, not the first to use
 - ii Novelty:** anything that has not been made available to the public. Novelty is not lacking if a prior disclosure was
 - Unknown by the relevant business community inside the EU
 - Made within 12 preceding months by designer or with her consent

- The result of breach of confidentiality towards the designer

 - iii. Individual character:** the overall impression on an informed user differs from overall impression of any design made available to the public before

 - v. Non exclusive functionality:** features which are solely dictated by the design's technical function are excluded. Functional designs as such are admitted, only the purely functional aspects are not

 - vi. Not a mechanical interface:** features which are solely dictated by need to mechanically connect the product to another one to perform function
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- ☐ Design protection is excluded on absolute grounds
 - i. Design contrary to public policy or morality**
 - ii. Design copied from a prior design**

 - ☐ Design protection is excluded on relative grounds
 - i. Conflicts with an existing trade mark**
 - ii. Conflicts with an existing copyright**

- ☐ Rights conferred by the Registered Design → rightholder has the exclusive right
 - To use and market products incorporating the design
 - To prevent the use of any design, even independently developed, which does not produce on an informed user a different overall impression

- ☐ Registered design right does not prevent (if the permitted acts are fair, and do not unduly prejudice the normal exploitation of design)
 - i.** Private uses with no commercial purpose
 - ii.** Fair use in teaching, research
 - iii.** Experimental uses
 - iv.** Citations and commentary

- ☐ Registered design protection is exhausted
 - i.** For goods voluntarily put on the EEA market
 - ii.** No exhaustion of rights if put on the market outside the EEA, unless import had been expressly consented to

- ☐ Term of protection should be 5 years, renewable up to a maximum of 25

- ☐ The Community Design Regulation contains a **uniform set of rights** valid and effective throughout the EU
- ☐ The Community Design Regulation covers **both Registered and Unregistered design**
- ☐ Community **Registered Design** is administered by the **OHIM** (Alicante), with **substantive rules and requirements that mirror those in the Directive 98/71**
- ☐ Community **Unregistered Design**
 - i.** Has to fulfil the **substantive** (that is, except registration) **requirements of the Registered Design**
 - ii.** **Has been made available to the public** (published, exhibited, used in trade, or otherwise made known to the relevant sector within the EU). Communication under duty of confidentiality does not satisfy this disclosure requirement
 - iii.** Unregistered design right only allows the rightholder to **prevent use of a design if it has been copied from the unregistered, not if it has been independently created**
 - iv.** Term of protection is **3 years** from the time of making it available to the public in the EU