

DESIGNS, a user's guide ...

What is a design?

A registered design is an industrial property right that protects the decorative or aesthetic aspect of a product. It can be two-dimensional (pattern, lines or colors) or three-dimensional (the shape of the product). The aesthetic aspect of a product can also result from, amongst other features, its texture, the materials used or its ornamentation.

Protection confers a monopoly right on the holder, allowing him to prohibit any third party from copying or imitating the design without his consent.

What can be protected by design registration?

Any kind of industrial or handicraft product, such as watches, jewellery, medical instruments, household articles, furniture, architectural structures, typographic characters and many other objects can be protected by a registered design.

However, the following products cannot be protected: parts that are not visible once incorporated into complex products; products whose shape is dictated by the function of the product; components that are integrated to ensure the proper working of a complex product.

What criteria must be fulfilled for a design to be registered?

In order to register a design, certain criteria must be fulfilled.

- The object has to have an aesthetic nature and its shape must not be dictated exclusively by technical or functional considerations.
- It must be reproducible by industrial processes (unlike a work of art)

Each country has criteria set out in its national law regarding the registration of designs. Among those criteria which are common to most national laws, there are the requirements of:

- **novelty**: the design must not have been disclosed to the public prior to filing;
- **originality (also referred to as individual character)**: it has to distinguish itself from existing objects by features which are not merely minor features.

The precise definitions of novelty and originality vary from one country to another. Generally, novelty is not absolute within the meaning of patent law (which stipulates that any written or oral disclosure, in any language, and whatever the country where the disclosure took place, is destructive of novelty). As regards designs, numerous countries consider that novelty is only destroyed if the disclosure took place in the country in which protection is sought and is known to people within the circle concerned. Certain countries allow a grace period (generally of one year) during which the creator is authorized to reveal his design without destroying novelty. This is the case for Switzerland, the European Community,...

What are the differences between a patent and a registered design?

A registered design protects the aesthetic or decorative appearance of an object. This appearance must not be dictated by technical or functional considerations. The patent, conversely, protects technical features, and excludes aesthetic considerations. Broadly speaking, the inside is protected by the patent (technical

solutions) while the outside is protected by the registered design, and their fields of protection are complementary.

What are the differences between a trademark and a registered design?

The first objective of the trademark is to distinguish the products of a company from those of its competitors and thus to create an added value on a name or a logo. The trademark can be associated with several different products, for example with all of the company's products and services. It acquires its value through use (advertisement, reputation).

The objective of a registered design is to protect the aesthetic aspect of an object and thus a creative effort. It is originality which establishes its main value.

Broadly speaking, the name or logo affixed to an object is protected by a trademark while its outside shape is protected by a registered design, and their fields of protection are complementary.

Nevertheless, the shape of a product may be protected as a three-dimensional trademark. Indeed, Swiss trademark law allows registration of trademarks composed of the shape of an object, provided the shape is sufficiently distinctive. However, this will rarely be the case and for this reason design registration should be preferred. Depending upon circumstances, and particularly if the object in question has been so successful in the public eye that it has become a distinguishing feature of its creator, there will always be time to file a trademark application, based on the fact that the object in question has acquired the distinctiveness required by law.

What are the differences between copyright protection and protection by design registration?

Broadly speaking, copyright protects works of art, whereas design registration is intended for utilitarian, industrial or consumer goods.

However, depending upon the country concerned, cumulative protection by copyright and design registration may be allowed. This is the case in particular in the European Community, where regulations on community design registration expressly provide that a protected design also benefits from the protection granted by the national copyright law of the concerned member states, the criteria and the scope of this protection being defined by the national law in question.

In Switzerland, both protections can be cumulated, provided the object protected by design registration fulfills the condition of *individual character* required by copyright law. Thus, it is a matter of interpretation as to whether a specific object registered as a design also benefits from copyright protection.

When should the design be protected?

Given the requirement of novelty, it is important, in those countries that do not allow a grace period, to file the design application before disclosing it publicly. This disclosure is however effective only if the design is presented outside of the company, employees being automatically subject to confidentiality. Great care must be taken in relations with subcontractors and suppliers.

In those countries that allow a grace period (like Switzerland), the design application must necessarily be filed before the end of the grace period.

It is important to be aware that the design right belongs to the first person to file. Therefore, the earlier the design application is filed, the greater the chances of being the first one to file.

What does a design application contain?

An application to register a design contains two compulsory parts and one part that is optional under the national law of certain countries, and compulsory under others. It contains one or several representations of the design to be protected. The optional part may contain a brief description of the products to be protected.

A design application can contain several designs. Under the national law of most countries, all the designs of one application must belong to the same class under the Locarno Classification, which means that the designs must concern the same kind of products.

The representations can be pictures or drawings, in black / white or in color.

What is the procedure?

First filing

The usual way to protect a design consists in filing an application in the country in which the holder is commercially active or has his company head office.

The filing date in this country constitutes the date of the start of protection. If the holder is a national or resident of a member state of the Paris Convention, priority can be claimed with extensions (within 6 months)

Extensions

To protect a design in countries other than the country of origin, several options are available, depending upon the country. These are:

- filing an **international design application** under the Hague Agreement,
- filing a **community design application** or
- filing **national design applications**.

Filing a Swiss design application (first filing).

In Switzerland the term of protection of a registered design is 5 years, renewable every 5 years up to a maximum of 25 years. As a general rule, registered designs are published shortly after filing. It is however possible to delay publication by up to a maximum of 30 months after the filing date by requesting postponement of publication. This is useful for protecting the exclusivity of a presentation during a fair for example.

Filing an international design application (under the Hague Agreement)

By filing an international design application, design protection covering the designated member states of the Hague Agreement, can be obtained in a single procedure. The effect of protection in each of the chosen countries is the same as that of a national filing. It is possible to choose one or several countries from the list of states party to this Agreement (see enclosed list). It should be noted that, unlike international trademarks, it is not possible to designate the European Community in an international design application.

This route is open to all physical or moral persons having a business or place of residence in the territory of one of the contracting states or being a national of such a state. International filing does not require preliminary national filing. It is possible to request the protection of a design in "the state of origin " of the applicant.

A design can be governed by the "1960 Act" if the applicant chooses only states bound exclusively by the 1960 Act, or by the "1999 Act" in the other cases. When a state is bound both by the 1960 Act and the 1999 Act, the 1999 Act prevails.

The term of protection is at least 15 years. The registered design is subject to renewal 5 years after filing. In those countries where the national law provides a term of protection of more than 15 years, it is possible to renew the registered design every 5 years, until the term reaches the maximum protection stipulated by the national law in the state concerned.

Filing a European Community design application

Community design protection covers the 28 states of the European Union, i.e. Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, The Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and United Kingdom. It is unitary which means that it is not one State that registers the design, but a central Office based in Alicante (Spain). Unlike international designs registered under the Hague Agreement, it is not possible to choose only part of the member states: all of the states are automatically covered.

The criteria for obtaining design protection are novelty and individual character. The European Union however allows a grace period of one year before the design application has to be filed. During this period, the product can be marketed without destroying novelty.

There are two different types of community designs, namely registered designs and unregistered designs.

Registered community designs

This type of protection involves filing an application and the payment of the required fees. It has a term of protection of 5 years, renewable every 5 years up to a maximum of 25 years.

Unregistered community designs

Unregistered designs have to fulfill the same criteria as registered designs - they must be novel and have individual character - to benefit from protection.

This protection is applicable from the date on which the designs were disclosed to the public within the European Union. Disclosure can occur either by selling the objects or by marketing actions or advertising. The term of protection is three years.

Differences between a registered design and an unregistered design

There are two essential differences between these two types of protection. First, the term of protection, which is a maximum of 25 years for a registered design and three years for an unregistered design, and secondly, the degree of protection. A registered design protects the product against unauthorized systematic copying as well as against development of similar designs (imitation). An unregistered design only protects the product against unauthorized systematic copying.

A registered design enjoys protection from a definite date, which is the filing date. The starting point for protection of an unregistered design is the first disclosure date. In practice, it can often be particularly difficult to prove the existence of protection in the case of an unregistered design.

National design application

This route is the only possible way to obtain protection in countries that are neither members of the European Union, nor members of the Hague Agreement. This is the case for example for China or the United States.