

## Client Alert

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Trademarks

Intellectual  
Property

## European Community Design Registration

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Most people are aware of the importance of filing trademarks in order to protect their intellectual property rights and their brand. Many are not as familiar with registered design rights and the importance they can play in protecting intellectual property rights and a brand.

### Background to the Registered Community Design System

Until recently, design protection in the European Union comprised a number of different national laws in each member state, each of which conferred different levels of protection in that state. In April 2003, the Registered Community Design System introduced a new type of intellectual property right for protecting designs and logos, with harmonized rights and characteristics throughout the European Union<sup>1</sup>. This new right is already proving popular, with approximately sixty thousand applications so far, and efficient, as registration takes only three months regardless of how complex or stylized the design is.

### What can be protected

A “design” is defined very broadly as “the appearance of the whole or a part of a product resulting from the features of, and in particular, the lines, materials, colors, contours, shapes, texture and ornamentation of the product”. What this means is that a design which is part of the logo, the “house style” or the general “look and feel” of a business can be registered, and that registration will protect the use of that design in a number of contexts. There is clearly an overlap with what can be protected using trademarks and whilst this in no way replaces trademark protection, it is perhaps a valuable alternative or ally, depending on the nature of the design, the budget and the protection required.

### Advantage of the Registered Community Design System over national applications

As with the European Community Trademark, the advantage of the Registered Community Design System is that it allows an applicant to file one design application and, providing the application is successful, register a design across the whole of the European Community at a fraction of the cost of applying for the design nationally in each country forming part of the European Community. Since 1 May 2004 this has extended to a further ten countries, making the total of twenty five countries covered by the European Community.



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<sup>1</sup> EU countries currently include: Austria; Belgium; Cyprus; Czech Republic; Denmark; Estonia; Finland; France; Germany; Greece; Hungary; Ireland; Italy; Latvia; Lithuania; Luxembourg; Malta; The Netherlands; Poland; Portugal; Slovakia; Slovenia; Spain; Sweden; United Kingdom

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### Unregistered Community Design; no application procedure but no monopoly right

Within Europe, in addition to a Registered Community Design, there are also other ways of protecting designs *inter alia*: copyright, national unregistered design rights, utility models and unregistered Community Designs. Unregistered Community Designs are also new and provide short-term protection within the EU against the copying of a design. 'Copying' requires the infringer to have knowledge of the protected design but does not mean that protection is limited to an exact copy. Unregistered Community Design lasts for a period of three years from the date on which the design was first made available to the public within the EU. Significantly, if the design was first made available outside the EU, this may preclude protection for Unregistered Community Design. Unregistered Community Design differs from Registered Community Design in two crucial respects: the Registered Community Design provides a much stronger right in that it affords the holder a monopoly over that design, and it easily affords protection to companies not based in Europe.

### Rights granted by a Registered Community Design

Arguably, the Registered Community Design confers a greater monopoly right than the Community Trade Mark. A Registered Community Design provides its holder the exclusive right to use the design and to prevent the making, offering, putting on the market, importing, exporting, using or stocking for such purposes by others of products incorporating the design. This right provides protection regardless of the class for which the design is registered. This contrasts with a Community Trade Mark, which provides protection to the extent that an infringing trade mark is either identical or similar and for identical or similar goods. A Community Trade Mark generally only provides protection for specific classes of goods.

The basic registration fee (including both application and publication fee) for the first design is €350, with lower fees being payable for further designs being registered at the same time.

An unlimited number of designs for 2-dimensional ornamentation (e.g. a logo trademark) may be included in a single application; the advantage being that one or more products, their packaging and the trademarks applied to them can be covered by a single application.

### Requirement for protection

As with any national design registration system, a requirement to obtaining protection is that the design is both novel, in that no identical design has been made available to the public, and of "individual character", which essentially means that it doesn't bring to mind any existing design. In addition, there are further exclusions to registration which, for example, include a prohibition on registering designs for non-visible parts. Products which are incorporated into another product will only be protected insofar as they remain visible once incorporated.

### Length and extent of protection

Each registered community design will be protected for up to a maximum of twenty five years from the date of filing. Registration will initially confer protection for a period of five years from the date of filing, but can be renewed up to four times. A Registered Community Design will not only allow the rights' holder to prevent third parties from copying its design but also prevent a third party from using any design that is independently created, if it can be shown



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that the later design is identical or creates the same "overall impression" as the earlier registered design. To avoid losing a competitive advantage, applicants for a registered community design are able to defer publication of their design for thirty months, enabling designs to be kept secret until they are put on the market.

Community Designs registered so far have included typefaces, cartoon characters, flow charts (under the guise of teaching material), containers, shapes, labels and logos.

### Case law illustrating the importance of Community Designs

*Mattel Inc v (1) Woolbro Ltd (Distributors) (2) Simba-Toys Ltd (Hong Kong) (3) Simba-Toys GmbH & Co KG [unreported, Oct 2003]*

The case of *Mattel v. Simba* highlights a particular advantage of a Registered Community Design Right, namely the possibility in one infringement action of obtaining an injunction against infringement which is valid throughout the whole of the European Community.

This infringement claim arose in the world of fashion dolls. The claimant is a well-known manufacturer of toys, including a range of dolls, sold under a variety of names including "Barbie". In July 2003, Mattel started proceedings against dolls designed by the Hong Kong subsidiary of the German Company Simba under the trademark "My Style". The "My Style" dolls bore a number of marked similarities to the Mattel product "My Scene" dolls including head shape, face paint and overall appearance. Significantly, a three dimensional scan of the dolls' heads showed that the "My Style" head was very similar to that of the "My Scene" dolls. The claimant made enquiries of the defendant's distributors obtaining brochures and samples. In the face of the evidence, the claimant obtained a comprehensive order, including a declaration that the "My Style" dolls were infringing goods.

As the defendants withdrew their defense and submitted to judgment, there has been no judicial interpretation. Nonetheless, this case illustrates the importance of European Community Design rights, the court ordered Simba to stop manufacturing, distributing and selling the "My Style" dolls in all countries of the European Community. Furthermore, Simba was ordered to request the return of any stocks of "My Style" dolls from its retailers and other customers, as well as infringing products such as brochures. In addition the court awarded costs and damages to Mattel.

### Comparative time and cost of European Community Trademark Registration and European Community Design Registration

#### Official Fees

- ▶ The official fees for registration and publication of a European Community Design are \$455.
- ▶ The official fees for filing and registration of a European Community Trademark are \$2,700.

#### Time Estimate to Grant

- ▶ The approximate time for prosecution of a European Community Design is between 3- 12 months.
- ▶ The approximate time for prosecution of a European Community Trademark is 18 months (assuming no opposition).



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