



SCHWEGMAN
LUNDBERG • WOESSNER
A PROFESSIONAL ASSOCIATION | SLWIP.COM

PATENT PROTECTION FOR HIGH TECHNOLOGY

(E)U Got the Look **Design Protection in Europe**

January 30th 2020
John Gray – UK of Counsel
Schwegman Lundberg Woessner Ltd.

(E)U Got the Look – Seminar Overview

- **EU registered designs ('RCD')**
 - Basic features
 - Novelty & Individual Character
 - Excluded features
 - Scope of Protection
 - Compare with U.S. practice: good points & dangers
 - Visual disclaimers at work
- **Brexit**
 - Transitional arrangements & UK registered designs
- **Unregistered Design Rights**
- **Q & A**

EU registered designs: Basic features



- Registered Community Designs (“RCDs”)
 - Single right for whole EU i.e. 28 countries, population >510m
 - Very quick to grant (but can defer publication up to **30m**)
 - Wide range of designs (shape, pattern, graphic icons etc.)
 - Multiple designs per application
 - Enforcement in national courts/takedown
 - Invalidation in EUIPO/EU courts
 - Lasts up to 25 years (renew every 5 years)
 - **WIPO** | **HAGUE** member



COUNCIL REGULATION
(EC) 6/2002 on
Community designs
(OJ EC No L 3 of
5.1.2002, p. 1)
amended No
1891/2006 No 40/94
(OJ EC No L 386 of
29.12.2006, p. 14)

EU registered designs: Novelty

- (Article 5) **Novelty**

1. A design shall be considered to be **new if no identical design has been made available to the public** [...] before the date of filing of the application registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.

2. Designs shall be deemed to be **identical** if their features **differ only in immaterial details**.

- Exceptions to prior art:

- (Art 7(1)) [...] published [...], or exhibited, used in trade or otherwise disclosed, [...] **except** where these events **could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community**. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.
- (Art 7(2)) **Grace Period** – 12 months before filing/priority date

EU registered designs: Originality – “Individual Character”

- (Article 6) **Individual Character**

1. A design shall be considered to have **individual character** if the **overall impression** it produces on the **informed user** differs from the **overall impression** produced on such a user by any design which has been **made available to the public** [...]

2. In assessing individual character, **the degree of freedom of the designer** in developing the design **shall be taken into consideration**.

- Who is “the informed user”?

“... not ... a user of average attention, but ... a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question.” (Grupo Promer v Pepsico C-281/10P at 53)



EU registered designs: Excluded features

- Article 8

dictated by function

1. A Community design shall **not** subsist in **features** of appearance of a **product** which are **solely dictated by its technical function**.

2. A Community design shall **not** subsist in features of appearance of a product which must **necessarily** be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied **to be mechanically connected to or placed in, around or against another product so that either product may perform its function**.

3. Notwithstanding paragraph 2, a Community design shall under the conditions set out in Articles 5 and 6 subsist in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system.



“must fit”

- Article 110

1. Until such time as amendments to this Regulation enter into force on a proposal from the Commission on this subject, protection as a Community design shall not exist for a design which constitutes a **component part of a complex product** used within the meaning of Article 19(1) **for the purpose of the repair** of that complex product **so as to restore its original appearance**.

“must match”

EU registered designs: Scope of Protection

- Art 10 Scope of Protection

*1. The scope of the protection conferred by a Community design shall include **any design which does not produce on the informed user a different overall impression.***

*2. In assessing the scope of protection, **the degree of freedom of the designer** in developing his design shall be taken into consideration.*

- Scope defined by drawings/images only.
 - Words are ignored (Designation of article, description, class)
 - Visual disclaimers work (usually!)
 - Multiple designs → multiple “claims”.

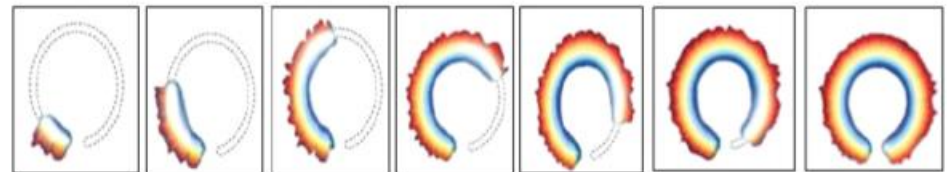
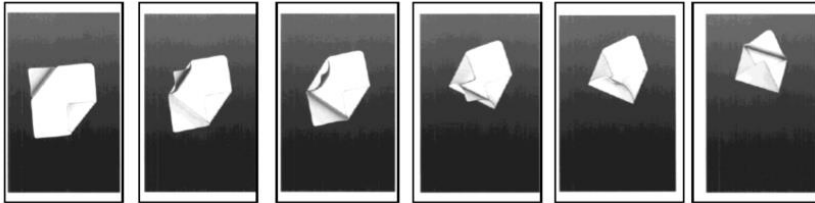
EU registered designs: Compare with U.S. practice

- Compare with U.S. – the good

- What can be protected



- All the usual but particularly, GUIs (screens and icons without context, animated GIFs, typefaces, menus, packaging, get-ups, colour or b/w).



- Practicalities

- Typically U.S. drawings will work with minimal changes to Europe
 - (Going the other way is more problematic, as often photos or non-line drawings have been filed)



EU registered designs: Compare with US – dangers 1

- Compare with US practice – some dangers
 - **Only 7 views** count
 - Can include additional views but only “for information of the examiner”.
 - Tricky e.g. for multi-position products; complex products.
 - Consider multiple designs.
 - Wording cannot extend the protection (or limit the prior art).
 - Product indication (title) and description are purely “for information”.
 - **Contrast US case** Curver v. Home Express...No. 18-2214 (Fed. Cir)

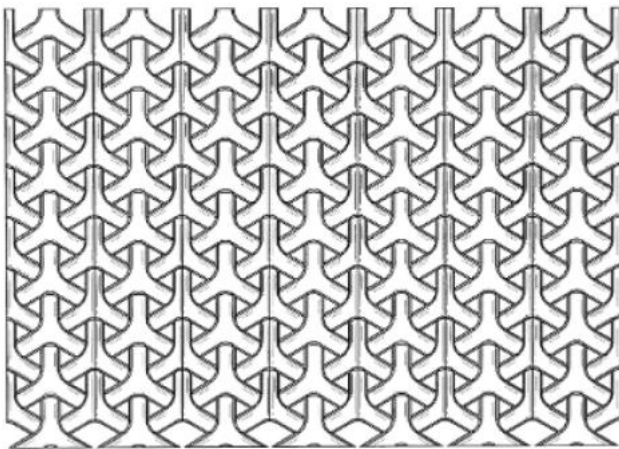
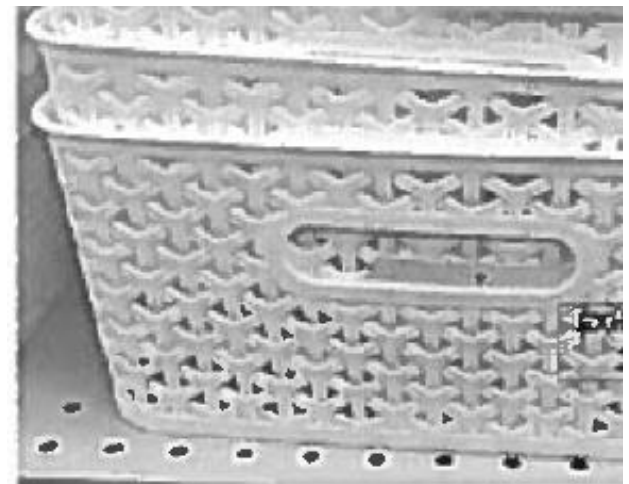


FIG. 1

"Pattern for a Chair"
not infringed by
a basket



EU registered designs: some dangers

A picture is worth a thousand words...unfortunately!

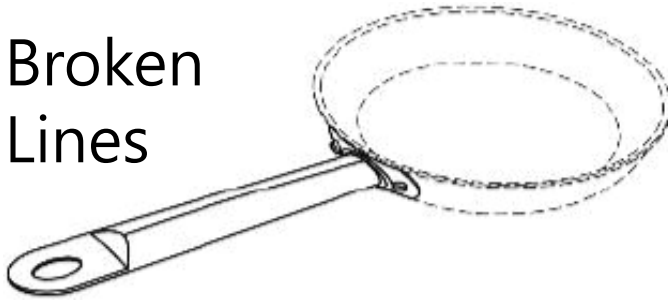
- Example 2011: **Dyson v VAX** (Filed under old law; judged differently in different countries)
- Example 2016: **Trunki** ride-on suitcase. Contrasting wheels...absence of ornamentation...horns v ears



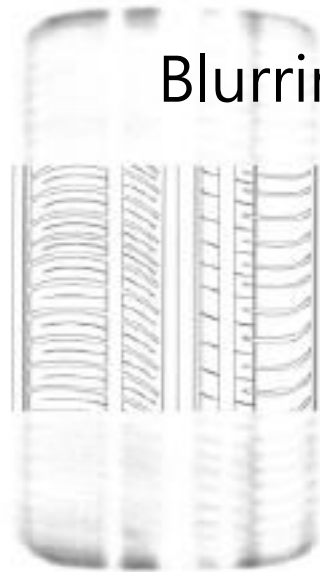
Put visual disclaimers to work - 1

- Several types of visual disclaimer are recognised.

Broken
Lines



Blurring



Boundaries



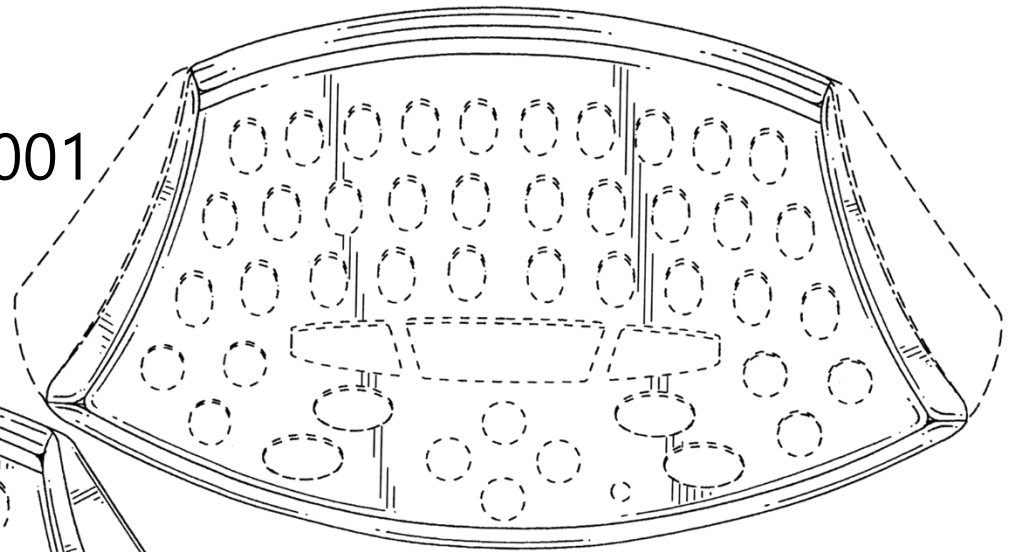
Colour/transparency



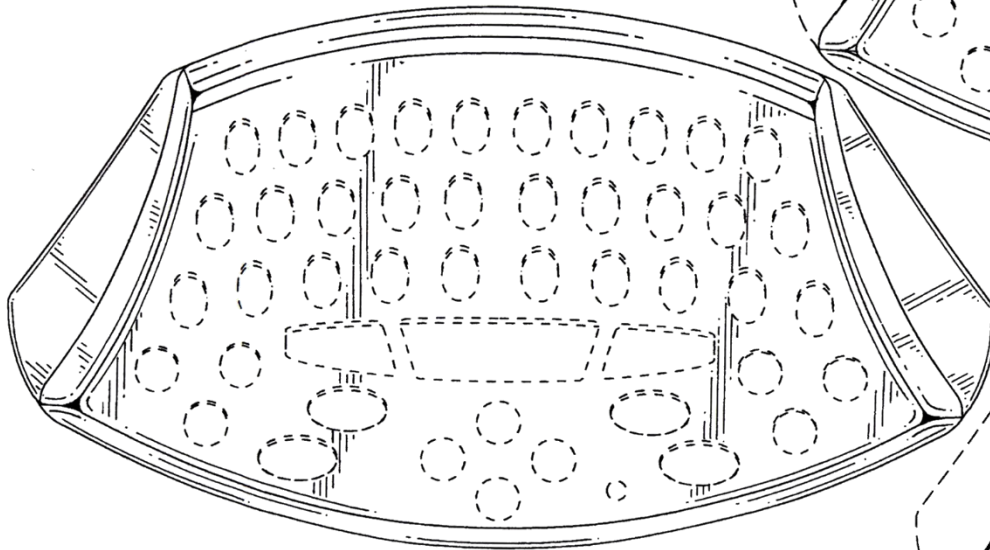
Put visual disclaimers to work - 2

- Example family: 3 designs protect different combinations of features

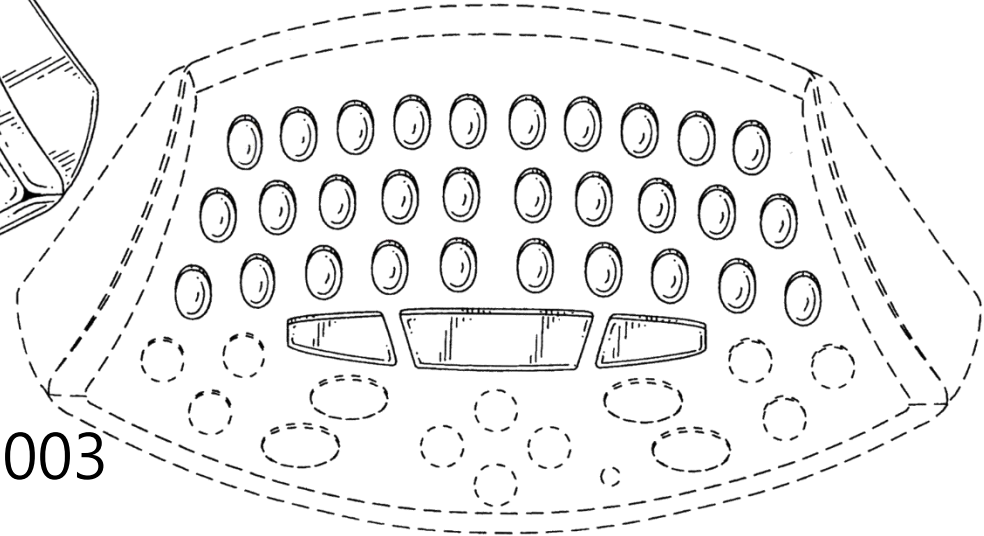
000033386-0001



000033386-0002



000033386-0003



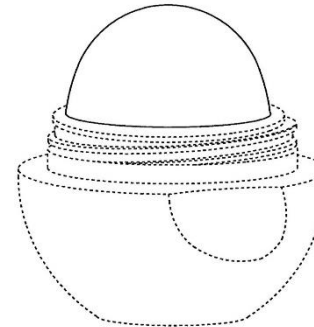
Visual disclaimers work (even when you don't want them to!)

- Example *RCD 01710245-0003*
- *The Kind Group v JPMC Interim relief; District Court in The Hague (8 July 2015, ECLI: NL:RBDHA: 2015:7834)*

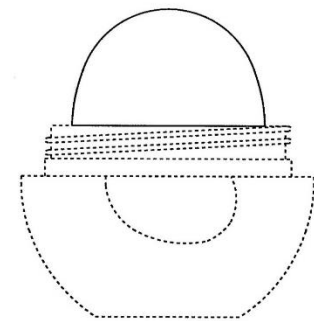


Original Product

Accused Products



Registered design

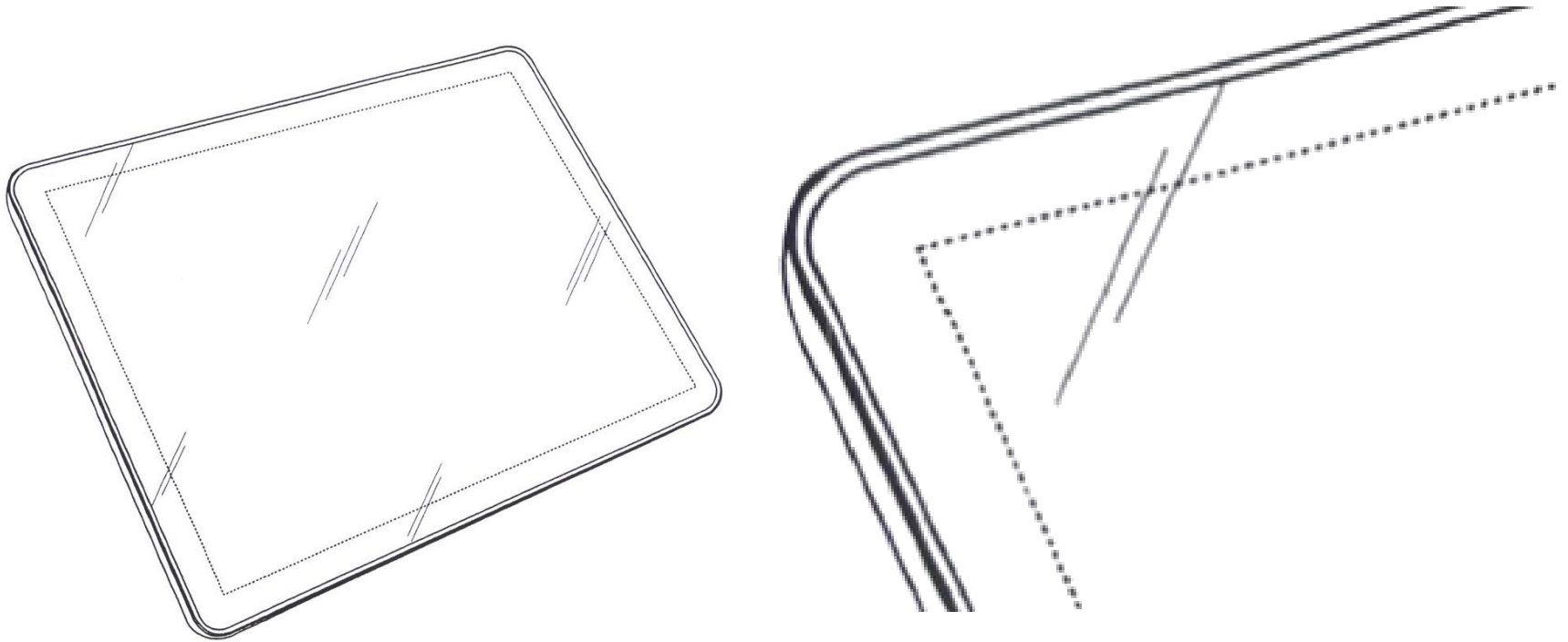


Prior Art



Visual disclaimers work (if that's what they are...?)

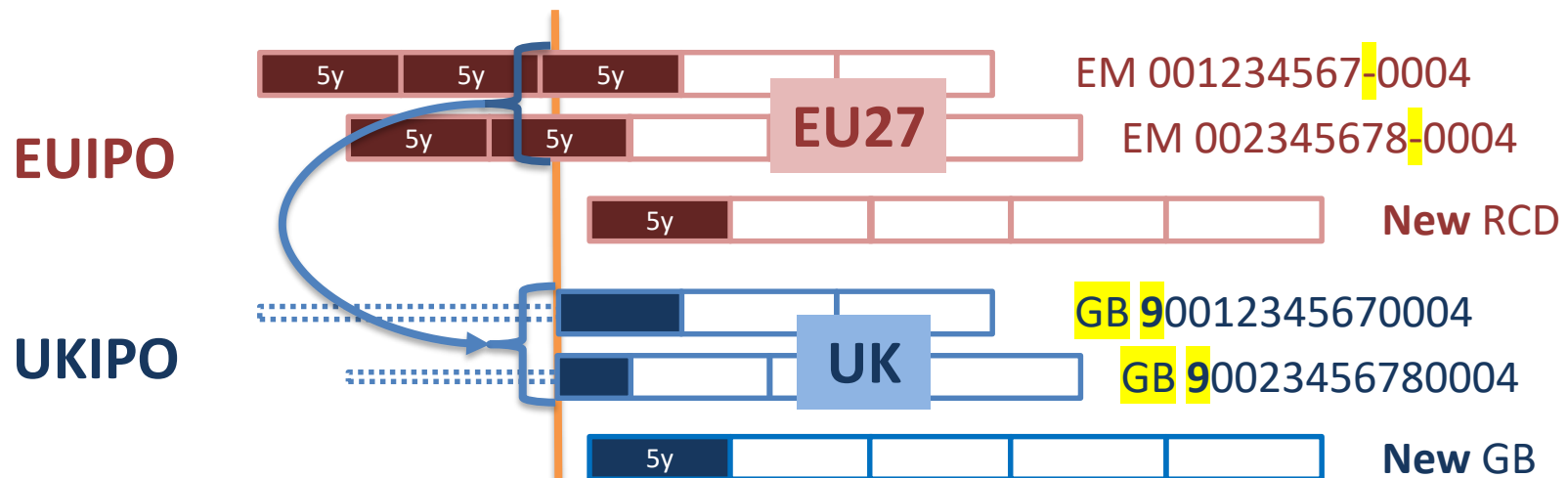
- Community Design No. 000181607-0001



- National courts (GB, NL) considered dotted lines were part of the design
 - *Samsung Electronics v. Apple*, [2012] EWCA Civ 1339
 - Invalidity action filed by Samsung held that scope was narrow but valid (ICD8539)

Brexit – EU28 becomes EU27 + United Kingdom

- UK leaves EU on 31 January 2020 (23:00 UTC) **BUT** transition period means **no change until 31 December 2020**
- **Registered EU('EM') rights** will be cloned into equivalent UK('GB') registrations with **no formal step or fee** (until next renewal).
- **Pending/lapsed EM rights** can be cloned in UK by the owner within a 9m grace period (i.e. 30 September 2021)
- After that (or now) file designs in UK as well as EU



- **Differences UK vs EU design law & practice?**
 - Very little! (e.g. >7 views; Max deferral 12M...)

Unregistered Design Rights – European Union

- **EU Unregistered Design Right (CUDR) (Art 11 etc)**
 - Unregistered rights protect against **COPYING**.
 - Beware risk of copying third party designs even if no registrations have been found!
 - Same scope as RCD (i.e. non-functional, novelty, individual character...)
 - 3 years from first publication/marketing
 - But ?ONLY if *first* publication was in the Community
 - “Gebäckpresse II” decision of the German Federal Supreme Court (Bundesgerichtshof – BGH)
 - Similar question in UK court referred to CJEU (Beverly Hills Teddy Bear Company v PMS International Group plc [2019] EWHC 2419 (IPEC))
 - CUDRs will be cloned into UK law after Brexit.

Unregistered Design Rights – United Kingdom

- **United Kingdom Design Right**

- Unregistered rights protect against **COPYING**. Beware risk of copying third party designs!
- Applicable to shape only, not surface pattern or graphics. Protects functional designs, internal and external features of machines (exceptions for “must fit”, “must match”). Similar to “unfair competition” in some countries.
- 15 years from creation or 10 years from first marketing; during the last 5 years of term, Licences of Right are available.
- **Not available to everyone:**
 - Qualification by nationality or residence of designer or first owner or
 - Qualification by place of first marketing.



SCHWEGMAN
LUNDBERG • WOESSNER
A PROFESSIONAL ASSOCIATION | SLWIP.COM

PATENT PROTECTION FOR HIGH TECHNOLOGY

(E)U Got the Look

These materials, and this webinar, are for general informational purposes only. They are not intended to be legal advice, and should not be taken as legal advice. They do not establish an attorney-client relationship.

January 30th 2020
John Gray – UK of Counsel
Schwegman Lundberg Woessner