



Double Degree Programme in Intellectual Property Law (LL.M/D.U)

www.ip.ukim.edu.mk

Dr. Jadranka Dabovik Anastasovska, Professor

INDUSTRIAL DESIGN

Skopje, 2011

Industrial Design

Contents

1. Why and what?.....	3
2. The legal perspective of the industrial design	4
3. Rights that apply in Industrial Design.....	6
4. Duration of rights.....	6
5. Entitlement to Rights	7
6. Acquisition of rights	7
7. Relation to Copyright.....	8
8. The difference between a design and other Industrial Property Rights such as patents and trademarks	9
9. The International “factor”	9
10. The Community Concept of Industrial Design.....	14
11. Community Design	15
Economic rights:	22
12. Community designs as object of property	23
13. Registration process for Registered Community design	27
14. Termination of the registered Community design	31
15. Appeals against OHIM’s decisions.....	36
16. Representation	38
17. Jurisdiction and procedure in legal actions relating to community designs	40

18.	Relationship with the national legal systems on Industrial Design.....	41
19.	Relationship with the international registration of Industrial Design	42

1. Why and what? INDUSTRY, COMMERCE AND AESTHETICS!

Industries and markets are faced with complex consumer behaviour: processes a consumer use to make purchase decisions, as well as to use and dispose of purchased goods or services. The notion of consumer behaviour also includes factors that influence purchase decisions and the product use. Consumer decision making process include several steps: need recognition; information search; evaluation of alternatives; purchase decision and purchase and post-purchase period. Consumers often take the visual appeal of a product into consideration when choosing between different products. This is especially true when the market offers a large variety of products with the exact same function. As the aesthetic appeal of a product can determine the consumer's choice an industrial design adds commercial value to a product. Protecting an industrial design is also a reward for creativity and encourages economic development. Above all, it ensures protection against unauthorised copying or imitation of the design and can be relatively simple and inexpensive to develop. An industrial design is not protected unless it has been published in an official bulletin.

What is design! Design is ... (by Oxford Dictionary):

- Noun: 1) *a plan or drawing produced to show the look and function or workings of something before it is built or made;* 2) *the art or action of producing such a plan or drawing;* 3) *underlying purpose or planning: the appearance of design in the universe;* 4) *a decorative pattern.*
- Verb: 1) conceive and produce a design for something; 2) plan or intend for a purpose.

However there is more to be said in the definition of design, as the term design has different meaning in different context.

Business design: comprehensive description of the structure of an enterprise, its subsystems and their relationships, relationships with the external environment, principles for the design and evolution of an enterprise, that includes enterprise goals, business functions, business process, roles, organisational structures, business information, software applications and computer systems.

Service design: Planning and organizing people, infrastructure, communication and material components of a service, in order to improve its quality, the interaction between service provider and customers and the customer's experience. The increasing importance and size of the service sector, requires services to be accurately designed in order for service providers to remain competitive and to continue to attract customers.

Process design: Activities involved in planning and determining the workflows and implementation requirements for a particular process. Processes (in general) are treated as a product of design, not the method of design. The term originated with the industrial designing of chemical processes; in the information age used to describe the design of business processes as well as manufacturing processes.

Package design: The science, art and technology of enclosing or protecting products for distribution, storage, sale, and use. The packaging and labels are used by marketers to encourage potential buyers to purchase the product. Marketing communications and graphic design are applied to the surface of the package and (in many cases) the point of sale display.

Product design: Generation and development of ideas through a process that leads to new products. By combination of art, science and technology, through systematic approach, product designers create tangible three-dimensional goods.

The **Industrial design** is concerned with the aspect of the process that brings the artistic form and usability to the mass produced goods. An industrial design is the ornamental or aesthetic aspect of an article. The design may consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or color. For example: the development of the iPod is in the sphere of product design. The “look” of the iPod is actually industrial design. Why the industrial design is important for the companies can be illustrated by one quote: “Between two products equal in price, function and quality, the better looking will out sell the other.” (Raymond Loewy, the father of the industrial design).

2. The legal perspective of the industrial design

The objective of the Industrial Design Right is protection of the appearance of the good or only a part of the good. As one can see from the definition there is fine line between copyright (because of the artistic and aesthetic elements) and industrial property right (because of the industrial application).

The establishment of the legal system of protection of the industrial design requires establishment of a balance of interests: the need to provide efficient and effective protection, in order to promote design element in production vs. the need to ensure that the law does not unnecessarily extend protection beyond what is necessary. Elements of the legal protection system are: the definition of the subject matter of protection; the rights which apply to the proprietor of the subject matter; the duration of such rights; the entitlement to such rights; the method of acquisition of such rights.

If one should define the subject matter of industrial design it would say that the design right provides protection to design which is applied to or embodied in articles or products. From this definition we can see that one of the fundamental prerequisites for the protection of the design as right is the application to or embodiment in an article, meaning that the design can be protected only if it is capable of being used in industry, or in respect of articles produced on a large scale. It has to be noted however, that such protection will not be extended to designs that are dictated by function. This for the reason that the novelty and originality constitute the fundamental reason for the grant of a reward to the originator through protection by registration of the industrial design.

As we said, designs which are dictated solely by the function which the article is to perform shall be excluded from protection. If a design for one article, for example screw, is dictated purely by the function which the screw is intended to perform, protection for that design would have the effect of excluding all other manufacturers from producing items intended to perform the same function. Such exclusion is not warranted, unless the design is sufficiently novel and inventive to qualify under the rigorous standards for patent protection. The exclusion relates only to those designs which are indispensable for achieving the desired function. In reality, many ways of achieving a given function will be possible. Protection through registration shall be granted only to designs which are novel or, as it is sometimes expressed, original. The novelty of the design constitutes the fundamental reason for the grant of a reward to the originator through protection by registration of the industrial design. The nature of the novelty differs amongst the laws of various countries. There are two systems of assessing the novelty. Within the system of absolute or universal novelty - the design for which registration is sought must be new as against all other designs produced in all other parts of the world at any previous time and disclosed by any tangible or oral means. Within the system of qualified standard of novelty, it is judged upon

several determinants: (1) Time- novelty is judged by reference to designs published within a limited preceding period of time; or (2) Territory - novelty is judged by reference to all designs published within the relevant jurisdiction, as opposed to anywhere in the world; or (3) Means of expression - novelty is assessed by reference to written or tangible disclosures anywhere in the world and to oral disclosures only within the relevant jurisdiction. An industrial design is not considered to be new and is not granted legal protection if an identical or confusingly similar industrial design has been disclosed or registered prior to the filing date of the registration application for an industrial design or if the owner has disclosed the industrial design within twelve months before the filing date of the registration application or before the date of priority. A person skilled in the art shall determine whether or not the industrial design has individual character. As the subject matter that may be protected by industrial design rights is very broad, a decision shall be made by a person who is skilled in the specific subject matter. As in today's network environment new information is accessed easily and quickly, the assessment of novelty and inventive step takes place on a worldwide basis. Novelty and individual character are assessed on the basis of information available to the public on the filing date of the application or on the priority date.

3. Rights that apply in Industrial Design

The subject matter of the rights of the proprietor are defined by the industrial design which has been registered. It is usual to provide that the proprietor's rights extend not only to the unauthorized exploitation of the exact registered industrial design, but also to the unauthorized exploitation of any imitations of such a design which differ from the registered design only in immaterial respects.

Industrial Design Law accords to the proprietor the exclusive right to prevent the unauthorized exploitation of the design in industrial articles. It usually encompasses the exclusive right to do any of the following things for industrial or commercial purposes: make articles to which the design is applied or in which the design is embodied; import articles to which the design is applied or in which it is embodied; sell, hire or offer for sale any such articles; to preventing another from stocking any articles to which the design has been applied or in which it is embodied (in some laws) .

4. Duration of rights

The term for an industrial design right varies from country to country. The usual maximum term goes from 10 to 25 years, often divided into terms requiring the proprietor to renew the registration in order to obtain an extension of the term. The relatively short period of protection may be related to the association of designs with more general styles of fashions, which tend to enjoy somewhat transient acceptance or success, particularly in highly fashion-conscious areas, such as clothing or footwear.

5. Entitlement to Rights

The right to legal protection in respect of an industrial design belongs to the creator (or author or originator) of the industrial design. In cases of industrial design created by an employee, or by a contractor pursuant to a commission, the law usually provides that the entitlement to legal protection of the design shall belong to the employer, or to the person who has commissioned the design. In this regard a question arises in regard to designs generated with the assistance of a computer. It has to be said that usually the computer is treated like any other tool which may be used by a designer to assist in the process of generating a design, so the person who is responsible for manipulating the computer's capacity to produce a design would be considered to be the author of the design.

6. Acquisition of rights

There are two systems for acquisition of the Industrial Design rights. The first one is the system of registration meaning that the protection is granted pursuant to a procedure for the registration of a designs. In the process there could be formal or substantive examination of the application. The second system is by Creation and Fixation - rights in designs may, under certain laws, also be acquired by the act of creation and fixation of the design, in a document or by embodying the design in an article. These systems do not require any formal registration procedure for the acquisition of exclusive rights in the design (France and United Kingdom).

In the cases where the Industrial Design rights are acquired in a formal procedure, this procedure is carried out by authorised stated bodies such as Industrial Property Offices or Design Offices. There are in general two systems of examination whether the application for registration meets the requirements set by the law: system of formal and system of substantive examination. Within

the system of formal examination of an application for a registered design, the application is examined so as to ensure that it meets with each of the formal requirements for an application, which are imposed by the relevant law. This system has the effect of shifting the burden of assessing novelty to those interested persons in the market who may wish to use, or who may have used, the design or a substantially similar design. They will have the opportunity either to oppose the registration of the design or to bring proceedings for the cancellation of a registration which it is alleged is invalid, depending on the system. Within the system of substantive examination, the design for which registration is sought is examined in comparison with past registered design to ascertain whether it satisfies the required condition of novelty. For this system it is necessary to maintain a search file and sufficient skilled manpower to undertake the substantive examination.

7. Relation to Copyright

Objects meeting the requirements for protection under industrial design law can also be protected under copyright law. If a design embodies elements or features which are protected by industrial design laws and copyright laws then claims under both laws can be made. The creator can choose to be protected under only one of the laws but in this case then they cannot invoke the other law when making a claim.

Whereas an industrial design needs to be registered, in most countries copyright does not require registration. Copyright protection lasts longer than industrial design protection. However, the right conferred by registration of an industrial design is an absolute right in the sense that there is infringement even though the infringer acted independently or without knowledge of the registered design. In copyright law, the copyright should always be stated. One can distinguish different systems of relations between the Industrial Design Law and Copyright Law: cumulative protection (exists in Germany and France) and co-existence of protection.

The cumulative protection means: (a) the design is protected simultaneously and concurrently by both laws in the sense that the creator can invoke the protection of either or both, the copyright law or the industrial design law, as he chooses; (b) if the author failed to obtain the protection of the industrial design law by failing to register the design, the author can claim the protection of copyright law, which is available without compliance with any formality; (c) after

the term of protection of the registered design expires, the creator may still have the protection of the copyright law.

The co-existence of protection means: the creator may choose to be protected either by the industrial design law or by the copyright law. If he has chosen the one, he can no longer invoke the other. If he has registered the industrial design, at the expiration of such registration he can no longer claim protection under the copyright law, at least for the particular application of the industrial design. Under the industrial design law, protection is lost unless the industrial design is registered by the applicant before publication or public use anywhere, or at least in the country where protection is claimed.

The difference between protection by the copyright law and protection by the industrial design law is seen in the following points: acquisition of the rights; duration of the protection and the scope of the protection. Copyright in most countries subsists without formalities, meaning that the registration is not necessary. Industrial design protection lasts generally for a short period of three, five, ten or fifteen years. Copyright lasts in most countries for the life of the author and fifty years after his death. The right conferred by registration of an industrial design is an absolute right in the sense that there is infringement whether or not there has been deliberate copying. There is infringement even though the infringer acted independently and without knowledge of the registered design. Under copyright law, there is infringement only in the reproduction of the work in which copyright subsists.

8. The difference between a design and other Industrial Property Rights such as patents and trademarks

All industrial property rights are intended to protect the creativity of businesses and individuals. However they do not cover the same aspects. A **design** only covers the **appearance** of a product. A design cannot protect the function of a product. A **patent** covers the function, operation or construction of an **invention**. To be patentable, a function must be innovative, have an industrial application and be described in such a fashion to permit reproduction of the process. A **trade mark** identifies the **origin of goods** and services of one undertaking to differentiate them from those of its competitors.

9. The International “factor”

The development of the international trade led to development of international rules of the industrial property including the industrial design. **International mechanisms for the**

protection of the Industrial Design arise from: The Berne Convention for the Protection of Literary and Artistic Works; Paris Convention for the Protection of the Industrial Property (Paris Convention); The Hague Agreement Concerning the International Deposit of Industrial Designs (The Hague Agreement); The Locarno Agreement Establishing an International Classification for Industrial Designs (The Locarno Agreement); Agreement on the Trade Related Aspects of the Industrial Property Rights (The TRIPS Agreement)

The need for a uniform system of protection of literary and artistic works resulted in the formulation and adoption in 1886, of the **Berne Convention** for the Protection of Literary and Artistic Works. It is the oldest international treaty in the field of copyright, open to all States. The Berne Convention has been revised several times in order to improve the international system of protection which the Convention provides, to make it compatible to the development of technologies in the field of creation and utilization of authors' works. The first major revision took place in Berlin in 1908, and this was followed by the revisions in Rome in 1928, in Brussels in 1948, in Stockholm in 1967 and in Paris in 1971. The aim of the Berne Convention is "to protect, in as effective and uniform a manner as possible, the rights of authors in their literary and artistic works." Article 1 lays down that the countries to which the Convention applies constitute a Union for the protection of the rights of authors in their literary and artistic works. The Berne Convention instituted a protection based on the authors' right as works of applied art and work of decorative art. Main principles of the Convention are: the recognition without any formality of registration, the principle of national treatment, independence of protection i.e. enjoyment and exercise of the rights granted is independent of the existence of protection in the country of origin of the work. In regard to "works of applied art", article 2.7 provides two principles: 1. The Member States are free to rule the protection mode applicable to the industrial design; and 2. The reciprocity principle is used in the process needed to determine if an author could benefit a protection based on author right in a country of the Union.

Industrial design Right is one of the rights enumerated in Article 1 of the **Paris Convention**. The most important principles of the Convention are the National Treatment and right of priority. By the Convention there is an obligation of all member countries to protect industrial designs (Article 5 *quinquies*). The Paris Convention introduces *special system of protection of industrial designs* by registration or by the grant of patents for industrial designs

The national treatment under the Paris Convention means that a person of a member state who wants to benefit of a protection in another member state of the Union is treated as the national of this country. Right of priority is the right to consider some prior date of filing an application in one country of the Union as the date of filing in others. Thus, on the basis of a regular application for an industrial property right filed in one of the member countries, the same applicant (or its or his successor in title) may, within a specified period of time (six or 12 months), apply for protection in all the other member countries and these applications will be regarded as if they had been filed on the same day as the earliest application. Article 5 *quinquies* merely states the obligation of all member countries to protect industrial designs. Nothing is said about the way in which this protection must be provided. Member countries can therefore comply with this obligation through the enactment of special legislation for the protection of industrial designs. They can, however, also comply with this obligation through the grant of such protection under the law on copyright or the law against unfair competition.

The **Hague Agreement** was adopted in 1925 within the framework of the Paris Convention; entered into force in 1928. It has been revised and supplemented several times and currently in force are the London Act of 1934 and the Hague Act of 1960 (that function independently from each other). The aim of the International deposit system is to enable protection to be obtained for one or more industrial designs in a number of States through a single deposit filed with the International Bureau of WIPO, with a minimum of formalities and expense. The applicant is thus relieved of the need to make a separate national deposit in each of the States in which he requires protection, thus avoiding the inherent complication of procedures that vary from one State to another.

An international deposit may be made by any natural or legal person who is a national of one of the Contracting States or has his domicile or a real and effective industrial or commercial establishment in one of those States. The International Deposit does not require any prior national deposit. It is made directly with the International Bureau of WIPO by the depositor or his representative on a form. It may, however, be made through the national Office of a Contracting State if the law of such State so permits (Article 4(1)). The law of a Contracting State may also require, in cases where that State is the State of origin, that the international deposit be made through the national Office of that State. Non-compliance with this requirement

does not prejudice the effects of the international deposit in the other Contracting States (Article 4(2)).

A single international deposit may comprise several designs (up to 100), however all must be in, or be intended for incorporation in articles listed in, the same class of the **International Classification (Locarno Classification)**. International deposit is subject to the payment of fees, in Swiss francs, the amounts of which are decided by the Assembly of the Hague Union. An international application may be filed in either English or French language, at the choice of the applicant. Data records and publications are made in both English and French, while correspondence is in the language in which the international application was filed. International deposits are published by the International Bureau in the *International Designs Bulletin* that comprises, in particular, a reproduction of the article or articles in which the deposited designs are to be incorporated. The depositor may ask for publication to be deferred for a period of his choice, which may not, however, exceed 12 months as from the date of the international deposit or, where appropriate, from the date of priority claimed. The Principle of International Deposit: The International Deposit has the same effect in each designated Member State if all conditions for registration in such state are met; registration may be refused as long as it does not extend to formalities and other administrative acts. Initial registration period is set to 5 years, with possibility to renewal, subject of payment of fees.

The **Locarno Agreement** Establishing an International Classification for Industrial Designs is a multilateral international treaty, signed in 1968, entered into force in 1971. The Agreement has established a Committee of Experts to make amendments and additions, as required by changes in technology and trade or as dictated by experience, to the International Classification.

The Locarno Agreement regulates the Legal Effect and Use of the Locarno Classification in such manner that the Industrial Property Offices of the countries of the Locarno Union must include in the official documents for the deposit or registration of designs, and if they are officially published, in the publications in question, the numbers of the classes and subclasses of the Locarno Classification in which the goods incorporating the designs belong. The countries of the Locarno Union reserve the right to use the Locarno Classification either as a principal or as a subsidiary system. International Classification for Industrial Designs (Locarno Classification) comprises of three parts: 1)List of Classes and Subclasses - in total, there are 31 classes and 211

subclasses; 2) Alphabetical List of Goods in which industrial designs are incorporated - this List contains in total approximately 6,000 entries; and 3) explanatory notes.

TRIPS is an international agreement administered by the WTO that sets down minimum standards for many forms of intellectual property regulation as applied to nationals of other WTO Members. It was negotiated at the end of the Uruguay Round of the General Agreement on Tariffs and Trade (GATT) in 1994. It is agreed desiring to reduce distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade. Several articles of TRIPS are applicable on the industrial design:

- Minimum harmonization (Art. 1(1));
- Categories falling under the terms “intellectual property” (Art. 1(2)): 1. Copyright and Related Rights, 2. Trademarks, 3. Geographical Indications, 4. Industrial Designs, 5. Patents, 6. Layout-Designs (Topographies) of Integrated Circuits, 7. Protection of Undisclosed Information, 8. Control of Anti-Competitive Practices in Contractual Licences; regulated by Art. 9 – 40;
- National treatment (Art. 1(3) and Art.3) and most favored nation treatment (Art. 4);
- Non-derogation of international conventions (Art. 2);
- Objectives (Art. 7): The protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.;
- Enforcement procedures and remedies (Art. 41-61);
- Acquisition and maintenance of intellectual property rights and related inter-partes procedures (Art. 62);
- Dispute Prevention and Settlement (Art. 63- 64) .

TRIPS stipulates that the requirements for securing protection for textile designs, in particular stipulating that any cost, examination or publication, should not unreasonably impair the opportunity to seek and obtain such protection. This obligation could be met through industrial design law or through copyright law. The owner of a protected industrial design shall have the

right to prevent third parties not having the owner's consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes. Limited exceptions to the protection of industrial designs, may be provided conditioned that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties.

10. The Community Concept of Industrial Design

The ideas of the European Community on of a single market may somehow be confronted with the concept of creation of specific, exclusive, rights related to for creation of specific aesthetic features. This for the reason that the Industrial Design is, per se, an issue of an individualisation and creation of market niches. The individualization includes development of attractive and distinctive characteristics. That, one hand, requires investments, but on the other provides for profits. In such circumstances the business sector is interested to be able to in obtaining a legal protection of the creations. On the other side, the Common Market equals to Common Interest, which means that community design should circulate freely in each member state of the community without any consideration of border. In this, let's say two sides of a coin one can see the following controversies:

- The principle of territoriality (national) of the IPRs vs. the territory of the internal market;
- The scope of the conferred rights includes the right to prohibit the importation, in each country where the right exists, and copying the design so it impedes the free movement of goods;
- Problems that arise when there are different holders of the same design in different member states so it impedes the free movement of goods, again;
- Different national systems may lead to a situation when for a same design protection is conferred in one Member state and not conferred in other;
- Exclusive rights vs. competition.

The obstacles that existed were overcome by several steps. The development of the theory of exhaustion of rights by the European Court of Justice led to the establishment of a balanced approach in the protection of the rights and the competition at the same time.

The most important step in the community approach was the enactment of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs. The directive has for its objective the harmonization of the national legal systems, by establishing the same criteria concerning the definitions of the design, the conditions of protection and the assessment of these conditions, the scope and the duration of the rights. However, the Directive was not sufficient to achieve the single market. Although the national systems are harmonized, they are not unified so again the same obstacles may occur. The need to create an autonomous community right of design, a right that confers the same title and protection in the whole territory of the EU and a right that is directly enforceable in each Member State resulted in the adoption of Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs and Implementing Regulation¹ (Official Journal of the European Union L 003,05.01.2002, pp. 1-24). So the term Community Design was created.

11. Community Design

¹ Amendments of the Regulation No. 6/2002 on Community designs: 1) Act concerning the conditions of accession of the Czech Republic, the Republic of Estonia, the Republic of Cyprus, the Republic of Latvia, the Republic of Lithuania, the Republic of Hungary, the Republic of Malta, the Republic of Poland, the Republic of Slovenia and the Slovak Republic and the adjustments to the Treaties on which the European Union is founded - Annex II: List referred to in Article 20 of the Act of Accession - 4. Company law - C. Industrial property rights - III. Community designs [OJ L 236, 23.9.2003]; 2) Act concerning the conditions of accession of the Republic of Bulgaria and Romania and the adjustments to the Treaties on which the European Union is founded - Annex III: List referred to in Article 19 of the Act of Accession: adaptations to acts adopted by the institutions - 1. Company law - Industrial property rights - III. Community designs [OJ L 157, 21.6.2005] Council Regulation (EC) No 1891/2006 of 18 December 2006 amending Regulations (EC) No 6/2002 and (EC) No 40/94 to give effect to the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs. The Supporting regulation includes: 1) Commission Regulation (EC) n°2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs; 2) Commission Regulation (EC) n° 2246/2002 of 16 December 2002 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs; 3) Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs)

A Community Design is a design which complies with the conditions contained in the Regulation. A design is protected by: a "registered Community design", if registered in the manner provided for in the Regulation and an "unregistered Community design", if made available to the public in the manner provided for in the regulation. The Community design has a unitary character. It has equal effect throughout the Community. The Community design could be registered, transferred or surrendered or be the subject of a decision declaring it invalid, or its use could be prohibited, only in respect of the whole Community, unless otherwise provided in the Regulation.

Community designs are registered at the Office for Harmonization in the Internal Market (OHIM) under **the Council Regulation 6/2002/EC on Community Designs**. The Office for Harmonization in the Internal Market (OHIM) located in Alicante in Spain registers the Community designs as from 1 April 2003. Community Designs registered by the OHIM are entitled to protection in all EU Member States. Only the formal requirements of the registration of the industrial design (the forms of the required documents, contents, filing dates etc.) are examined. Upon filing a relevant application the OHIM serves the right to invalidate registered designs if they do not meet the requirements.

The Design Courts in the member states of the European Community may decide that the registered design should actually not enjoy legal protection if during the course of the alleged violation of legal claim proceedings action, the opposing legal action is presented to invalidate the design. Community design applications may be filed directly with the OHIM (electronic filing is possible) . The order of filing Community design application has been established by the Regulation of Industrial Design. Community design applications must comply with formal and substantive requirements prescribed by **the Community Design Regulation and Implementing Regulations**. The state fee prescribed by Article 36(4) of the Community Design Regulation must be paid directly to the OHIM..

Regulation No 6/2002/2002/EC of the EU Council on the Community Design provides protection also to the unregistered designs. In order to obtain protection, the unregistered designs should meet the same substantive criteria as the registered designs: they have to be novel and distinctive. Protection will become valid since the publication date of the design in the European Union. Publication may take place via placing the design on sale or through preceding marketing

or advertising. Protection will last for 3 years. The main difference in the level of protection lies in the fact that the registered Community design is protected against intentional copying as well as against the independent elaboration occurrence of a similar design. Unregistered design is protected only against intentional copying. New concept in the IP Law are sui generis IP right although there is no registration it should not be considered equal to copyright – it is a Industrial Property right, directed to meet the needs of the industries that produce goods with short life cycle (such as the textile industry) it elevates the burden to undertake lengthy and expensive procedure for registration while the commercial success of the product is not certain.

By the right to unregistered Community design any design disclosed in the Community after the effect of the Regulation (March 6th, 2002) enjoys protection without registration by the OHIM. The scope of protection is the same as the registered Community design however the term of protection is shorter.

11.1. Protection requirements

In order to be protected the design has to be new and to have individual character. A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character: (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character. In this regard "normal use" means use by the end user, excluding maintenance, servicing or repair work. The meaning of "Component part of a complex product" includes such things as parts of cars, wing mirrors, bumpers, bonnets, lights. If they are visible during their normal use, these are not excluded from registration but they will have a limited protection. It will be possible to produce and sell these parts specifically for repair of an original product without infringing the registered Community design. If they are not visible in the normal use of the complex product, they will not be excluded from protection through registration as OHIM does not conduct any substantive examination before registration but they will not have the legal effects of a Community design, even if registered.

A design shall be considered to be new if no identical design has been made available to the public:(a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public; (b) in the case of a

registered Community design, before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.

A design shall be deemed to have been made available to the public if : it has been published following registration or otherwise; exhibited; used in trade or otherwise disclosed; before the date on which the design for which protection is claimed has first been made available to the public (for unregistered Community design) or the date of filing the application for registration or, if a priority is claimed, the date of priority (for registered Community design), 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 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.

Designs shall be deemed to be identical if their features differ only in immaterial details. A disclosure shall not be taken into consideration when judging on novelty and individual characteristics if a design, for which protection is claimed, has been made available to the public: (a) by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title; (b) during the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority;(c) as a consequence of an abuse in relation to the designer or his successor in title.

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: a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public; b) in the case of a registered Community design, before the date of filing the application for registration or, if a priority is claimed, the date of priority. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration. The term degree of freedom stands for the designers' freedom when creating can vary greatly from one product to another. The freedom is, however, not to be measured by the absence of leeway from a subjective point of view (e.g. the fact that the person who orders the designs requires that some features appear in them) but from an objective one.

Thus sectors in which prior art (i.e. all pre-existing creations) is crowded or in which standardisation imposes many constraints will be considered to leave little freedom to designers².

11.2. Exclusion from protection

Community Design rights shall not be conferred to designs dictated by their technical function and design of interconnections. A Community design shall not subsist:

- in features of appearance of a product which are solely dictated by its technical function;
- 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.

Contrary, Community design shall subsist, provided novelty and individual character, in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system. **“Modular system”** consists of a number of items that are designed to be connected together in a number of ways. The typical example of a modular system is the building blocks or tiles used by children. This notion is also of particular relevance to the furniture industry as it includes items such as desks and tables, which may consist of a number of smaller tables that can be assembled in alternative configurations. **“Interconnections”** refer to the feature of a product which enables that product to be assembled or to be mechanically connected with another product, e.g. the connection for a plug or an exhaust pipe would necessarily be of a specific “form and dimension” in order to fit with a car. This will not usually include the possibility of alternative configurations as in the case of a modular system. Applications for registrations of “Interconnections” will not be excluded from protection through registration as OHIM does not conduct any substantive examination before registration but they will not have the legal effects of a Community design even if registered. Design rights shall not be conferred also to designs contrary to public policy and morality.

² See Case T-9/07: Judgment of the General Court of 18 March 2010 — Grupo Promer Mon Graphic v OHIM — PepsiCo (Representation of a circular promotional item) (Community design — Invalidity proceedings — Registered Community design representing a circular promotional item — Prior design — Ground for invalidity — Conflict — No different overall impression — Meaning of conflict — Product at issue — Degree of freedom of the designer — Informed user — Article 10 and Article 25(1)(d) of Regulation (EC) No 6/2002); OJ C 113, 1.5.2010, p. 39–40.

11.3. Scope of protection

The scope of the protection conferred by a Community design includes any design which does not produce on the informed user a different overall impression. In assessing the scope of protection, the degree of freedom of the designer in developing his design is taken into consideration.

11.4. Term of protection

The term of protection depends if the community design is unregistered or registered.

A design which meets the requirements for protection shall be protected by an *unregistered Community design for a period of three years*. The term commences on the date on which the design was first made available to the public within the Community. A design shall be deemed to have been made available to the public within the Community if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known 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.

Upon registration by the Office, a design which meets the requirements for protection shall be protected by a *registered Community design for a period of five years*. The term commences on the date of the filing of the application for registration. The right holder may have the term of protection renewed for one or more periods of five years each, up to a total term of 25 years from the date of filing. The registration of the RCD is renewed at the request of the right holder or of any person expressly authorised by him, provided that the renewal fee has been paid. The Office informs the right holder of the RCD and any person having a right entered in the register of Community designs, of the expiry of the registration in good time before the said expiry. Failure to give such information does not invoke responsibility of the Office. The request for renewal should be submitted and renewal fee should be paid within the last six months of the protection. If the right holder or the person expressly authorised by him, fail to do this the request may be submitted and the fee paid within a further period of six months following the end of the previous term, provided that an additional fee is paid within this further period. The Renewal takes effect from the day following the date on which the existing registration expires. The renewal is entered in the Register.

11.5. Entitlement to the Community design right

The right to the Community design belongs to the designer or his successor in title. If two or more persons have jointly developed a design, the right to the Community design vests in them jointly. Where a design is developed by an employee in the execution of his duties or following the instructions given by his employer, the right to the Community design vests in the employer, unless otherwise agreed or specified under national law³.

If an unregistered Community design is disclosed or claimed by, or a registered Community design has been applied for or registered in the name of, a person who is not entitled to it, the person entitled to it may claim to become recognised as the legitimate holder of the Community design. Where a person is jointly entitled to a Community design, that person may claim to become recognised as joint holder. The claim for entitlement is without prejudice to other remedies. The claim is made to a Community design Court. The legal proceedings regarding the claim to entitlement should be undertaken within three years after the date of publication of a registered Community design or the date of disclosure of an unregistered Community design. The set deadline shall not be applied if the person who is not entitled to the Community design was acting *mala fides* at the time when such design was applied for or disclosed or was assigned to him. In the case of claim for entitlement to a registered Community design, the data in the Register is amended accordingly by including: (a) mention that legal proceedings have been instituted; (b) the final decision or any other termination of the proceedings ; and (c) any change in the ownership of the registered Community design resulting from the final decision.

The Regulation defines the effects of the judgement on entitlement to a registered design. To this end, where there is a complete change of ownership of a RCD, licences and other rights shall lapse upon the entering in the register of the person entitled. If, before the institution of the legal proceedings, the holder of the RCD or a licensee has exploited the design within the Community

³ Case C-32/08: Judgment of the Court (First Chamber) of 2 July 2009 (Reference for a preliminary ruling from the Juzgado de lo Mercantil n o 1 de Alicante y n o 1 de Marca Comunitaria — Spain) — Fundación Española para la Innovación de la Artesanía (FEIA) v Cul de Sac Espacio Creativo SL, Acierta Product Position SA (Regulation (EC) No 6/2002 — Community designs — Articles 14 and 88 — Proprietor of the right to the Community design — Unregistered design — Commissioned design); *OJ C 205, 29.8.2009, p. 7–8*

or made serious and effective preparations to do so, he may continue such exploitation provided that he requests within a period of three months a non-exclusive licence from the new holder whose name is entered in the register. This licence shall be granted for a reasonable period and upon reasonable terms. This will not apply if the holder of the RCD or the licensee was acting in bad faith at the time when he began to exploit the design or to make preparations to do so.

The Regulation also defines the presumption of entitlement. Namely the person in whose name the registered Community design is registered or, prior to registration, the person in whose name the application is filed, shall be deemed to be the person entitled in any proceedings before the Office as well as in any other proceedings.

11.6. Rights conferred by the Community Design

The Community Design confers Moral and Economic Rights.

Moral right is the right of the designer to be cited. The designer shall have the right, in the same way as the applicant for or the holder of a registered Community design, to be cited as such before the Office and in the register. If the design is the result of teamwork, the citation of the team may replace the citation of the individual designers.

Economic rights: An unregistered Community design confers on its holder the exclusive right to use it and to prevent any third party not having his consent from using it only if the contested use results from copying the protected design. The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder. This also applies to a RCD subject to deferment of publication as long as the relevant entries in the register and the file have not been made available to the public in accordance the Article 50(4) of the Regulation.⁴

The rights conferred by a Community design shall not be exercised in respect of: acts done privately and for non-commercial purposes; acts done for experimental purposes; acts of

⁴ **Article 50, Deferment of publication :** 4. At the expiry of the period of deferment, or at any earlier date on request by the right holder, the Office shall open to public inspection all the entries in the register and the file relating to the application and shall publish the registered Community design in the Community Designs Bulletin, provided that, within the time limit laid down in the implementing regulation: (a) the publication fee and, in the event of a multiple application, the additional publication fee are paid; (b) where use has been made of the option pursuant to Article 36(1)(c), the right holder has filed with the Office a representation of the design. If the right holder fails to comply with these requirements, the registered Community design shall be deemed from the outset not to have had the effects specified in this Regulation.

reproduction for the purpose of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source. In addition, the rights conferred by a Community design shall not be exercised in respect of: the equipment on ships and aircraft registered in a third country when these temporarily enter the territory of the Community; the importation in the Community of spare parts and accessories for the purpose of repairing such craft; the execution of repairs on such craft.

The rights conferred by a Community design are extended to acts relating to a product in which a design included within the scope of protection of the Community design is incorporated or to which it is applied, when the product has been put on the market in the Community by the holder of the Community design or with his consent.

A right of prior use exists for any third person who can establish that before the date of filing of the application, or, if a priority is claimed, before the date of priority, he has in good faith commenced use or made serious and effective preparations to commence use within the Community, of a design included within the scope of protection of a registered Community design, which has not been copied from the latter.

The right of prior use entitles the third person to exploit the design for the purposes for which its use had been affected, or for which serious and effective preparations had been made, before the filing or priority date of the registered Community design.

The right of prior use does not extend to granting a licence to another person to exploit the design. The right of prior use cannot be transferred except, where the third person is a business, along with that part of the business in the course of which the act was done or the preparations were made.

12. Community designs as object of property

12.1. Community design as a national design right

A Community design as an object of property shall be dealt with in its entirety, and for the whole area of the Community, as a national design right of the Member State in which: (a) the holder has his seat or his domicile on the relevant date; or (b) where point (a) does not apply, the holder has an establishment on the relevant date. In the case of a registered Community design, this shall apply according to the entries in the register.⁵

⁵ This shall be the case unless Articles 28, 29, 30, 31 and 32 of the Regulation provide otherwise

In the case of joint holders, if two or more of them fulfil the condition of seat or domicile i.e. establishment on the relevant date, the Member State shall be determined: (a) in the case of an unregistered Community design, by reference to the relevant joint holder designated by them by common agreement; (b) in the case of a registered Community design, by reference to the first of the relevant joint holders in the order in which they are mentioned in the register. Where these conditions do not apply, the Member State shall be the Member State in which the seat of the Office is situated.

12.2. The transfer of a registered Community design

The transfer of a registered Community design is subject to the following provisions:(a) at the request of one of the parties, a transfer shall be entered in the register and published;(b) until such time as the transfer has been entered in the register, the successor in title may not invoke the rights arising from the registration of the Community design; (c) where there are time limits to be observed in dealings with the Office, the successor in title may make the corresponding statements to the Office once the request for registration of the transfer has been received by the Office; (d) all documents which require notification to the holder of the registered Community design shall be addressed by the Office to the person registered as holder or his representative, if one has been appointed⁶.

12.3. Rights in rem on registered Community design

A registered Community design may be given as security or be the subject of rights in rem. On request of one of the parties, these rights shall be entered in the register and published. A registered Community design may be levied in execution. As regards the procedure for levy of execution in respect of a registered Community design, the courts and authorities of the Member State shall have exclusive jurisdiction⁷. On request of one of the parties, levy of execution shall be entered in the register and published.

⁶ (Article 66: Notifications reads: “The Office shall, as a matter of course, notify those concerned of decisions and summonses and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of this Regulation or of the implementing regulation, or of which notification has been ordered by the President of the Office.)

⁷ The courts and authorities of the Member State are determined in accordance with Article 27: Dealing with Community designs as national design rights

The only insolvency proceedings in which a Community design may be involved shall be those opened in the Member State within the territory of which the centre of a debtor's main interests is situated. In the case of joint proprietorship of a Community design, this shall apply to the share of the joint proprietor. Where a Community design is involved in insolvency proceedings, on request of the competent national authority an entry to this effect shall be made in the register and published in the Community Designs Bulletin⁸.

12.4. Licencing

A Community design may be licensed for the whole or part of the Community. A licence may be exclusive or non-exclusive. Without prejudice to any legal proceedings based on the law of contract, the holder may invoke the rights conferred by the Community design against a licensee who contravenes any provision in his licensing contract with regard to its duration, the form in which the design may be used, the range of products for which the licence is granted and the quality of products manufactured by the licensee. Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a Community design only if the right holder consents thereto. However, the holder of an exclusive licence may bring such proceedings if the right holder in the Community design, having been given notice to do so, does not himself bring infringement proceedings within an appropriate period. A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in an infringement action brought by the right holder in a Community design. In the case of a registered Community design, the grant or transfer of a licence in respect of such right shall, at the request of one of the parties, be entered in the register and published. The effects vis-a-vis third parties of the legal acts related to (a) transfer of the registered Community design, (b) rights in rem on a registered Community design, (c) levy of execution and (d) licensing are governed by the law of the Member State. As regards registered Community designs, legal acts related to (a) transfer of the registered Community design, (b) rights in rem on a registered Community design and licensing, have effect vis-a-vis third parties in all the Member States after entry in the

⁸ OHIM periodically publishes a Community Designs Bulletin containing entries open to public inspection in the register as well as other particulars the publication of which is prescribed by this Regulation or by the implementing regulation. Notices and information of a general character issued by the President of the Office, as well as any other information relevant to this Regulation or its implementation, are published in the Official Journal of the Office.

register. Nevertheless such an act, before it is so entered, shall have effect vis-a-vis third parties who have acquired rights in the registered Community design after the date of that act but who knew of the act at the date on which the rights were acquired. The Member State is determined in accordance with Article 27: Dealing with Community designs as national design rights. The rules in regard to the effects vis-à-vis third parties for the registered Community design do not apply to a person who acquires the registered Community design or a right concerning the registered Community design by way of transfer of the whole of the undertaking or by any other universal succession.

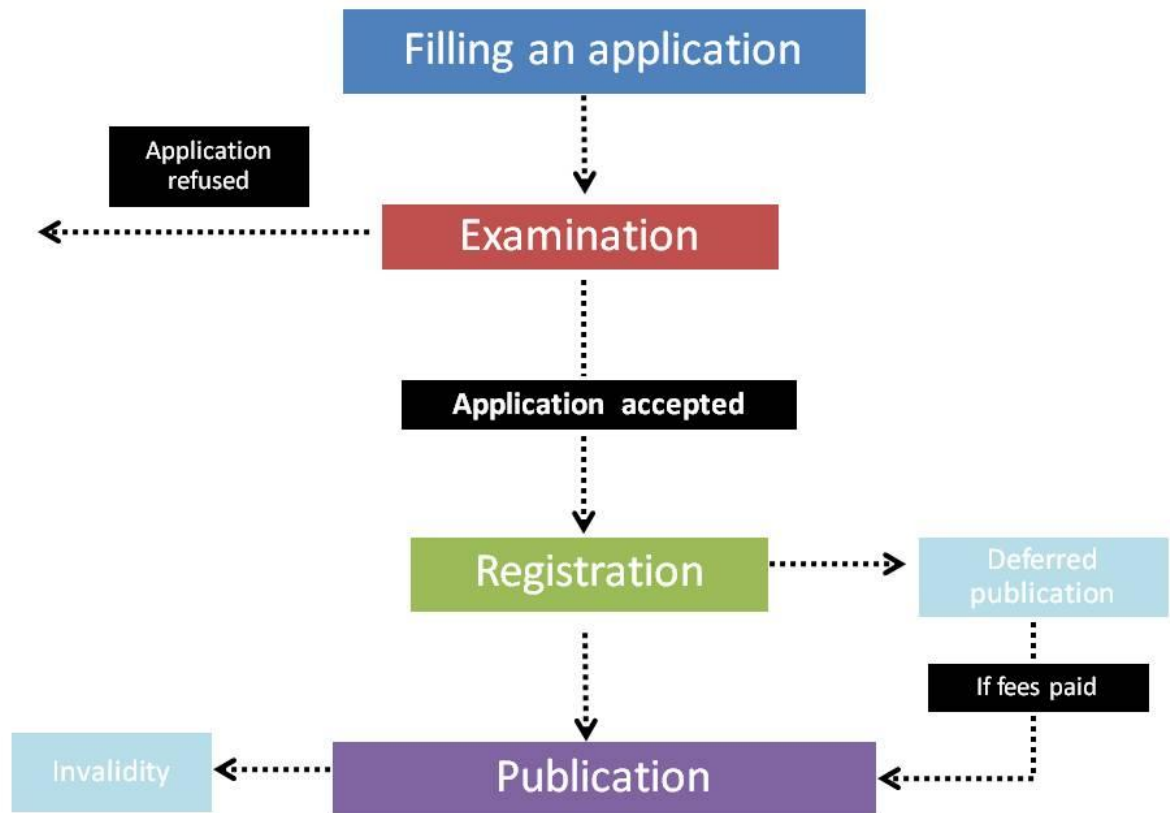
12.5. Effects vis-a-vis third parties

The effects vis-a-vis third parties of the legal acts related to (a) transfer of the registered Community design, (b) rights in rem on a registered Community design, (c) levy of execution and (d) licensing are governed by the law of the Member State⁹. As regards registered Community designs, legal acts related to (a) transfer of the registered Community design, (b) rights in rem on a registered Community design and licensing, have effect vis-a-vis third parties in all the Member States after entry in the register. Nevertheless, such an act, before it is so entered, shall have effect vis-a-vis third parties who have acquired rights in the registered Community design after the date of that act but who knew of the act at the date on which the rights were acquired.

Until such time as common rules for the Member States in the field of insolvency enter into force, the effects vis-a-vis third parties of insolvency proceedings are governed by the law of the Member State in which such proceedings are first brought under the national law or the regulations applicable in this field.

⁹ The Member State is determined in accordance with Article 27: Dealing with Community designs as national design rights. The rules in regard to the effects vis-à-vis third parties for the registered Community design do not apply to a person who acquires the registered Community design or a right concerning the registered Community design by way of transfer of the whole of the undertaking or by any other universal succession.

13. Registration process for Registered Community design



An application may be filed at: OHIM; or central industrial property office of a Member State; or in the Benelux countries, at the Benelux Design Office. The application must satisfy the requirements in terms of its contents. There is possibility for multiple applications.

As date of filing the registration will be considered the date on which documents (containing the minimum information required) are filed. In the application the applicant may claim priority. (Optional Request for Deferment). When the application is not filed at OHIM, the office where the application was filed forwards the application to OHIM. At OHIM an application may be filed online, by fax or by mail (OHIM encourages on-line applications).

The application, in terms of content, should have at least: 1) name and address of the applicant; 2) indication of the first and second language; 3) at least one visual representation of the design; 4) Indication of the type of product designed (by Locarno Classification); 5) Signature.

The applicant can file as many designs as he wishes, under the condition that the products to which the design is applied belong to the same class of product. This condition does not apply

when an application concerns ornamentation. The only upper limit concerning the number of designs within a multiple application relates to an application made online, when it is limited to 99 designs per application.

As date of filing the registration will be considered the date on which documents containing the specified information are filed by the applicant with the OHIM /central industrial property office of a Member State /Benelux Design Office. If the application filed with the central industrial property office/Benelux Design Office reaches the OHIM more than two months after the date on which documents containing the specified information have been filed shall be the date of receipt of such documents by the Office. The priority may be claimed on the basis of a previous (first) application(s) of a design or utility model (but not on the basis of a patent application) filed in or for a State which is party to the Paris Convention or a member of the WTO. Priority can only be claimed where the application for a Community design is filed within six months from the date of filing of the first application(s). It is highly recommended that the priority is claimed in the application. The claim of priority needs to be supported by a priority document which is recommended to be enclosed with the application. The applicant may request deferment of the publication. Publication may be delayed for up to 30 months upon request of the applicant. The request for deferment must be made on the application form; late requests will not be accepted.

13.1. Examination

The applications are checked mainly for formalities. There is no substantive examination, except to verify that the application is for a design and that the design is not contrary to public policy or morality. If the application does not meet the formal requirements, the applicant is called to amend the application in set period of time. Examination of formalities: name, address, language, signature, priority date(s), fees, description, designer and indication of product/classification; representations: public policy and morality, and if the application qualifies as a design.

The deficiency in the application that does not meet the formal requirements is usually called remedial deficiency. In existence of such, objection is raised by OHIM (usually called a "deficiency letter" and contain a time limit for the applicant's reply). Following the letter the applicant may make amendments of the application and the procedure continues. If application is not amended, this may lead to its refusal in the case of non-compliance with the requirement. If the applicant does not reply to the "deficiency letter" within two months, this could lead to the

refusal of the application, the deletion of certain views or to the loss of the claim of the priority right. OHIM may refuse the application if it is made for: design for which protection is sought does not correspond to the definition of design ; design for which protection is sought is contrary to public policy or to accepted principles of morality. The application shall not be refused before the applicant has been allowed the opportunity of withdrawing or amending the application or of submitting his observations. If examination reveals no problems the design is registered and published immediately. In the case of deferred publication, the design will be published upon request – such a request can be filed within 27 months from the filing date (or within the same period from the priority date, if applicable).

13.2. Registration and Publication

OHIM registers the application in the Community design Register as a registered Community design. Upon registration, OHIM publishes the registered Community design in the Community Designs Bulletin. The publication may be deferred for a period of 30 months. The registration bears the date of filing of the application (the date referred to in Article 38 of the Regulation).

a) Publication

The publication of the RCD contains: File number; Language of filing and second language; Date of filing, date of entry into the Register, date of publication; Registration number; Name(s) of designer(s) or team of designers; Name and address of the holder; Name and business address of the representative; Locarno classification; Indication of the product(s); Country, date and number of application for which priority is claimed (Paris Convention priority); Name, place and date on which the design was first exhibited (exhibition priority); Indication that a specimen/description was filed; Representation of the design.

The applicant may request, that the publication of the RCD be deferred for a period of 30 months from the date of filing the application/date of priority. Upon such request, the RCD shall be registered (provided conditions are met) but neither the representation of the design nor any file relating to the application shall be open to public inspection. OHIM in the Community Designs Bulletin publishes a mention of the deferment of the publication of the registered Community design. The mention is accompanied by information identifying the right holder in the RCD, the date of filing the application and any other particulars prescribed by the implementing regulation. At the expiry of the period of deferment, or at any earlier date on request by the right holder, the OHIM opens to public inspection all the entries in the register and the file relating to the

application and shall publish the registered Community design in the Community Designs Bulletin, provided that, within prescribed time limit : (a) the publication fee and, in the event of a multiple application, the additional publication fee are paid; (b) where use has been made of the option pursuant to Article 36(1)(c), the right holder has filed with the Office a representation of the design. If the right holder fails to comply with these requirements, the registered Community design/some of the designs in the case of multiple application shall be deemed from the outset not to have had the effect. The institution of legal proceedings on the basis of a RCD during the period of deferment of publication shall be subject to the condition that the information contained in the register and in the file relating to the application has been communicated to the person against whom the action is brought.

b) Maintenance of registration

At least six months before expiry of the registration, OHIM informs the holder, and any person having a right entered in the Register, including a licensee, in respect of the Community design, that the registration is approaching expiry and that an application for renewal of registration should be filed and fees for renewal to be paid. If the fees for the renewal are paid, this shall be deemed to constitute a request for renewal provided that it contains all the indications required. Where the application for renewal is filed within the prescribed time limits, but the other conditions for renewal are not satisfied, OHIM informs the applicant of the deficiencies. Where an application for renewal is not submitted or is submitted after expiry of the prescribed time limits, or if the fees are not paid or are paid only after expiry of the relevant time limit, or if the deficiencies are not remedied within the time limit specified by OHIM, the Office shall determine that the registration has expired and shall notify the holder accordingly. In the case of a multiple registration, where the fees paid are insufficient to cover all the designs for which renewal is requested, such a determination shall be made only after the OHIM has established which designs the amount paid is intended to cover. In the absence of other criteria for determining which designs are intended to be covered, the OHIM shall take the designs in the numerical order in which they are represented in the application for registration. The OHIM shall determine that the registration has expired with regard to all designs for which the renewal fees have not been paid or have not been paid in full. Where this determination has become final, the OHIM shall cancel the design from the Register with effect from the day following the day on which the existing registration expired. Where the renewal fees have been paid but the

registration is not renewed, those fees shall be refunded. A single application for renewal may be submitted for two or more designs, whether or not part of the same multiple registration, upon payment of the required fees for each of the designs, provided that the holders or the representatives are the same in each case.

14. Termination of the registered Community design

14.1.Surrender of the registered Community design

The surrender of a RCD is declared to the Office in writing by the right holder. The surrender does not have effect until it is entered in the Register. If RCD which is subject to deferment of publication is surrendered it shall be deemed from the outset not to have had the effects specified in the Regulation. RCD may be partially surrendered provided that its amended form complies with the requirements for protection and the identity of the design is retained. Surrender is registered only with the agreement of the proprietor of a right entered in the Register. If a licence has been registered, surrender is entered in the register only if the right holder in the RCD proves that he has informed the licensee of his intention to surrender.

If an action relating to the entitlement to a RCD has been brought before a Community design court, the Office shall not enter the surrender in the register without the agreement of the claimant.

14.2.Declaration of invalidity

A registered Community design shall be declared invalid on application to the OHIM or by a Community design court on the basis of a counterclaim in infringement proceedings. A Community design may be declared invalid even after the Community design has lapsed or has been surrendered. An unregistered Community design shall be declared invalid by a Community design court on application to such a court or on the basis of a counterclaim in infringement proceedings. The Regulation provides set of rules for surrender and invalidity of the registered Community design (Title VI of the Regulation) and the appeals procedures (Title VII of the Regulation) .

The grounds of invalidity of the Community design are provided numerus clausus in the Regulation i.e. as Art. 25 (1) stipulates “A Community design may be declared invalid only in the following cases ... “

1. The design does not correspond to the definition of design¹⁰;
2. The design does not fulfil the protection requirements¹¹;
3. The right holder is not entitled to the Community design, by virtue of a court decision¹²;
4. The Community design is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date: by a registered Community design or an application for such a design, or by a registered design right of a Member State, or by an application for such a right, or by a design right registered under the Geneva Act of the Hague Agreement, or by an application for such a right¹³. This ground may be invoked solely by the applicant for or holder of the earlier right, and it is without prejudice to the freedom of Member States to provide that the ground may also be invoked by the appropriate authority of the Member State in question on its own initiative¹⁴.

¹⁰ **Definitions** (Article 3(1)) For the purposes of this Regulation: (a) "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation; (b) "product" means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs; (c) "complex product" means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

¹¹ the "protection requirements" in this sense refers to the requirements set by Art. 4 to Art. 9 of the Regulation (Article 4: Requirements for protection, Article 5: Novelty, Article 6 : Individual character, Article 7: Disclosure, Article 8: Designs dictated by their technical function and designs of interconnections, Article 9: Designs contrary to public policy or morality). A registered Community design which has been declared invalid pursuant to this ground may be maintained in an amended form, if in that form it complies with the requirements for protection and the identity of the design is retained. "Maintenance" in an amended form may include registration accompanied by a partial disclaimer by the holder of the registered Community design or entry in the register of a court decision or a decision by the Office declaring the partial invalidity of the registered Community design

¹² This point refers to Article 14 of the Regulation that reads: "1. The right to the Community design shall vest in the designer or his successor in title. 2. If two or more persons have jointly developed a design, the right to the Community design shall vest in them jointly. 3. However, where a design is developed by an employee in the execution of his duties or following the instructions given by his employer, the right to the Community design shall vest in the employer, unless otherwise agreed or specified under national law. This ground may be invoked solely by the person who is entitled to the Community design under Article 14.

¹³ Article 25 (d) regulating this issue is amended by Council Regulation (EC) No 1891/2006 of 18.12.2006, and entered into force on 1 January 2008.

¹⁴ This ground may be invoked solely by the applicant for or holder of the earlier right. A registered Community design which has been declared invalid pursuant to this ground may be maintained in an amended form, if in that form it complies with the requirements for protection and the identity of the design is retained. "Maintenance" in an amended form may include registration accompanied by a partial disclaimer by the holder of the registered Community design or entry in the register of a court decision or a decision by the Office declaring the partial invalidity of the registered Community design.

5. A distinctive sign is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use¹⁵;
6. The design constitutes an unauthorised use of a work protected under the copyright law of a Member State¹⁶;
7. The design constitutes an improper use of any of the items listed in Article 6ter of the Paris Convention, or of badges, emblems and escutcheons other than those covered by the said Article 6ter and which are of particular public interest in a Member State.

14.2.1. declaration of invalidity by OHIM

Application for a declaration of invalidity may be submitted to the OHIM by any natural or legal person, as well as a public authority empowered to do so¹⁷. It is filed in a written reasoned

¹⁵ This ground may be invoked solely by the applicant for or holder of the earlier right. A registered Community design which has been declared invalid pursuant to this ground may be maintained in an amended form, if in that form it complies with the requirements for protection and the identity of the design is retained. "Maintenance" in an amended form may include registration accompanied by a partial disclaimer by the holder of the registered Community design or entry in the register of a court decision or a decision by the Office declaring the partial invalidity of the registered Community design.

¹⁶ This ground may be invoked solely by the person or entity concerned by the use. It is without prejudice to the freedom of Member States to provide that the ground may also be invoked by the appropriate authority of the Member State in question on its own initiative. A registered Community design which has been declared invalid pursuant to paragraph (1)(b), (e), (f) or (g) may be maintained in an amended form, if in that form it complies with the requirements for protection and the identity of the design is retained. "Maintenance" in an amended form may include registration accompanied by a partial disclaimer by the holder of the registered Community design or entry in the register of a court decision or a decision by the Office declaring the partial invalidity of the registered Community design.

¹⁷ empowerment is provided in Article 25 of the Regulation. The group of persons includes: the person who is entitled to the Community design under Article 14; the applicant for or holder of the earlier right; appropriate authority of the Member State in question on its own application. An application to the Office for a declaration of invalidity should contain:(a) as concerns the registered Community design for which the declaration of invalidity is sought: its registration number; the name and address of its holder; (b) as regards the grounds on which the application is based: a statement of the grounds on which the application for a declaration of invalidity is based; additionally, in the case of an application pursuant to Article 25(1)(d) of Regulation (EC) No 6/2002, the representation and particulars identifying the prior design on which the application for a declaration of invalidity is based and showing that the applicant is entitled to invoke the earlier design as a ground for invalidity pursuant to Article 25(3) of that Regulation; Additionally, in the case of an application pursuant to Article 25(1)(e) or (f) of Regulation (EC) No 6/2002, the representation and particulars identifying the distinctive sign or the work protected by copyright on which the application for a declaration of invalidity is based and particulars showing that the applicant is the holder of the earlier right pursuant to Article 25(3) of that Regulation; Additionally, in the case of an

statement, and it is not deemed to have been filed until the fee for an application for a declaration of invalidity is paid. It is not admissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a Community design court and has acquired the authority of a final decision.

If OHIM finds that the application is admissible, it examines whether the grounds for invalidity prejudice the maintenance of the registered Community design. In the examination of the application OHIM invites the parties, as often as necessary, to file observations, within a period fixed by OHIM, on communications from the other parties or issued by itself. The decision declaring the registered Community design invalid, upon becoming final, is entered in the Registry. In the event of filing application for a declaration of invalidity RCD, and as long as no final decision has been taken by OHIM, any third party who proves that proceedings for infringement of the same design have been instituted against him may be joined as a party in the invalidity proceedings on request submitted within three months of the date on which the infringement proceedings were instituted. The same applies in respect of any third party who proves both that the right holder of the Community design has requested that he cease an alleged infringement of the design and that he has instituted proceedings for a court ruling that he is not infringing the Community design. The request to be joined as a party is filed in a written reasoned statement and it shall not be deemed to have been filed until the invalidity fee has been paid. Thereafter the request, unless exceptions are provided is treated as an application for a declaration of invalidity.

14.2.2. declaration of invalidity by Community design court

The issue of invalidity may be brought before the Community design court, as an action or a counterclaim for a declaration of invalidity of a Community design. They may only be based on the grounds for invalidity mentioned in Article 25, and brought by the person entitled under

application pursuant to Article 25(1)(g) of the Regulation (EC) No 6/2002, the representation and particulars of the relevant item as referred to in that Article and particulars showing that the application is filed by the person or entity concerned by the improper use pursuant to Article 25(4) of that Regulation; Where the ground for invalidity is that the registered Community design does not fulfil the requirements set out in Article 5 or 6 of Regulation (EC) No 6/2002, the indication and the reproduction of the prior designs that could form an obstacle to the novelty or individual character of the registered Community design, as well as documents proving the existence of those earlier designs; An indication of the facts, evidence and arguments submitted in support of those grounds; (c) as concerns the applicant: his/her name and address in accordance with Article 1(1)(b) of the Implementing Regulation; if the applicant has appointed a representative, the name and the business address of the representative, in accordance with Article 1(1)(e) of the Implementing Regulation; Additionally, in the case of an application pursuant to Article 25(1)(c) of Regulation (EC) No 6/2002, particulars showing that the application is made by a person or by persons duly entitled pursuant to Article 25(2) of that Regulation.

those provisions. If the counterclaim is brought in a legal action to which the right holder of the Community design is not already a party, he shall be informed thereof and may be joined as a party to the action in accordance with the conditions set out in the law of the Member State where the court is situated. The validity of a Community design may not be put in issue in an action for a declaration of non-infringement. Where in a proceeding before a Community design court the Community design has been put in issue by way of a counterclaim for a declaration of invalidity the court shall: (a) declare the Community design invalid if any of the grounds mentioned in Article 25 are found to prejudice the maintenance of the Community design; or (b) shall reject the counterclaim, if none of the grounds mentioned in Article 25 is found to prejudice the maintenance of the Community design.

The Community design court with which a counterclaim for a declaration of invalidity of a registered Community design has been filed informs OHIM of the date on which the counterclaim was filed. OHIM records this fact in the register.

The Community design court hearing a counterclaim for a declaration of invalidity of a registered Community design may, on application by the right holder of the registered Community design and after hearing the other parties, stay the proceedings and request the defendant to submit an application for a declaration of invalidity to OHIM within a time limit determined by the court. If the application is not made within the time limit, the proceedings shall continue; the counterclaim shall be deemed withdrawn. Where a Community design court has given a judgment which has become final on a counterclaim for a declaration of invalidity of a registered Community design, a copy of the judgment is sent to the OHIM who mentions the judgment in the register. Counterclaim for a declaration of invalidity of a registered Community design cannot be made if an application relating to the same subject matter and cause of action, and involving the same parties, has already been determined by the Office in a decision which has become final. When it has become final, a judgment of a Community design court declaring a Community design invalid shall have in all the Member States the effects specified in Article 26.

14.3. Effect of the decision for invalidity

A Community design shall be deemed not to have had, as from the outset, the effects specified in the Regulation, to the extent that it has been declared invalid. Subject to the national provisions relating either to claims for compensation for damage caused by negligence or lack of good faith

on the part of the holder of the Community design, or to unjust enrichment, the retroactive effect of invalidity of the Community design shall not affect: (a) any decision on infringement which has acquired the authority of a final decision and been enforced prior to the invalidity decision; (b) any contract concluded prior to the invalidity decision, in so far as it has been performed before the decision; however, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract may be claimed on grounds of equity.

In regard to invalidity it is to be noted that in proceedings in respect of an infringement action or an action for threatened infringement of a registered Community design, the Community design court shall treat the Community design as valid. Validity may be challenged only with a counterclaim for a declaration of invalidity. However, a plea relating to the invalidity of a Community design, submitted otherwise than by way of counterclaim, shall be admissible in so far as the defendant claims that the Community design could be declared invalid on account of an earlier national design right, within the meaning of Article 25(1)(d), belonging to him. In proceedings in respect of an infringement action or an action for threatened infringement of an unregistered Community design, the Community design court shall treat the Community design as valid if the right holder produces proof that the conditions laid down in Article 11 have been met and indicates what constitutes the individual character of his Community design. However, the defendant may contest its validity by way of a plea or with a counterclaim for a declaration of invalidity.

15. Appeals against OHIM's decisions

Decisions of the Office shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments. In proceedings before it, OHIM examines the facts of its own motion. However, in proceedings relating to a declaration of invalidity, the OHIM is restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought. OHIM may disregard facts or evidence which are not submitted in due time by the parties concerned. In regard of the time of appealing it should be noted that the notice of appeal shall be deemed to have been filed only when the fee for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

Decisions subject to appeal may be: 1) Decisions of the examiners; 2) Decisions of the Administration of Trade Marks and Designs and Legal Division; 3) Decisions of Invalidity

Divisions. Person entitled to appeal the decision are: a) Any party to proceedings adversely affected by a decision may appeal; b) Any other parties to the proceedings shall be parties to the appeal proceedings as of right.

The notice of appeal must be filed in writing at the Office within two months after the date of notification of the decision appealed from.

The appeal has suspensive effect. A decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.

15.1.Procedure upon appeal

The procedure upon appeal starts with interlocutory revision, Namely, if the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision. This shall not apply where the appellant is opposed by another party to the proceedings. If the decision is not rectified within one month after receipt of the statement of grounds, the appeal shall be remitted to the Board of Appeal without delay and without comment as to its merits.

The procedure continues by examination of appeals. If the appeal is admissible, the Board of Appeal shall examine whether the appeal is to be allowed (examination as to the merits of the appeal). In the examination of the appeal, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself.

15.2.Decisions upon appeals

The Board of Appeal may exercise any power within the competence of the department which was responsible for the decision appealed against. The Board of Appeal may remit the case to that department for further prosecution. If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts are the same. The decisions of the Boards of Appeal shall take effect only two months from the notification on the decision or, if an action has been brought before the Court of Justice within a period of two months from the notification on the decision, from the date of rejection of such action.

15.3.Actions before the Court of Justice

Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals. The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of the Regulation or of any rule of law relating to their application or misuse of power. The Court of Justice has jurisdiction to annul or to alter the contested decision. The action shall be open to any party to proceedings before the Board of Appeal adversely affected by its decision. The action shall be brought before the Court of Justice within two months of the date of notification of the decision of the Board of Appeal. The Office shall be required to take the necessary measures to comply with the judgment of the Court of Justice.

16. Representation

16.1.general principles of representation

No person shall be compelled to be represented before OHIM. Natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Community must be represented before the OHIM in all proceedings before the OHIM, except in filing an application for a RCD. Natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the Community may be represented before the OHIM by one of their employees, who must file with it a signed authorisation for inclusion in the files. An employee of a legal person to which this paragraph applies may also represent other legal persons which have economic connections with the first legal person, even if those other legal persons have neither their domicile nor their principal place of business nor a real and effective industrial or commercial establishment within the Community. The authorisation of employees acting on behalf of natural or legal persons is in detail regulated by the Implementing Regulation. The authorisation may be filed in any of the official languages of the Community and it may cover one or more applications or registered Community designs or may be in the form of a general authorisation allowing the representative to act in respect of all proceedings before the Office to which the person who has issued it is a party. In the cases where an authorisation has to be filed, OHIM specifies the time limit within which such authorisation shall be filed. If the authorisation is not filed in due time, proceedings shall be continued with the represented person.

Any procedural steps other than the filing of the application taken by the representative shall be deemed not to have been taken if the represented person does not approve them. This applies mutatis mutandis to a document withdrawing an authorisation. Any representative who has ceased to be authorised shall continue to be regarded as the representative until the termination of his/her authorisation has been communicated to OHIM. Subject to any provisions to the contrary contained therein, an authorisation shall not terminate vis-a-vis OHIM upon the death of the person who gave it. Where several representatives are appointed by the same party, they may, notwithstanding any provisions to the contrary in their authorisations, act either collectively or individually. The authorisation of an association of representatives shall be deemed to be an authorisation of any representative who can establish that he/she practises within that association.

16.2. Professional representation

Representation of natural or legal persons in proceedings before OHIM under the Regulation may only be undertaken by: legal practitioner qualified in one of the Member States and having his place of business within the Community, to the extent that he is entitled, within the said State, to act as a representative in industrial property matters; or professional representatives whose name has been entered on the list of professional representatives; or persons whose names are entered on the special list of professional representatives for design matters.

Conditions for entry in the special list of professional representatives in design matters are: he must be a national of one of the Member States; he must have his place of business or employment in the Community; he must be entitled to represent natural or legal persons in design matters before the central industrial property office of a Member State or before the Benelux Design Office. Entry on the list is effected upon request, accompanied by a certificate furnished by the central industrial property office of the Member State concerned, which must indicate that the conditions are fulfilled. On the condition the person to be a national of one of the Member States exception may be granted by President of OHIM in special circumstances. In regard to the condition the person to be entitled to represent natural or legal persons in design matters before the central industrial property office of a Member State or before the Benelux Design Office, it should be noted that where, in that State, the entitlement to represent in design matters is not conditional upon the requirement of special professional qualifications, persons applying to be entered on the list must have habitually acted in design matters before the central

industrial property office of the said State for at least five years. Exception may be granted by the President of OHIM if the applicant furnishes proof that he has acquired the requisite qualification in another way. However, persons whose professional qualification to represent natural or legal persons in design matters before the central industrial property office of one of the Member States is officially recognised in accordance with the regulations laid by such State shall not be subject to the condition of having exercised the profession.

17. Jurisdiction and procedure in legal actions relating to community designs

17.1. Jurisdiction

The Convention on Jurisdiction and Enforcement¹⁸ shall be applied in proceedings relating to Community designs and applications for registered Community designs, as well as to proceedings relating to actions on the basis of Community designs and national designs enjoying simultaneous protection. In the disputes concerning the infringement and validity of Community designs the competent authority are Community design courts - national courts and tribunals of first and second instance designated by the Member States in their territories. The courts have exclusive jurisdiction: (a) for infringement actions and - if they are permitted under national law - actions in respect of threatened infringement of Community designs; (b) for actions for

¹⁸ Convention on Jurisdiction and Enforcement - Convention on Jurisdiction and the Enforcement of Judgements in Civil and Commercial Matters, signed in Brussels on 27 September 1968 (OJ L 299, 31.12.1972, p. 32. Convention as amended by the Conventions on the Accession to that Convention of the States acceding to the European Communities) . It is applied as determined in Article 79 of the Regulation. The Regulation provides rules for International jurisdiction of the Community design courts (Article 82, International jurisdiction : 1. Subject to the provisions of this Regulation and to any provisions of the Convention on Jurisdiction and Enforcement applicable by virtue of Article 79, proceedings in respect of the actions and claims referred to in Article 81 shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment. 2. If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment. 3. If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the Office has its seat. 4. Notwithstanding paragraphs 1, 2 and 3: (a) Article 17 of the Convention on Jurisdiction and Enforcement shall apply if the parties agree that a different Community design court shall have jurisdiction; (b) Article 18 of that Convention shall apply if the defendant enters an appearance before a different Community design court. 5. Proceedings in respect of the actions and claims referred to in Article 81(a) and (d) may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened) When the Community design court has jurisdiction based on these rules, this jurisdiction is in respect of acts of infringement committed or threatened within the territory of any of the Member States. Proceedings in respect of the actions for infringement and for counterclaims for a declaration of invalidity may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened. In deliberating and deciding, the Community design courts apply the provisions of the Regulation. On all matters not covered by the Regulation the Community design courts apply their national law, including its private international law.

declaration of non-infringement of Community designs, if they are permitted under national law;
(c) for actions for a declaration of invalidity of an unregistered Community design;

17.2.Measures

Where the Community design court finds in the procedure that the defendant has infringed or threatened to infringe a Community design, it shall, unless there are special reasons for not doing so, order the following measures: (a) an order prohibiting the defendant from proceeding with the acts which have infringed or would infringe the Community design; (b) an order to seize the infringing products;(c) an order to seize materials and implements predominantly used in order to manufacture the infringing goods, if their owner knew the effect for which such use was intended or if such effect would have been obvious in the circumstances; (d) any order imposing other sanctions appropriate under the circumstances which are provided by the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law.

17.3.Jurisdiction of Community design courts of second instance - further appeal.

An appeal to the Community design courts of second instance shall lie from judgments of the Community design courts of first instance in respect of proceedings arising from the actions and claims to the first instance Community design court. The conditions under which an appeal may be lodged with a Community design court of second instance are determined by the national law of the Member State in which that court is located. The national rules concerning further appeal are in respect of judgments of Community design courts of second instance.

An applicant that has a national design registration can apply for a registered Community design, provided he files an application at EU level within one year of the disclosure of the national design. If the national design application was filed less than six months before the Community design application, then it is possible to claim the priority of that earlier application within the RCD application.

18. Relationship with the national legal systems on Industrial Design

An applicant that has a national design registration can apply for a registered Community design, provided he files an application at EU level within one year of the disclosure of the national design. If the national design application was filed less than six months before the Community design application, then it is possible to claim the priority of that earlier application within the RCD application.

A design protected by a Community design is also eligible for protection under the law of copyright of Member States as from the date on which the design was created or fixed in any form. The extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State

The provisions of the Regulation shall be without prejudice to any provisions of Community law or of the law of the Member States concerned relating to unregistered designs, trademarks or other distinctive signs, patents and utility models, typefaces, civil liability and unfair competition.

The regulation defines the rules on parallel action. Namely, where actions for infringement or for threatened infringement involving the same cause of action and between the same parties are brought before the courts of different Member States, one seized on the basis of a Community design and the other seized on the basis of a national design right providing simultaneous protection, the court other than the court first seized shall of its own motion decline jurisdiction in favour of that court. The court which would be required to decline jurisdiction may stay its proceedings if the jurisdiction of the other court is contested.

The Community design court hearing an action for infringement or threatened infringement on the basis of a Community design shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of a design right providing simultaneous protection.

The court hearing an action for infringement or for threatened infringement on the basis of a national design right shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of a Community design providing simultaneous protection.

19. Relationship with the international registration of Industrial Design

The Provisions of Regulation apply to registrations of industrial designs in the international register designating the Community. The recordings and publications have the same effect.

In the international registration designating the Community the international applications are filed directly at the International Bureau. An international registration designating the Community, from the date of its registration, has the same effect as an application for a registered Community design. The OHIM however has the possibility for refusal if the design for which protection is sought does not correspond to the definition of design by the Regulation or is

contrary to public policy or to accepted principles of morality. It also has the possibility for declaration of invalidity

Unless otherwise specified, the Regulation and any Regulations implementing it, apply, *mutatis mutandis*, to registrations of industrial designs in the international register maintained by the International Bureau of WIPO designating the Community, under the Geneva Act. Any recording of an international registration designating the Community in the International Register has the same effect as if it had been made in the register of Community designs of OHIM. Any publication of an international registration designating the Community in the Bulletin of the International Bureau of WIPO has the same effect as if it had been published in the Community Designs Bulletin.

If in carrying out an examination of an international registration, OHIM notices that the design for which protection is sought does not correspond to the definition of design by the Regulation or is contrary to public policy or to accepted principles of morality, OHIM shall communicate to the International Bureau of WIPO a notification of refusal not later than six months from the date of publication of the international registration,

The effects of an international registration in the Community shall not be refused before the holder has been allowed the opportunity of renouncing the international registration in respect of the Community or of submitting observations.

The effects of an international registration in the Community may be declared invalid partly or in whole in accordance with the procedure set in the Regulation or by a Community design court on the basis of a counterclaim in infringement proceedings. Where OHIM is aware of the invalidation, it shall notify it to the International Bureau of WIPO.