

## Design - FAQs

Delivered by the competent authority, the registered design is an official title that protects **the outside aesthetics appearance** of a product or parts constituting such product.

### ➤ What is the object of the protection ?

A design protects the outside aesthetics appearance conferred to an object by its **shape, configuration, outlines, patterns, decorative elements, material** (as well as any combination of these elements).

### ➤ How to protect a design ?

In most countries, notably in Switzerland, United States and the European Community, a design can be protected via a registered design, an official title delivered by the Intellectual Property Office of the country. To obtain this official title, it is necessary to file a request for registration of a design with the national/regional Office of Intellectual Property <sup>1</sup>.

*<sup>1</sup> There are differences in national laws governing the registration of the design, the scope of protection of the registered title and duration of protection, as well as in their application. The title of the right granted also varies between countries, e.g. "design patent" in the United States, "Geschmacksmuster" in Germany.*

In certain jurisdictions, notably in the European Community and in United Kingdom, there exists also a form of protection (under certain conditions and in a more limited manner) for non-registered designs « unregistered design rights ».

### ➤ Which are the criteria for registration ?

To be protected, a design must satisfy three basic criteria <sup>2</sup> :

- ✓ **novelty:** a design is not novel if an identical design has been made available to the public before the filing date.
- ✓ **Originality:** a design must differ from previous existing designs by major characteristics belonging to the overall impression given by said design.
- ✓ **Conformity to the law and morality:** a design must not be contrary to either law or morality.

*<sup>2</sup> The above criteria for registration reflect the laws of many countries. However, there are national differences in these laws and their application. Many offices of intellectual property (including Switzerland) do not check, during the examination of the application for registration, if these criteria are met.*

*! In Switzerland, for a design not to be novel, it is also necessary that the people belonging to the specialized circles in the field concerned in Switzerland could have had knowledge of the identical design. Moreover, the holder of the design may disclose his design till up to twelve months (grace period) preceding the date of filing of this design without destroying novelty. A grace period is also allowed in some other countries (including the European Community and the United States).*

## ➤ What is the scope of the protection ?

The holder of a registered design has the right to prevent any third party from using, for industrial purposes (e.g. manufacture, storage, offer, import, export, transit), an object in which the design concerned (or a design that does not differ significantly from the latter) is incorporated or to which it is applied, in the country where the design was registered, during the period of validity of the registered design. The registered design is protected against both deliberate copying and the independent development of a similar design <sup>3</sup>.

<sup>3</sup> *The level of protection described above reflects the legal provisions in many countries. However, there are national differences in these laws and their application.*

Protection of **unregistered design** (only possible in certain jurisdictions, notably the European Community and the United Kingdom) gives its holder a more limited level of protection. In particular, an unregistered Community design confers on its proprietor only the right to prohibit the copy of said design.

The **scope of protection** is defined by the representation(s) provided at filing.

**Principle of territoriality:** a design has an effect only in the country in which it is registered and in force. Outside this territory, anyone can use the design (subject to other rights which could protect against the use of the design, including unfair competition, copyrights, or unregistered design rights).

## ➤ What is the length of protection <sup>4,5</sup> ?

**For a registered design: 5 years minimum, 25 years maximum** (five periods of five years each)<sup>4</sup>.

<sup>4</sup> *The duration of protection mentioned above reflects the legal provisions in many countries. However, there are national differences in these laws (for instance United States 15 years (filed on or after May 13, 2015), China 10 years).*

<sup>5</sup> *An **unregistered** Community design protects the design only for a period of three years from the date on which it was disclosed to the public for the first time in the European Community. An unregistered UK design protects the concerned design for a maximum of five years from the date on which a product incorporating the design is placed on the market for the first time (or ten years from the date of creation of the design (manufacturing or description of the design in a document), if the design has not been placed on the market during the first five years). For an unregistered UK design, there is a supplementary period of protection of five years during which any third party has the right to an automatic license for the manufacture and marketing of products incorporating the design.*

## ➤ Why protect a design ?

A consumer's decision to purchase is largely conditioned by his sense of aesthetic trends. Creating designs may require a significant investment. The registered design allows the holder to have an exclusivity on the overall outside appearance of his products. Therefore, design protection is a way to preserve this investment.

Design is a transferable propriety (cession or licensing)<sup>6</sup>.

<sup>6</sup> *Special conditions apply however to the registration of a new holder for the international Design (the Hague System).*

### ➤ How to mark a product incorporating a registered design ?

In most countries, laws on designs do not require that items subject to a filed design are marked as « filed ». It is recommended however that a notation such as “**registered design** », followed by the number of the corresponding design application to inform the public.

However, an abuse identifying a design for an article as having been filed in a country, while it is not the case, is punishable.

### ➤ How to file a first design application ?

**Filing of a first design application** (called « basic » or « priority » application) is made to an Office of Intellectual Property.

The choice of the Office for the first filing will depend on many criteria such as the residence of the applicant, the market for the protected product, national laws, the budget of the applicant, etc...

A **Counsel in Intellectual Property** will assist you in these filing steps (see « What is the role of a Counsel in Intellectual Property ? »).

### ➤ How to protect a design in other countries ?

Before the expiry of a period of six months from the basic filing date (called « priority »), the holder has the option to **extend the geographical scope of design protection**.

Various routes of protection are possible and some (non-exhaustive) examples are represented on the **enclosed diagrams**.

- ✓ **First filing** in Switzerland, European Community (not including Switzerland), United States, or International Registration (The Hague system) ;
- ✓ « **Extended** » **filing within six months from the first filing**  
By the filing of one or several national/regional applications for registration (for instance, in France, Italy, European Community or United States, etc..) and/or an International Application for Registration (covering 65 countries on 15.04.2016).

Due to the complexity of the procedures, of the various possible routes of protection, it is recommended to consult a Counsel in Intellectual Property already in the initial phases of the project to establish a solid strategy of protection.

### ➤ What are the requirements for filing an application for a design registration ?

- ✓ **Only the owner of a design can file an application and obtain the registration of a design.** If the designer was commissioned to develop a design for the account of another person, this is this person who is the owner and only this person can file an application for a registration, the name of the designer is, however, mentioned <sup>7</sup>.
- ✓ **Formal requirements** regarding the representations of the design exist (sufficient contrasts, clear outlines, neutral background, reproduction showing single object, etc...)

- ✓ **Several representations** <sup>7</sup> of the design can be filed within the same filing.
- ✓ In several countries, notably in Switzerland and the European Community, **several designs**<sup>7, 8</sup> belonging to the same class of products (Locarno classification, 32 classes) can be filed within the same filing.
- ✓ **A description of the visual aspects of the design** can be added <sup>7</sup>.

<sup>7</sup> The above formal criteria of registration reflect legal provisions in many countries. However, there are national differences in these laws and their application.

<sup>8</sup> However, laws of some countries, including the United States, China, India and Japan, only allow a single design per application.

### ➤ What is the role of a Counsel in Intellectual Property ?

#### Profile :

- ✓ Scientific/Technical and/or Legal education (for patents : qualifying examination)
- ✓ Internal (Industry)/External (Private practice)
- ✓ Interacts with a network of foreign national Counsels worldwide and lawyers

#### Role:

- ✓ Informing and advising on Intellectual Property rights
- ✓ Guiding towards an appropriate protection (patent, trademark, design...) and advising on the strategy of protection
- ✓ Representing and advising the applicant in the steps for obtaining, defending and/or attacking intellectual property rights (interaction with competent Offices, foreign agents, and lawyers in case of litigation)
- ✓ In charge of the administrative management of the portfolio of filed/registered rights
- ✓ Involved in assignments, licenses, due diligence, counterfeiting...

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## Example of format of an application for a registration of a design (several designs in the same class of products)

