



When NOT to seek protection for a design

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Speaker:
Arnaud FOLLIARD - Legal Department, EUIPO

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Questions and answers – When NOT to seek protection for a design

Can I rely on protection of my design as a UCD even if it has been declared invalid?
That is to say, can an invalid RCD be enforced as a UCD if it is within the 3-year protection period?

 **No**

if we assume that UCD protection is claimed for the design that is covered by an invalid RCD.

This is because the protection requirements are the same for RCDs and UCDs.

This means that, if an RCD lapses or is invalidated, there cannot be any protection for a corresponding UCD.

Questions and answers – When NOT to seek protection for a design

How do we protect software designs? Can the software architecture also be protected?

Design law does not protect software (for design or architecture purposes) as such.

Computer programs enjoy special protection under [copyright law](#).

Design law may, however, cover designs created by means of software.

Questions and answers – When NOT to seek protection for a design

Could you please share the link to the NDA template? Is it applicable in all jurisdictions?

You can find the templates [here](#).

Since NDAs are no more than contracts, they are subject to national law, which the parties may freely choose.

I am not aware of specific national requirements applying to NDAs.

Questions and answers – When NOT to seek protection for a design

Would the presentation of a design in a showroom be deemed a public disclosure where the venue is opened to prospective customers within the private premises of a fashion house and where these prospective customers are requested to keep the project strictly confidential (no pictures allowed, etc.)?

Making the design public by presenting it to prospective customers is an act of disclosure in itself.

This act of disclosure will, however, **not produce any effect if the RCD proprietor can prove that the disclosure is the result of a breach of confidentiality.**

This requires:

- i) identifying the third person responsible for the first 'leak' and;
- ii) demonstrating that this person violated their duty of confidentiality.

This may be difficult to prove (especially i)). **It is recommended to take a decision on whether to register the design as RCD as early as possible before the expiry of the 12-month grace period.**

Questions and answers – When NOT to seek protection for a design

Could you please remind us what disclosures are relevant from a territorial point of view?

In the context of **Article 7 CDR** (disclosure that defines the relevant prior art), there is **no limitation in space or time**.

Article 11(1) CDR is ambiguous because it refers to ‘the date on which the design was first made available to the public within the Community’. **It does not prevent a first disclosure in a third country followed by a second act of disclosure to the EU public** (only the second act would become relevant).

Article 110a(5) CDR does not support this interpretation, as it says that ‘pursuant to Article 11, a design which has not been made public within the territory of the Community shall not enjoy protection as an unregistered Community design’. **The compliance of Article 110a(5) CDR with TRIPs is sometimes questioned**. Let’s see what the recast regulation will do with this issue.

Questions and answers – When NOT to seek protection for a design

Are features (of a non-complex product) that are not visible at first, but visible during normal use, protectable as a design?

In my personal opinion, yes.

As in CJEU C-472/21, *Monz*, **it shouldn't be required that a given feature is visible all the time if it is visible part of the time during use that can reasonably be expected of the product at issue.**

Questions and answers – When NOT to seek protection for a design

Can you talk about the relationship/differences between the 12-month grace period and the deferment of publication?

The 12-month grace period (Article 7(2) CDR) will protect your design from loss of novelty if you file a design application at the latest 12 months after the first time you made your design public.

The deferment of publication is for a maximum period of 30 months (Article 50 CDR), and its purpose is to prevent third parties from seeing your design (after publication) before you decide to market your product.

A design whose publication is deferred is not part of the prior art and is protected by a specific provision (Article 25(1)(d) CDR).

Questions and answers – When NOT to seek protection for a design

Could you provide us the number of the GC judgment (or the nickname – ‘Monz’?)
that you mentioned when discussing the visibility criterion?

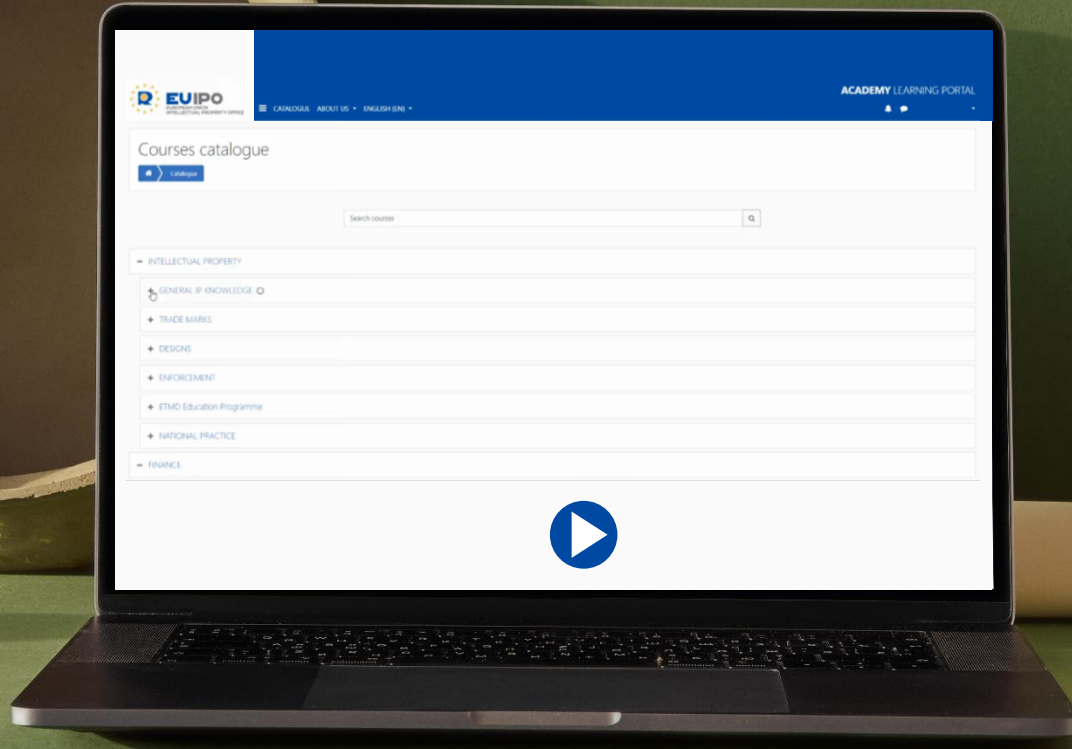
**16/02/2023, C-472/21, Monz Handelsgesellschaft
International, EU:C:2023:105**

Questions and answers – When NOT to seek protection for a design

Would an online work psychology assessment tool (e.g. a questionnaire plus a reporting website) be considered eligible for design protection too? The programming/functional part of the tool conditions the assessment design per se. At the same time, the assessment design is a unique creation that can be considered a work of authorship.

In my personal opinion, **a distinction should be made between the GUI (graphical user interface)**, which can be protected as a registered design if it has a fixed form, **and the result of a psychology test generated by software**, which is contingent. Without a predefined appearance, there can be no design protection.

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