

# WHEN NOT TO REGISTER YOUR DESIGN

(OR HOW TO MAXIMISE YOUR DESIGN FILING STRATEGY)

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## PROGRAMME

30'  
Presentation

- You know or should know that your **design is not new** on its date of filing
- You should know that **the design is not yours or not entirely**
- Your design is **exclusively dictated by technical considerations** and has no ornamental added value
- Your design is **offensive** (art 9 CDR)
- **Conclusion**

10'  
Questions and answers

1

**You know or should know  
that your design is not new  
on its date of filing**

## Article 7 CDR: disclosure & self-disclosure

### 1. A design shall be deemed to have been made available to the public if it has been :

- **published** following registration;
- **exhibited;**
- **used in trade**
- or **otherwise disclosed [...]**

**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**.



## Article 7 CDR: disclosure & self-disclosure

### 2. A disclosure shall not be taken into consideration


[...] and if a design for which protection is claimed under a registered Community design has been made available to the public:

- **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; **and**
- during **the 12-month period** preceding the date of filing of the application or, if a priority is claimed, the date of priority.
- if the design has been made available to the public as a consequence of an **abuse in relation to the designer or his successor in title**.





## Example of a disclosure


NETWORK ▾  UNITED STATES / EN (\$) PUBLISH PRODUCTS

**archiproducts®** Search in 310,692 products, brands, designers

New Furniture Bathroom Kitchen Lighting Outdoor Office Contract Wellness Decor Finishes Construction

Brands Magazine BIM

**13/04/2015** - Just as with nature, **ALGORITHM** is the physical expression of compositional beauty governed by the mathematical order that lies behind it. Like a constellation of globes, a flock of birds or a frozen rain shower, this collection fuses beauty and geometry into a magical system of illumination.

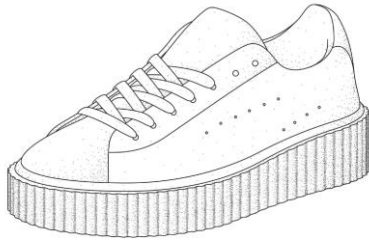


- Date of filing: **14 April 2016**
- Disclosure in an online publication on **13 April 2015** about the Milan *Euroluce/Salone del Mobile* 2015

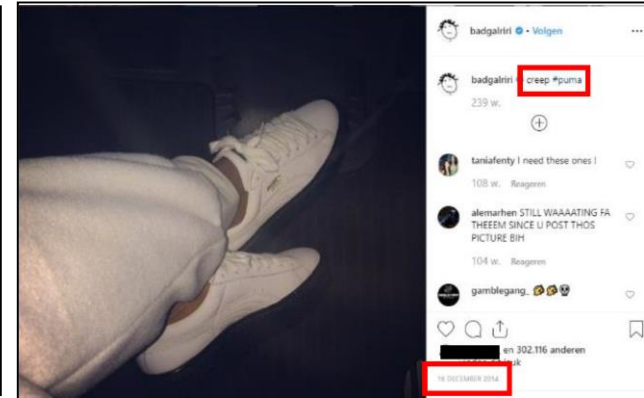


Invalidity upheld by Board of Appeal in R 1289/2021-3, 23/11/2022

## Case law :Board of Appeal, 11/08/2022, R 726/2021-3, (Puma) Shoes



RCD No 3 320 555-0002  
(priority date: 25 July 2016)

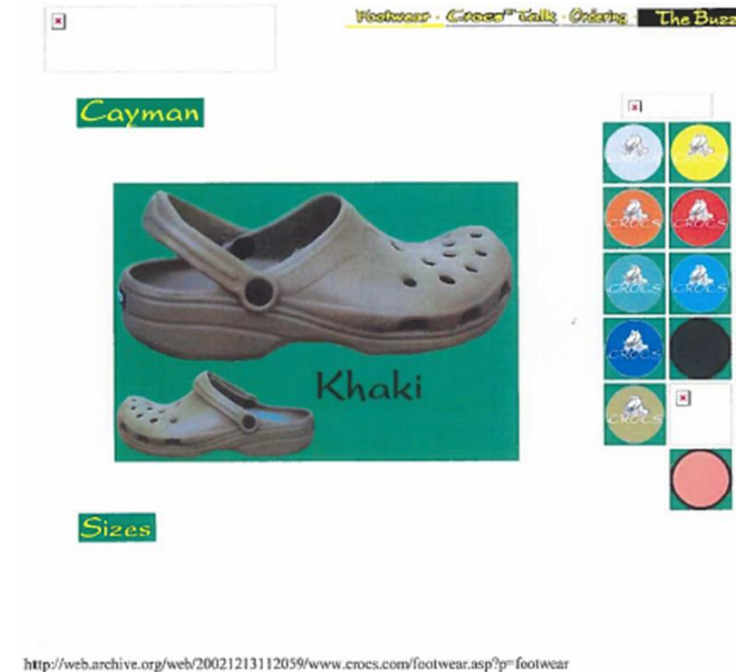


Rihanna's Instagram (16 December 2014)



## Monitor the date of first disclosure (novelty-destroying effect on RCD)

- Disclosure in **fairs worldwide** is potentially novelty destroying (GC, T-651/16, 14/03/2018, 'Crocs')
- **Internet and external communications**, including emails (GC, T-166/15, 27/02/2018, case for a mobile phone, § 92-93)



## Article 96(2) CDR: relationship with copyright



(§ 55) **Designs such as the clothing designs** at issue in the main proceedings generate, **over and above their practical purpose, a specific and aesthetically significant visual effect is not such as to justify those designs being classified as ‘works’** within the meaning of Directive 2001/29

CJEU, 12/09/2019, C-683/17, Cofemel

Source:

<https://ipkitten.blogspot.com/2019/09/the-cofemel-decision-well-beyond-simple.html>

## Article 11 CDR: disclosure as a protection requirement for UCDs

1. A design [...] shall be protected by an unregistered Community design :
  - for a **period of three years**
  - as **from the date** on which the design was **first made available** to the public within the Community.
2. [...] **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.



## Article 19 CDR: Rights conferred

1. An unregistered Community design shall, however, confer on its holder the right to prevent the acts referred to in paragraph 1 only if the contested use results from **copying** the protected design.



## Have a better control over your design's disclosure

- **The disclosure of your design has two consequences**
  - **Triggers a 12-month period** during which an application for RCD can be filed without the disclosure having any negative impact. Justified by the need to 'test the products' (Rec. 20; art. 7(2) CDR)
  - **Triggers the 3-year protection** as an Unregistered Community Design (UCD) (art. 11 CDR)
- You are your own worst enemy: **self-disclosure**
- **Document the date of first disclosure** (starting point of UCD)



## Implement internal processes for securing confidentiality



- **A disclosure resulting from a breach of confidentiality** (explicit or implied by the circumstances surrounding the parties' relationships) is **not effective** or novelty-destroying, **without consideration of time** lapsed until registration (Art. 7(1) CDR)
- Make sure that **your employees** (internal communication) and **external partners** (before and during negotiations) have signed a **Non Disclosure Agreement** ([NDA](#))

## Implement internal processes for securing confidentiality



- **Implied confidentiality** can be inferred from **security measures adopted by the design proprietor to restrict access to the design**, including on an Intranet, via passwords or any other express permissions (see [Order](#), Alicante, *juzgado de marca comunitaria*, 07/12/2005, Festina Lotus SA)
- **Avoid attaching representations of the design in emails.** Consider links to access restricted drives, sharing platforms or webpages.

## Document the date of first disclosure (starting point of UCD)

Various options exist to measure **website traffic**:

- a page view;
- a page hit;
- a session



which may also be quantified by the use of **web analytics** or similar tools.



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**You should know that the design is not yours or not entirely**

## Legal & contractual considerations on ownership

### Contractual arrangements applicable to creators: an unharmonised field



#### **Employees**

(Art. 14(3) CDR)



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**

#### **Works made for hire**

(commissioned works)



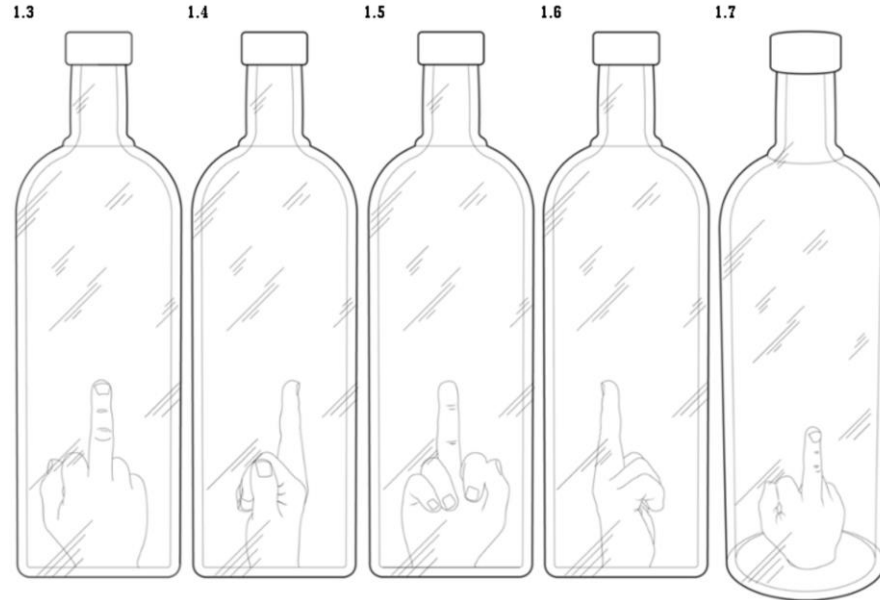
**Licence or transfer of all rights?**

**Consider a clause** on the **retroactive effect** of the transfer

(GC, T-727/21, 26/04/23, gril, § 26-27)

# 3 Your design is offensive (art 9 CDR)

## Example

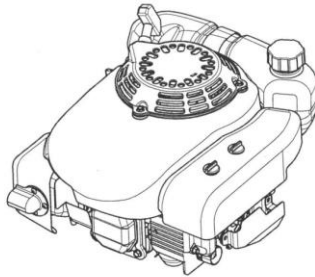
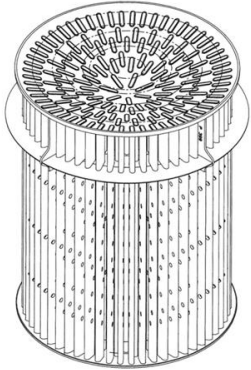


**DM102352, EU designation in IR  
refused on 08/02/2019**

4

**Your design is exclusively dictated by technical considerations and has no ornamental features (art. 8(1) CDR)**

## Examples



## General Court, 18/11/2020, T-574/19, Fluid distribution equipment

(24) If (...) **at least one** of the features of appearance (...) is not solely dictated by the technical function of that product



the design at issue **remains valid and protects that feature**

## General Court, 18/11/2020, T-574/19, Fluid distribution equipment

(25) if **all the features** of appearance of the product concerned are solely dictated by its technical function



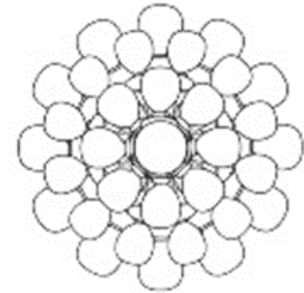
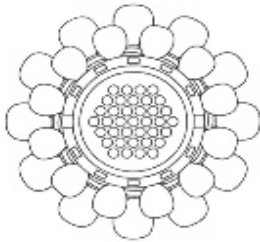
**the design at issue will not be valid**

### unless

- it is apparent that the **arrangement of those features** was dictated by considerations not concerned solely with the need to fulfil the technical function of the product concerned, creating, in particular, an **overall visual impression going beyond mere technical function**.
- (...) a **particular arrangement of features** could be chosen for purposes other than the need to fulfil a technical function and, in particular **for ornamental purposes** and, more generally, for purposes seeking to **enhance the visual aspect of the design**



## Prohibition of functional designs: General Court, 18/11/2020, T-574/19, Fluid distribution equipment



## No copyright on functional shapes

### CJUE, C-833/18, 11/06/2020 *BromptonBicycle*

- (§ 33) Where the shape of the product is solely dictated by technical function, **that product cannot be covered by copyright protection**
- (§ 35) The existence of alternative shapes is not decisive
- (§ 37) Factors external to and subsequent to the creation of the product are irrelevant



## Conclusion

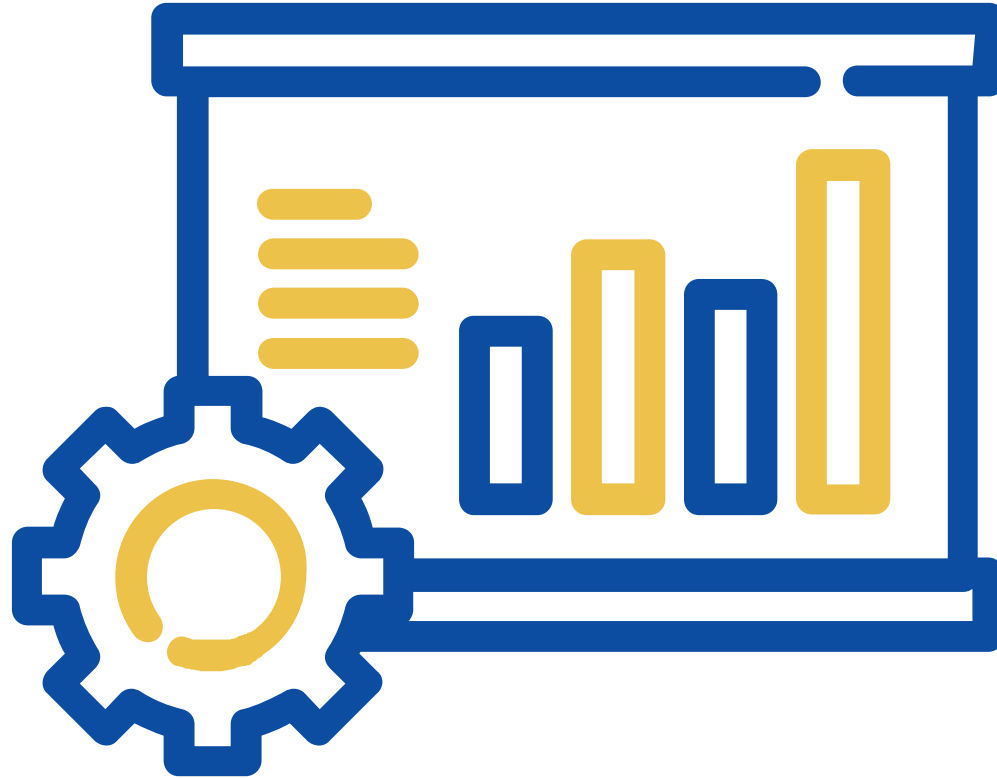
- **Rationalise your investments in RCD and avoid unnecessary risks** (public morality) or vulnerability (functionality or self-disclosure)
- **The disclosure is the starting point of your IP strategy** (UCD/RCD). Have control over disclosure and consider within 12 months whether to file an RCD application
- **Conditions for 7(2) are strict** (limited in time, proof of ownership).
- **Keep track of your own disclosure for UCD purposes:** disclosure *'in such a way that'* the disclosure can be known to the public.



## Conclusion

- **Make sure that your design registration does not infringe third parties rights**
- **Make sure that your design is not solely functional**





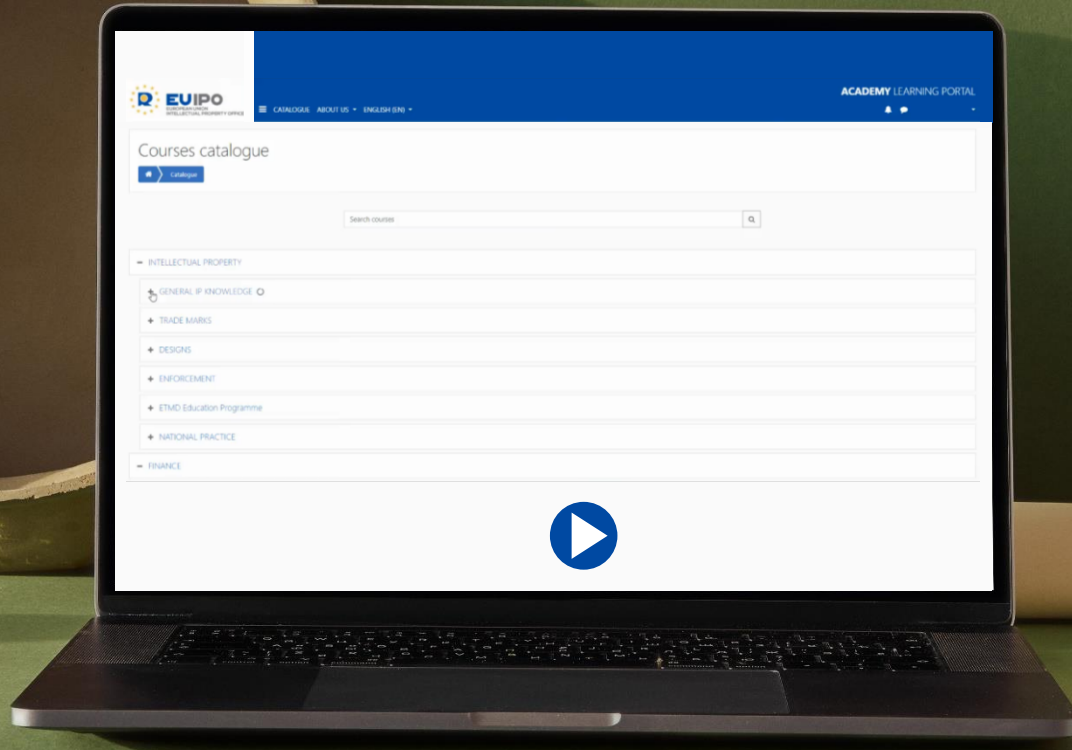
## Poll

# With which of the following statements do you agree more:

- a) An effective internal process for securing confidentiality should prevent unwanted disclosure and, in case of consented disclosure, trigger an alarm for the expiry of the 12-month grace period.
  
- b) An unregistered design right will always provide sufficient protection.



## Keep in touch with the EUIPO Academy







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Legal Department - EUIPO



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**THANK YOU**

When NOT to register your design



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**THANK YOU**