

Abusive design registrations

Kelly BENNETT
17/10/2023

PROGRAMME

50'
Presentation

- What is an abusive design registration?
- Tools for e-commerce sellers
- Solutions for RCD holders
- Proceedings for designers

10'
Questions and answers



1 What is an abusive design registration?

What is an abusive design registration? A summary of complaints



RCDs registered in bad faith



No novelty check by the EUIPO



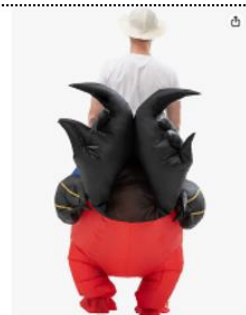
Non-EEA applicant without a representative



Misrepresentation

RCDs registered in bad faith - Blatant copying of eMarketplace products

Prior design – disclosed on Amazon.de



Contested design – RCD No 009086754-0001



No novelty check by the EUIPO - Article 47 CDR

The **EUIPO** can only examine *ex officio* two substantive grounds for non-registrability, namely whether:

- (i) the design **corresponds to the definition** set out in Article 3(a) CDR; or
- (ii) it is **contrary to public policy or to accepted principles of morality** (Article 9 CDR).

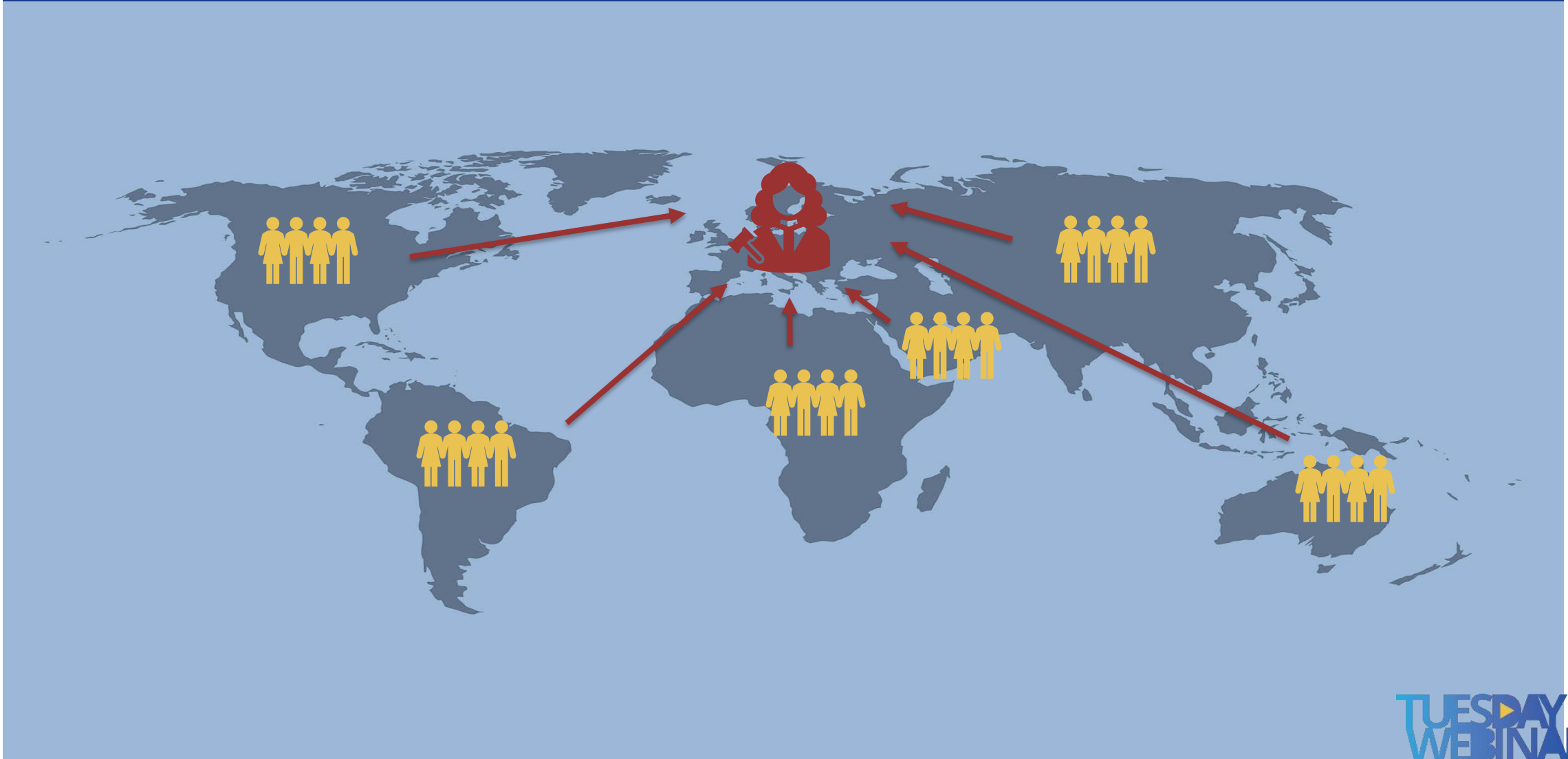


Non-EEA applicant without a representative - Article 77(2) CDR

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 Office [...] **in all proceedings before the Office** [...], **other than in filing an application for a registered Community design.**



Misrepresentation



Misrepresentation



Actions taken:



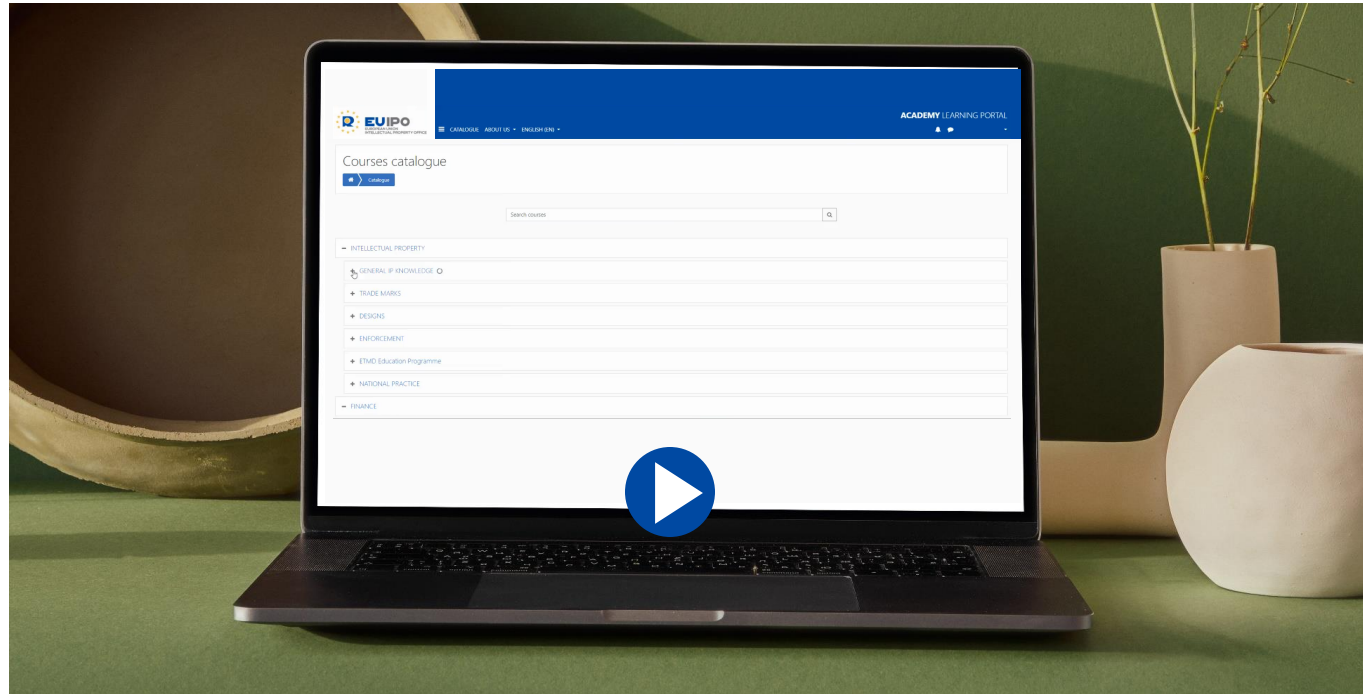
Prevention: technical solution



Refusal RCD application:



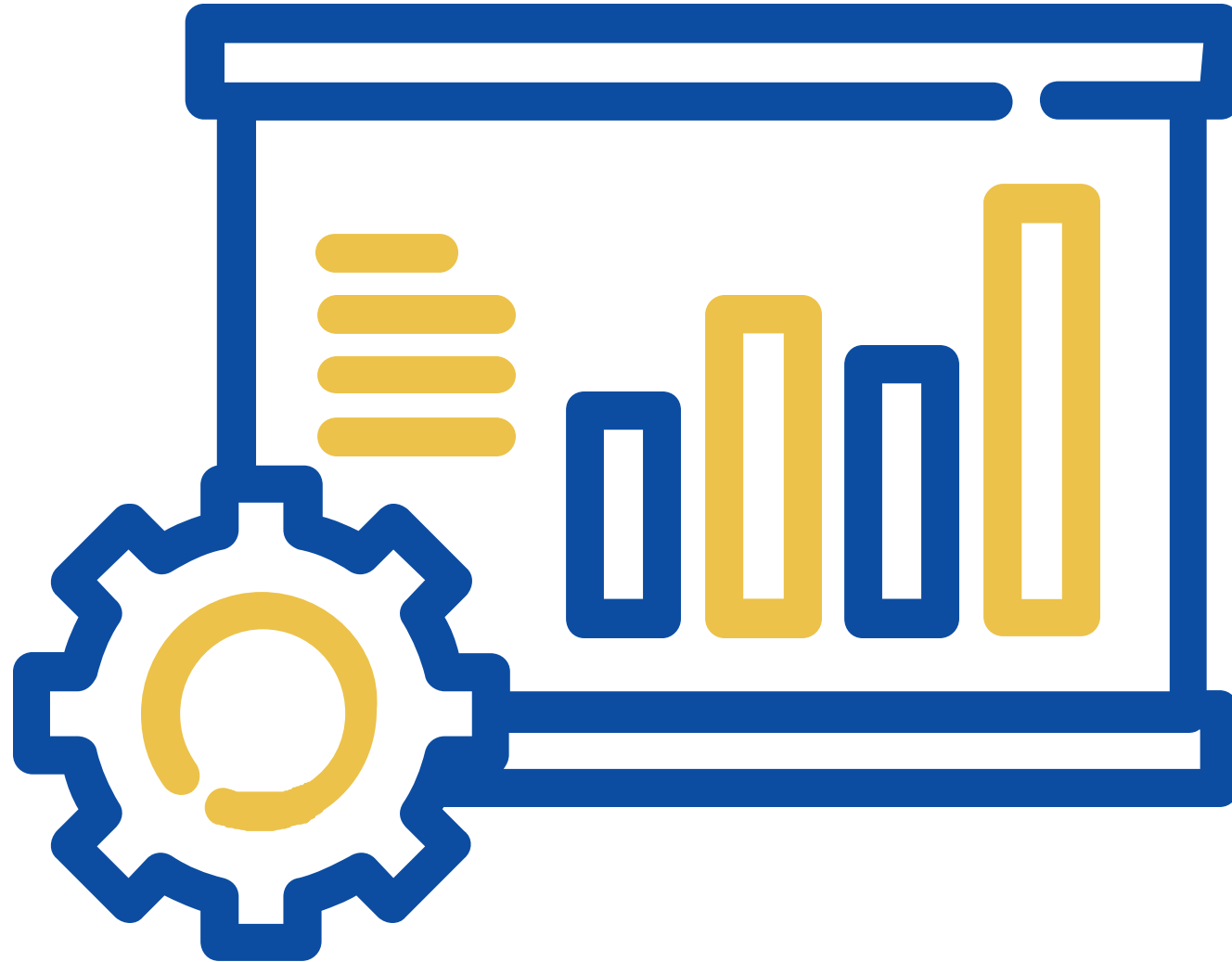
**RCD already registered:
revocation and then refusal**



Tuesday webinar (20.06.2023) on
‘Protecting representatives: combatting misuse of User Area credentials and misrepresentation’



2 Tools for e-commerce sellers





How many of you have a registered Community design already?

RCD registration

Benefits of registration – Filing

Applications can be **filed directly with the EUIPO** by:

- **e-filing** (electronic application)
- **post**
- **hand delivery**

e-filing



or, **through any IP National Office of the EU**
(filing date = the date of receipt in the National Office)

Benefits of registration – Costs

	REGISTRATION	PUBLICATION		DEFERMENT OF PUBLICATION*
1st DESIGN	EUR 230	EUR + 120	= EUR 350	EUR 40
DESIGNS 2 TO 10	EUR 115	EUR 60	= EUR 175	EUR 20 *
DESIGN 11 AND ADDITIONAL	EUR 50	EUR 30	= EUR 80	EUR 10 *

Benefits of registration – Examination

Formal examination



- **Application**
- **Identification** of the applicant
- **Representation** of the design
- **Indication** of the products

Limited substantive examination



- **Not corresponding to the definition** of ‘design’
- **Against public policy** and accepted **principles of morality**

Benefits of registration – Speedy procedure

**The Community design will be registered
within 2 days of the filing date**






















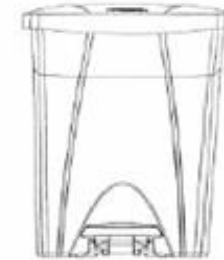
Benefits of registration – Registration



OAMI - OFICINA DE ARMONIZACIÓN DEL MERCADO INTERIOR
MARCAS, DIBUJOS Y MODELOS

OHIM - OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
TRADE MARKS AND DESIGNS

- 21 000289277-0001
- 25 ES - EN
- 22 24/01/2005
- 15 24/01/2005
- 45 05/04/2005
- 11 000289277-0001
- 73 01
- 73 PLASTIKEN, S.L.U.
- Avenida de Valencia, 3
- E-46191 Palomar (Valencia)
- ESPAÑA
- 74 ISERN CAÑADELL
- Travessera de Gracia, 30 - 1ºC
- E-08021 Barcelona
- ESPAÑA
- 51 07 - 07
- 54  - Cubos [uso doméstico]
-  - Džbáry [pro domácnost]
-  - Ököszegek [háztartásigazg]
-  - Eimer
-  - Mappadamsimbord
-  - Kôšo [okrasný úžitok]
-  - Buckets [household]
-  - Seaux de ménage
-  - Secchi [per la casa]
-  - Spēni [saimniecībai]
-  - Kibirai [butinėi]
-  - Vídrók [háztartás]
-  - Eimers [voor huishoudelijk gebruik]
-  - Wiedra [gospodarsze domowe]
-  - Baldes [uso doméstico]
-  - Vedra [pro domácnost]
-  - Veda [gospodarske]
-  - Ampari [cattolouskaytmon]
-  - Hókar [háztál]



0001.1



0001.2



0001.3

Benefits of registration – Renewal

Registered Community designs:

- are renewed in **blocks of 5 years**;
- the maximum term of protection is **25 years**.



Benefits of registration

One application procedure

One language

One Office

One file

One fee in **one** currency


Possibility of filing **multiple applications**

Possibility of **deferring publication**



RCD Easy Filing

RCD Easy Filing



EUIPO
EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

Design Filing

Apply for your European Union design

File a design application

How do you want to start your application?

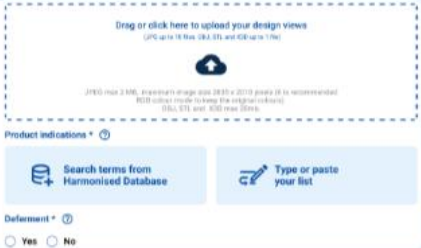
FILE A NEW DESIGN

IMPORT EXISTING FILE

- Improved management of views
- Improved terms search
- Fast track on Non-Fast track configuration.

New design filing form

The new form is more user-friendly and has new features, including:



Drag or click here to upload your design views
(PDF up to 10 files, 20.0 MB, and 400 pages total)

PDF: max 2 MB, maximum page size 2000 x 2000 pixels (6 to recommended 1000 pixels) (to keep the original colours)
PNG, GIF and JPEG: max 50MB

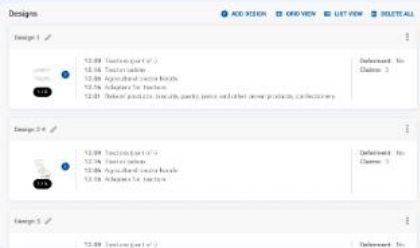
Product indications *

Search terms from Harmonised Database | Type or paste your list

Deferral *

Yes No

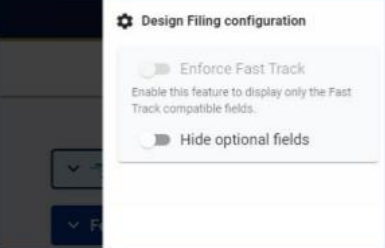
A new fresh design with full guidance and contextual help



Designs

Design 1	Design 2	Design 3
13.09.2023 13.09.2023 13.09.2023 13.09.2023	13.09.2023 13.09.2023 13.09.2023 13.09.2023	13.09.2023 13.09.2023 13.09.2023 13.09.2023
Submitted: No Claim: 1	Submitted: No Claim: 1	Submitted: No Claim: 1

Smoother management of multiple applications



Design Filing configuration

Enforce Fast Track
Enable this feature to display only the Fast Track compatible fields.

Hide optional fields

Configuration options that allow you to tailor your filing experience

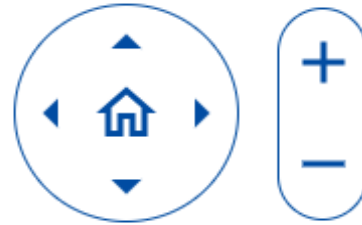
RCD Easy Filing

Click here to [reset](#) all views

i Please note that you must create at least one view from the 3D dynamic view



Move the 3D dynamic view with your mouse or keyboard to change the camera viewpoint, or use the controls below.



Move camera

Zoom

- Perspective
- Right
- Front
- Top
- Back
- Bottom
- Left

CREATE VIEW FROM THIS VIEWPOINT


Move your model and take a screenshot of desired viewpoint.

CREATE PREDEFINED VIEWS (7)

Predefined views are: front, top, back, bottom, left, perspective and right.

▼ **fast track** Compatible

▼ **Fees** 350,00 €

▼ **Support** 

 Download PDF to review


 Reset form

RCD Easy Filing

Design(s)
Add designs to your application

Design + ADD DESIGN GRID VIEW LIST VIEW DELETE ALL


Design 1



1/7

- 02.01 Abdominal supports
- 02.01 Adhesive articles for breast support
- 02.04 Anatomic insoles for footwear
- 06.03 Bar tables

Deferment: No Claims: 0



ADD DESIGN

Product indications*

Search to select terms from the Harmonised Database.

ADD

[Powered by designClass and the HDBPI](#)

If you do not find the terms that fit your product you can [browse the taxonomy](#)

03 - Travel goods, ...

01 - Trunks, suitca...

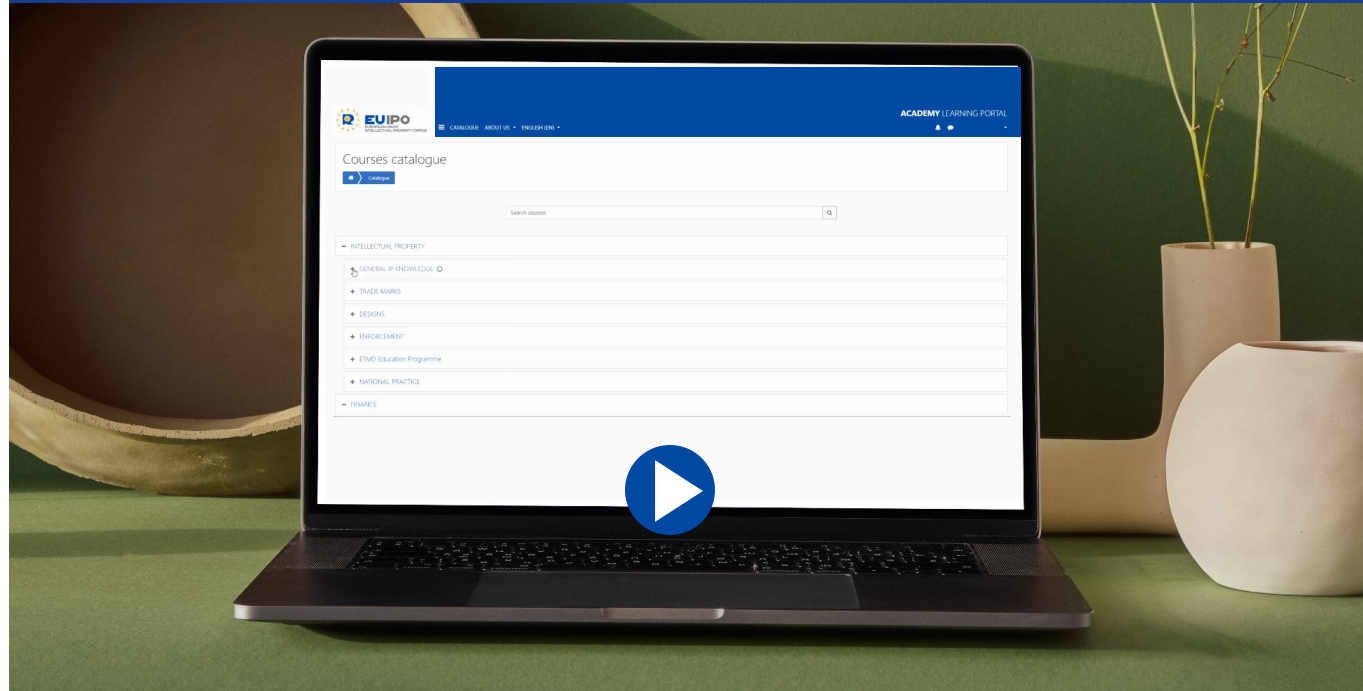
FILTER

- ▶ 01 - Foodstuffs
- ▶ 02 - Articles of Clothing and Haberdashery
- ▶ 03 - Travel goods, cases, parasols and personal belongings, not elsewhere specified
- ▶ 04 - Brushware
- ▶ 05 - Textile piece goods, artificial and natural sheet material
- ▶ 06 - Furnishing
- ▶ 07 - Household goods, not elsewhere specified
- ▶ 08 - Tools and hardware
- ▶ 09 - Packaging and containers for the transport or handling of goods

- 03 01 Armbands for mobile telephones ADD
- 03 01 Artists' portfolios ADD
- 03 01 Athletic bags ADD
- 03 01 Attaché cases ADD
- 03 01 Baby bags ADD
- 03 01 Baby changing bags ADD
- 03 01 Back covers for mobile phones ADD
- 03 01 Backpack frames ADD
- 03 01 Backpack trolleys ADD
- 03 01 Backpacks ADD
- 03 01 Bag straps ADD

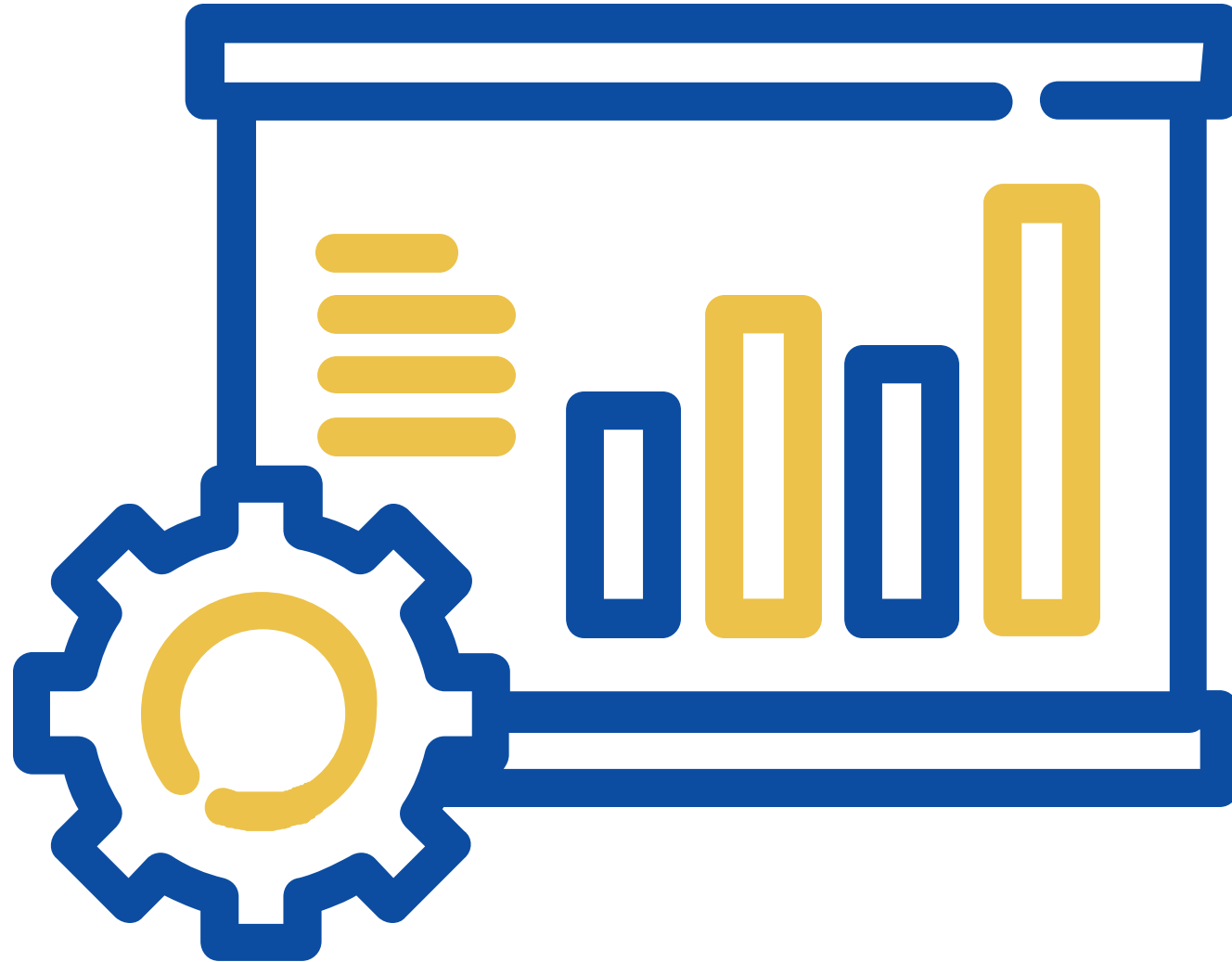
Class	Subclass	Term	
02	01	Abdominal supports	×
02	01	Adhesive articles for breast support	×
02	04	Anatomic insoles for footwear	×

Upcoming Tuesday Webinar on RCD e-filing



Next Tuesday webinar (24.10.2023) on
‘Track on design: discovering the new RCD e-filing and solving your design doubts’

Search tools





Have any of you used any of the EUIPO search tools ?

What are TMview and DESIGNview?

Online consultation tools that allow any internet user to **search for trade mark and design applications and registrations** from the participating Offices in a **single place**, free of charge.

TMview

109 million trade marks

77 IP Offices



DESIGNview

20 million designs

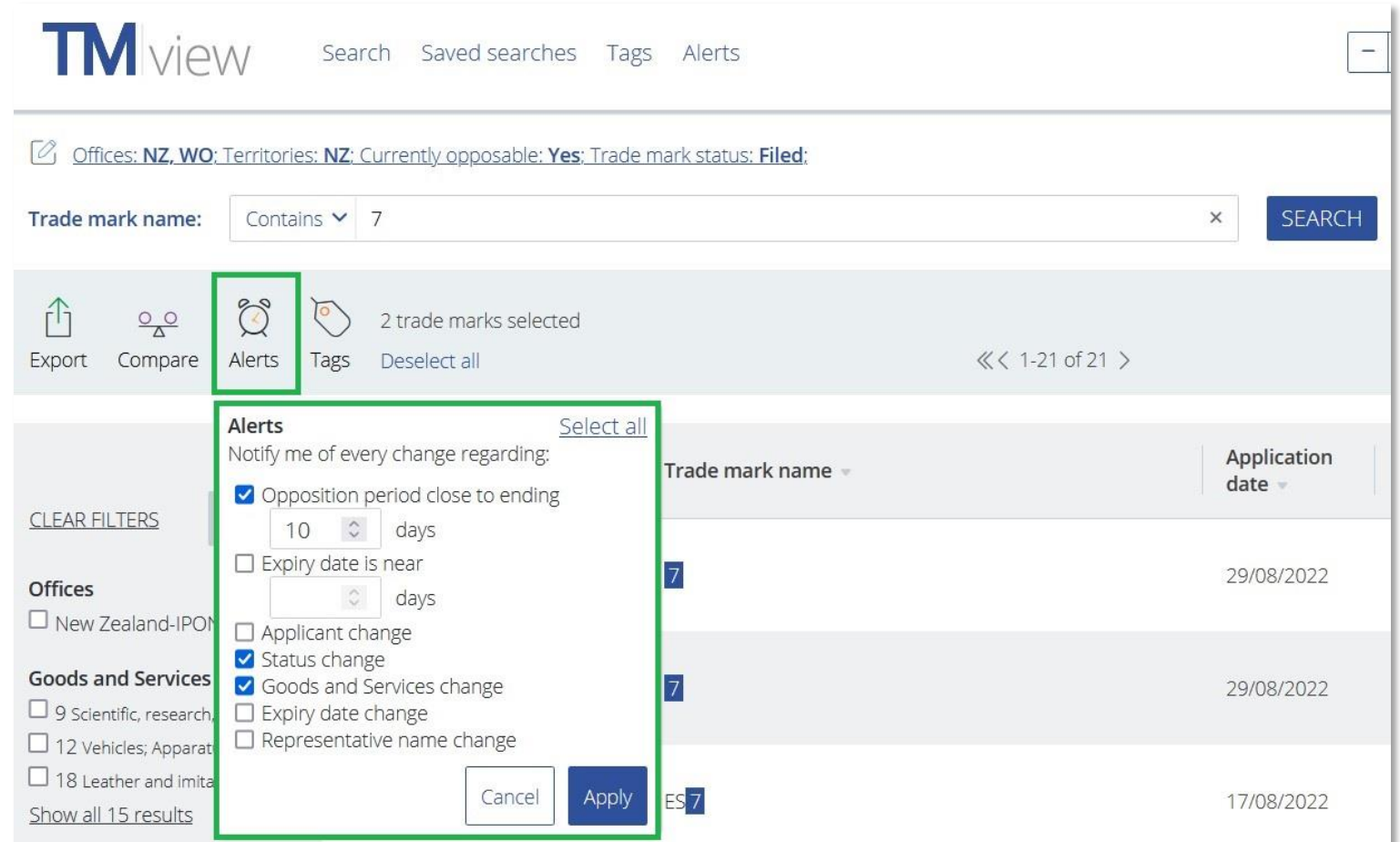
76 IP Offices

Alerts

Alerts can be created to receive notifications on the trade marks or designs that the user wants to follow up on.

To set alerts, users need to **sign in to TMview/DESIGNview**, **select the trade marks or designs** in the list of results, and **click the Alerts button**.

The user can **access the saved alerts in the menu header**.



The screenshot displays the TMview interface. At the top, there is a navigation bar with 'TMview', 'Search', 'Saved searches', 'Tags', and 'Alerts'. Below this, a filter bar shows 'Offices: NZ, WO; Territories: NZ; Currently opposable: Yes; Trade mark status: Filed:'. A search bar contains 'Trade mark name: Contains 7' with a 'SEARCH' button. The main area shows a list of trade marks with columns for 'Trade mark name' and 'Application date'. A modal dialog box titled 'Alerts' is open, allowing users to configure notifications. The dialog includes a 'Select all' link and a list of notification types with checkboxes and input fields. The 'Alerts' button in the main interface is highlighted with a green box.

Alerts [Select all](#)

Notify me of every change regarding:

- Opposition period close to ending
10 days
- Expiry date is near
days
- Applicant change
- Status change
- Goods and Services change
- Expiry date change
- Representative name change

Cancel Apply

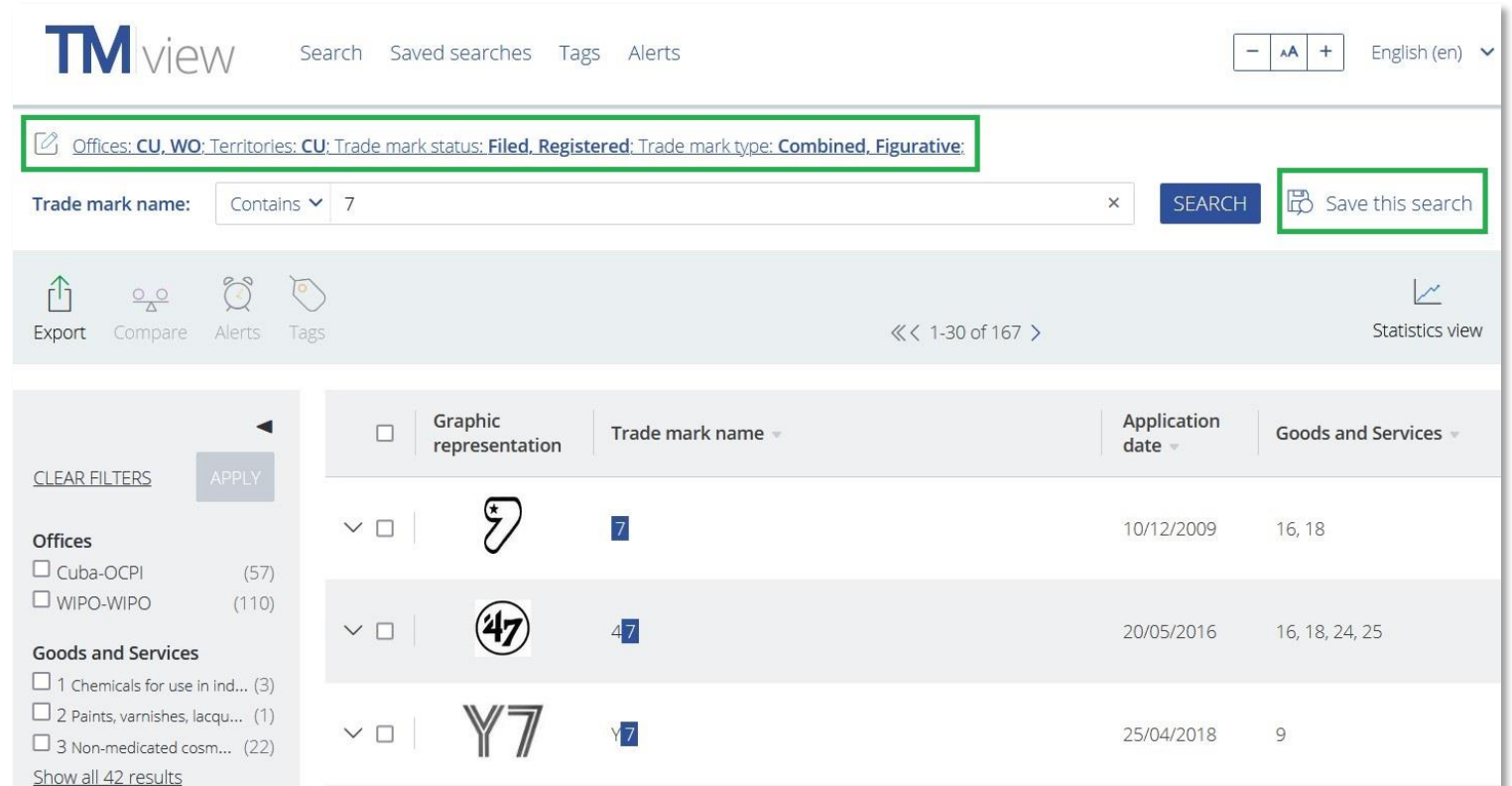
Trade mark name	Application date
7	29/08/2022
7	29/08/2022
ES 7	17/08/2022

Saved searches

Users can save their custom searches to **receive notifications when there are new trade marks or designs** in the list of results, or some trade marks or designs can no longer be found.

To use this feature, **users need to sign in to TMview/DESIGNview and save their search from the results page.**

The user can access all saved searches in the menu header.



The screenshot displays the TMview interface. At the top, there is a navigation menu with 'Search', 'Saved searches', 'Tags', and 'Alerts'. A language dropdown is set to 'English (en)'. Below the menu, a search filter bar is highlighted with a green box, containing the text: 'Offices: CU, WO; Territories: CU; Trade mark status: Filed, Registered; Trade mark type: Combined, Figurative;'. Below this, a search input field shows 'Trade mark name: Contains 7' with a 'SEARCH' button and a 'Save this search' button, both highlighted with green boxes. A toolbar below the search bar includes icons for 'Export', 'Compare', 'Alerts', and 'Tags', along with a pagination indicator '1-30 of 167' and a 'Statistics view' link. On the left side, there is a sidebar with 'CLEAR FILTERS' and 'APPLY' buttons, and a list of filters for 'Offices' (Cuba-OCPI (57), WIPO-WIPO (110)) and 'Goods and Services' (1 Chemicals for use in ind... (3), 2 Paints, varnishes, lacqu... (1), 3 Non-medicated cosm... (22)). The main area shows a table of search results with columns for 'Graphic representation', 'Trade mark name', 'Application date', and 'Goods and Services'. The table contains three rows of results, each with a dropdown arrow, a checkbox, a graphic representation, a trade mark name with a blue square icon, an application date, and goods and services.




<input type="checkbox"/>	Graphic representation	Trade mark name	Application date	Goods and Services
▼ <input type="checkbox"/>		7	10/12/2009	16, 18
▼ <input type="checkbox"/>		47	20/05/2016	16, 18, 24, 25
▼ <input type="checkbox"/>		Y7	25/04/2018	9

Image search

TMview users can upload an image from their device, crop it if needed, and **search for trade marks with a similar graphical representation.**

The image search functionality can also be triggered from the graphic representation of any trade mark displayed in the list of results or in the trade mark details.

Search by image ×



Click on the **red box**, or draw your own by clicking-and-dragging on image to select an area.

Advanced Options

- (searches only for colour per se trade marks)
- Use optical character recognition (OCR) for the image search

Beta <p>EUIPO Image Search</p>

Supported by these offices: BX, DK, PT, CZ, EM, IT, ES, SI, EE, BG, FR, RO, AT, CY, DE, FI, GR, HU, IE, LT, LV, MT, PL, SE, HR, SK




Image search











TMview users can upload an image from their device, crop it if needed, and **search for trade marks with a similar graphical representation.**

The image search functionality can also be triggered from the graphic representation of any trade mark displayed in the list of results or in the trade mark details.

TMview

Graphic representation: 

Export Compare Alerts Tags « 1-30 of 999 »

<input type="checkbox"/>	Graphic representation	Trade mark name	Application date	Goods and Services	Trade mark status	Trade mark office
<input type="checkbox"/>		IS	03/02/2022	42	Registered	EUIPO-EUIPO 
<input type="checkbox"/>		7	26/06/2001	9, 16, 35, 37, 38, 41, 42	Expired	Slovenia-SIPO 
<input type="checkbox"/>		7	07/02/2013	9, 25	Registered	EUIPO-EUIPO 
<input type="checkbox"/>		7	26/08/2008	35, 38, 41	Expired	EUIPO-EUIPO 
<input type="checkbox"/>		7	13/03/2018	4, 37, 39, 41, 42	Registered	Germany-DPMA 

[CLEAR FILTERS](#) [APPLY](#)

Offices

- Austria-OPA (5)
- Bulgaria-BPO (7)
- Benelux-BOIP (2)

[Show all 20 results](#)

Goods and Services

- 1 Chemicals for use in i... (11)
- 2 Paints, varnishes, lacq... (10)
- 3 Non-medicated cosm... (32)

[Show all 45 results](#)

Vienna codes

- 01.01 STARS, COMETS (18)
- 01.03 SUN (8)
- 01.13 ARMILLARY SPHER... (6)

eSearch plus – image search

How to do a visual search for designs

[Link to the video](#)

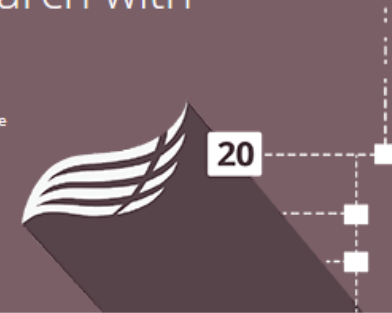
Search for exactly what you need

Select and adjust a red frame to zoom in or out of the areas you want to search for.



Power your search with classification

Combine your image search with the Vienna and Nice Classifications. Available in advanced search.



See up to 100 results at once

With three different viewing options:

Detail



List



Images



Upload different formats

You can use any of these formats:



Combine with other search criteria

Such as trade mark name, type or filing date, etc.



Colour search

Look for trade marks registered specifically for colour protection.





3 Solutions for RCD holders

Notice and Take Down

ECD provisions - (Directive 2000/31/EC)

Article 14 E-commerce Directive

Hosting service providers **must remove** illegal user-generated content to benefit from the liability exemptions.

The knowledge of such content's illegality can be acquired through various ways.



DSA provisions

Digital Service Act

Mandates **hosting service providers** to **implement mechanisms** enabling the reporting of potentially illicit content.

They must be **easily accessible, user-friendly**, and based on **electronic notice submission**.



Amazon's notice and takedown procedure

Steps required to request a takedown

- 1) **Log in** to Amazon account.
- 2) The specific **form** must be used.
- 3) The user **must be the rights owner** or an agent acting on behalf of the rights owner.
- 4) The user must specify **one type of IP violation** per notice.
- 5) The user must provide additional specific information.



Amazon's notice and takedown procedure

Steps taken by Amazon after the submission

- 1) **Confirmation of receipt** of the notice.
- 2) Follow-up message once notice processed.
- 3) **Outcome** of the notice of infringement:



Accepted



Content will be removed

Rejected

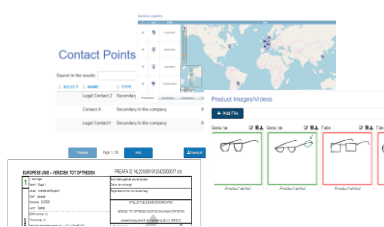


Content will remain

IP ENFORCEMENT | portal

The IP Enforcement Portal (IPEP)

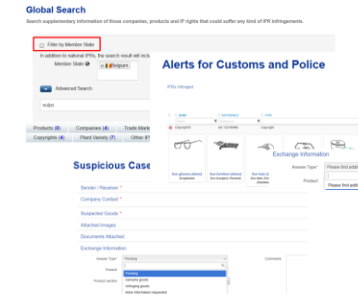
Free of charge, secure platform enabling real-time exchange of information between rights holders and enforcement authorities



IP ENFORCEMENT portal

Notifications

AFAs, Alerts



Rights holders enter **product, IPR and contact information.**

Enforcers access information with **one single search.**

Rights holder are authenticated and IPR information validated.

Customs Application for Action (AFAs) – e-AFA – integration with COPIS and digital signature

Application for Action (AFA)

Protect your rights on the border providing the custom authorities with the necessary information about your rights, contacts and products.
The Application for Action allows the applicant to request the customs authorities to take action with respect to goods suspected of infringing an intellectual property right.
Further details can be found in the [Manual for Application for Action](#) provided by DG TAXUD.

E-AFA mandatory soon!



- ✓ Rights holders can file and manage e-AFAs in all EU languages.
- ✓ Pre-admissibility check on mandatory information following Customs Regulation (EU) no. 608/2013

[Previous](#) Page: 1 / 58 [Next](#) [Download](#)

EUROPESE UNIE – VERZOEK TOT OPTREDEN		PREAFA ID: NL20190619120420000017 (nl)
1	1. Aanvrager Naam*: Euiipo 1 Adres*: Avenida de Europa 4 Stad*: Alicante Postcode: E-03008 Land*: Spanje EORI-nummer: (+) TIN-nummer: (+) Nationaal registratienummer: (+) – VAT: VATnotEUIPO	Voor intern gebruik van de douane Datum van ontvangst Registratienummer voor de aanvraag
	INST	INTELLECTUELE-EIGENDOMSRECHTEN VERZOEK TOT OPTREDEN DOOR DE DOUANE AUTORITEITEN overeenkomstig artikel 6 van Verordening (EU) nr. 608/2013

IPEP – Supporting cooperation with e-commerce marketplaces

Clear and secure path for marketplaces to access information on IP rights, and contact points with rights holders that apply to their IP protection services



Verify IP rights



Obtain contact points for rights holders



Send Communication or Verification Code

IP Enforcement Portal

IP ENFORCEMENT | portal



SECURE

Access through customs **secure** network CCN and other secure tunnels as guaranteed by the **security audit** (SOC2)



MULTILINGUAL

Information available in **23 languages**

Contact: ipenforcementportal@euipo.europa.eu

4 Proceedings for designers

Invalidity proceedings

Invalidity proceedings – Filing

- **e-filing** (electronic application)
- **post**
- **hand delivery**

Designs

Design is an important business asset for innovative companies, and helps to create jobs and support economic growth.

Quick links:

[Renew a Community design ↗](#)

[File a declaration of invalidity ↗](#)

[File an appeal ↗](#)

[Online services →](#)

[Apply for a design ↗](#)

Inter partes form

* [Mandatory details](#) [View help](#)

Reference

Optional 

Your reference:

 Maximum of 30 characters, spaces are not allowed

Type of action

Opposition

Cancellation

Invalidity of designs

Reference

Type of action

Invalidity Applicant(s)

Representatives

Challenged Entity

Grounds for Invalidity

Arguments and Evidence

Annexes to Arguments
(Evidence)

Invalidity fee **350.00 €**

▲ Total Fee 350.00 €

Save to drafts

Print

Reset Form

Admissibility check



- **One RCD per application**
- **In writing**
 - ✓ Form
 - ✓ Reasoned statement
 - ✓ Evidence
- **Language** of proceedings
- **Invalidity fee** (350€)

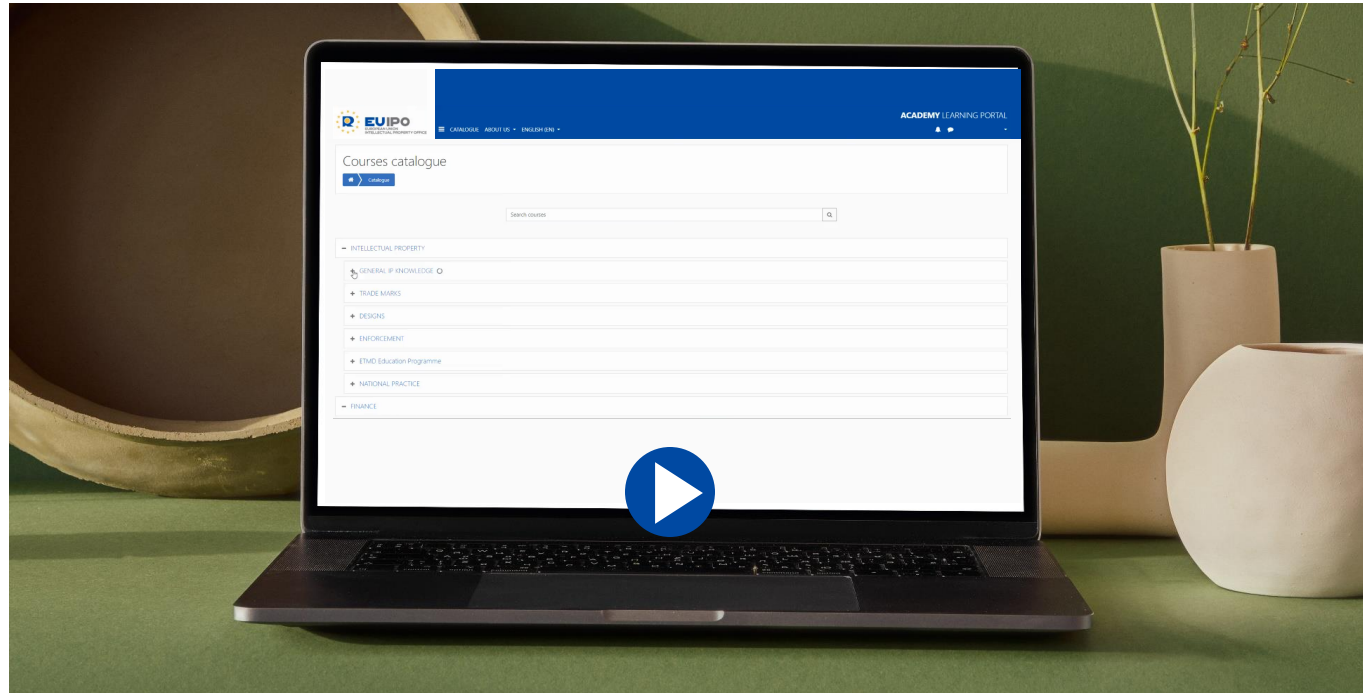
Invalidity proceedings – Examination

Substantive examination

(Article 25(1)(b) Lack of novelty or individual character)



- Reasoned statement
- Proof of:
 - an **earlier identical design** or one that produces the same overall impression;
 - **disclosure**



Tuesday webinar (20.09.2022) on
‘Disclosure of earlier designs in RCD invalidity proceedings
(Article 7 CDR)’

Entitlement proceedings

Entitlement proceedings – Change in ownership

Entitlement proceedings and changes in ownership



Recognition as the **legitimate holder**.

Recognition as **joint holder**. 

Entry in the Register

- start of legal entitlement proceedings;
- final decision;
- change in the RCD's ownership.

Requirements for entries relating to entitlement

No fee

Filed by:

- the RCD holder(s); or
- the applicant for the entitlement proceedings.
- the person recognised as the legitimate holder of the RCD.

Mandatory indications:

- RCD number
- the holder's name, address and nationality
- the legitimate holder's name, address and nationality



Free IP support for SMEs

HOW TO GET FREE IP SUPPORT?

Five **STEPS** to get your **FREE IP SUPPORT**

1.



Fill out and
send the form

2.



We receive
the form

3.



Is your support
request eligible?

If so, we will email you a list of
collaborators offering Free IP support.

4.



Start your
Free IP support!

Within 10 days of receiving our email with the list of
collaborators offering Free IP support, you must:

- **SELECT ONE** Free IP support collaborator.
- **CONTACT** them to start receiving their support.
- **INFORM US** of your chosen collaborator by replying to
the email we sent listing the available collaborators.

5.

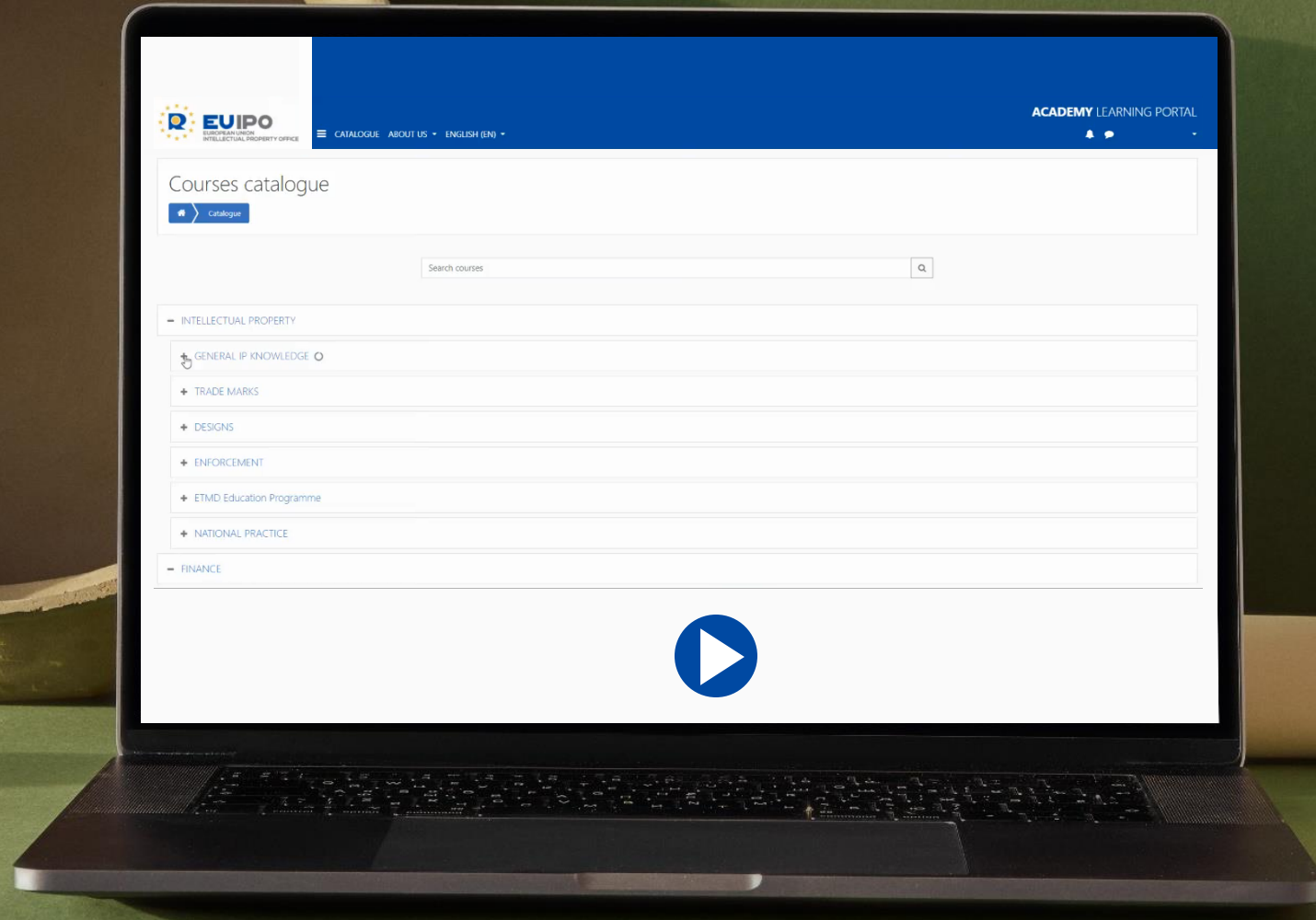


Feedback

Once you have finished receiving
your Free IP support, please
INFORM US by email and **FILL IN**
the [satisfaction survey](#).



Keep in touch with the EUIPO Academy





Kelly BENNETT
Legal Department - EUIPO



EUIPO
EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

www.euipo.europa.eu

 [@EU_IPO](https://twitter.com/EU_IPO)

 [EUIPO](https://www.linkedin.com/company/euipo)

 [EUIPO.EU](https://www.facebook.com/EUIPO.EU)

THANK YOU



EUIPO

EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

www.euiipo.europa.eu



[@EU_IPO](https://twitter.com/EU_IPO)



[EUIPO](https://www.linkedin.com/company/euiipo)



[EUIPO.EU](https://www.facebook.com/EUIPO.EU)

THANK YOU

**TUESDAY
WEBINARS**