UNREGISTERED COMMUNITY DESIGNS: A RIGHT NOT TO OVERLOOK DURING DISPUTES!

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In addition to the protection by copyright and registered design, the appearance of an industrial or artisanal item (product) can be protected by an unregistered Community design (UCD). This protection system, often forgotten in the past, is beginning to claim its place in disputes relating to the appearance of product, particularly in the fashion field where many products have relatively short life cycles, meaning that filing a protection request may sometimes be too costly.

The UCD meets the same protection criteria as registered Community designs. Therefore, among other things, the design must be new and have an individual character.

Remember, the novelty requirement for a product will be met if not other identical design has been disclosed to the public (including those that differ only in significant details). As for the requirement of individual character, it will be recognised if the overall impression the design makes on the informed user differs from that produced by any other design which has been publically disclosed.

What is the difference with the registered Community design?

Firstly, as the name indicates, no filing formality is required. Making the savings on taxes jump out! The economic benefit relating to the filing of a design is therefore unquestionable.

However, to obtain protection, initial disclosure in the European Union must be demonstrated with certainty since this will determine the protection period. This date cannot be approximate and is often difficult to prove, and here we find the major downfall of this protection system!
Additionally, the difference in the protection period compared to a registered Community design is noticeable: only 3 years protection from the date of disclosure, compared to 5 years (from the date of filing), renewable 4 times, for a registered Community design.

Finally, its scope of protection is limited to intentional copying. This is not comparable to slavish copying as Article 19.2 of the Council Regulation n°6/2002 specifies that the disputed use is not considered a copy “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.” Therefore, recognising a copy of an UCD will be harder than for a registered Community design, as the bad faith of the copier must be proved.

- What about copyright protection versus UCD

Even if, as with the UCD, copyright does not require any formalities, these two rights are quite different.

The protection criteria for each are very distinct: while a design must be new and have individual character (as detailed above), the work protected by a copyright must be “original”, a condition of protection classically defined in jurisprudence as reflecting the “personality of the author”. This criterion is distinct and different from those eligible for protection by a design.

Copyright protection enjoys two significant advantages compared to the UCD: it has a protection period of 70 years after the death of the author, and is independent of disclosure (meaning copyright can be claimed on an original work, even if it remains secret, as long as the date of creation can be proved).

The same product may fulfil all the criteria and therefore benefit from both protections, although this is not systematic, and in terms of applied arts is increasingly difficult to prove.

For example, in the Paris Court of Appeal decision (Pôle 5, Chambre 1) n° 206/2016 of 12 April 2016 between SANDRO ANDY (marketing products under SANDRO) and the DIRAMODE Company, SANDRO ANDY’s “MICHIGAN” and “MICHIGAN BIS” coats are protected by copyright. The Court reiterates that “the notion of priority is immaterial in copyright law, which instead requires that the person invoking these dispositions can justify that the claimed work presents an individuality which shows an aesthetic choice and reflects the personality of the author”. One of the coats – “MICHIGAN” - is also protected by an unregistered design (SANDRO ANDY did not request the same protection for MICHIGAN BIS). The Court therefore submits that to establish this protection “the holder of an unregistered Community design is
not required to prove that it presents an individual character, but must identify the elements of the design that give it said character. It is down to the one who denies said character to prove that the overall impression produced on the informed user is identical to that produced by a previous publically disclosed design”; which DIRAMODE failed to do. It should be noted that in this instance neither the infringement of the copyright nor the unregistered design was upheld by the Court.

This shows that the UDC can be a possible defence against third parties that intentionally copy your designs, but without giving you the security of protection offered by a registered design.

We are available to establish an overall protection strategy linked to the appearance of your products and/or help you in cases of third party disputes.

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