

Praha | Bratislava

ŠTROS & KUSÁK

ADVOKÁTNÍ A PATENTOVÁ KANCELÁŘ
ATTORNEYS-AT-LAW & PATENT ATTORNEYS
RECHTSANWÄLTE & PATENTANWÄLTE

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Industrial property

- Trademarks
- Patents (granted on inventions)
- Utility models
- Designs
- Appellations of origin/geographical designations
- Inherent is the registration principle

Design

- The outward appearance of a product or part of it (resulting from its lines), contours, colours, shape, material and/or ornamentation
- Product = any industrial *or* handicraft item (including packaging, graphic symbols)
- Computer programs (software) excluded from protection

Protection systems

- National protection (Czech, Slovak, German, etc.)
- International protection (Hague Agreement)
- Community protection (RCD, UCD)

Hague Agreement

- An international system, which confers national protection by filing a single application with the WIPO
- The application designates in which protection is sought
- Approximately 40 member states

Hague/.. RCD, UCD

- Hague systems provides opportunity to :
via one *centralised* application obtain
several national protections
- WHEREAS
- Community design grants ONE right in the
whole territory of the Union

Design in conflicts with other industrial property rights

- In fact no conflict
- One product can be protected by more industrial property rights, typically:
 - Copyright
 - Trademark
 - Design

Benefits of Community rights

- Strong and uniform protection
- Single application
- Single language
- Single administrative centre
- Single payments
- Multiple applications
- Possibility to keep the design undisclosed for up to 30 months to avoid competitors learning of it

Design ../.. 3D trademark

- Both protections available
- Design = relates to the shape, lines, contours of a product
- 3D mark = relates to the distinctiveness of the mark
- Main difference is :
 - Trademark protection has virtually no time limite
 - Design protection limited to max of 25 years

Design ../.. Patent

- Patent covers function, operations, processes, technology
- Patent has basically different criteria of protection (novelty, innovative steps, industrial applicability)
- Patent protection is limited in time (20 years, some patents can however be extended)

Community design history

- Draft paper of the Max-Planck-Institute, Munich, dated 1990, which was picked up by the Commission in the Green Book, and 1993 it became the first proposal for legislation
- Agreement on need for unified protection (similar to the CTM)

Community design overview

- Based on the Directive 98/71/EC of 13th October 1998, which called for approximation of national laws
- Regulation No 6/2002 dated 12th December 2001, on the Community Design
- Reg No 6/2002 came into force on 6th March 2002
- Texts can be found e.g. on www.ohim.eu.int

Community design overview

- Reg No 6/2002 created :
 - Unitary system of protection in the whole European Union
 - One right, one registration number, one renewal, one administration of the right
 - Unified system of enforcement
 - Equal value in all member states

Conditions of protection

- A design can be protected, if :
 - It is new (novelty requirement) - Art. 5
 - It has individual character – Art. 6 refers to the so called informed user

RCD & UCD

- Same scope of protection
- Both have unitary character
- Both have requirements of novelty and individual character

RCD & UCD

- What are the differences :
 - Conferred rights differ
 - RCD gives an exclusive right to use and prevent making, offering, putting on the market, importing, exporting, using or stocking for such purposes products incorporating the design, which does not produce a different overall impression

RCD & UCD

- What are the differences :
 - Conferred rights differ
 - UCD constitutes right to prevent the commercial use of the design ONLY if the use results from copying
 - If the design has been created independently, there will be no infringement

RCD & UCD

- What are the differences :
 - Infringement proceedings
 - RCD : the infringement court deems the RCD to be valid
 - UCD : the plaintiff must produce proof of the point in time of the disclosure and indicate what constitutes the individual character of the design
 - *To indicate* is not identical with *produce proof*
 - Similar to produce proof and make plausible (Glaubhaft machen)

RCD & UCD

- What are the differences :
 - Period of protection:
 - RCD : initially has a life of five years from the filing date
 - However, can be renewed in blocks of five years up to maximum 25 years – then, the protection expires once for ever (exceptions available)

RCD & UCD

- What are the differences :
 - Period of protection:
 - UCD : protection available for three years from the date on which the design was first made available to the public within the territory of the Community
 - Thus, substantially shorter period of protection

RCD & UCD

- Limits & weaknesses of UCD
 - Proof of the date and place of first disclosure
 - Proof that the design refers to the disclosed design
 - Proof that the interested circles within the Community could have been aware of the disclosure itself
 - Proof that the defendant/infringer has in fact copied the protected design

Infringement action

- Not dealt with by the OHIM
- Fully in „national hands“
- Basically under national procedural rules
- *Inter partes* proceeding

Accession and IP

- Accession treaty Art. 110a:
 - As from the date of the accession, the Community designs protected or applied for before the date of the accession shall be extended to the territory of the new member states

Accession and IP

- Accession treaty Art. 110a:
 - Applicant or holder of an earlier right in a new member state may oppose the use of the Community right within the territory where the earlier right is protected;
 - Earlier right means a right acquired or applied for in good faith before accession

THANK YOU

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