



Registered and unregistered designs: the “ratio” behind unregistered Community designs

Some aspects to bear in mind when shaping a design portfolio strategy

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Davide L. PETRAZ
Co-Managing Partner



Giorgia COSTA
Trademark Attorney

Rights holders have the chance of protecting a design in the European Union by means of national design registration in the member states of interest and/or by a Community design covering all member states.

First of all, it is necessary to recall that the discipline of Italian designs and models (articles 31-44 of the Italian Industrial Property Code) largely corresponds to that of Community designs but does not provide for the category of unregistered designs.

Regulation on Community Designs No. 6/2002 generally provides for two categories of unitary titles: the “*registered Community designs*” and the “*unregistered Community designs*”.

As stated in recitals No. 16 and No. 17 of Council Regulation (EC) No. 6/2002 dated 12 December 2001, the discipline related to unregistered designs has been introduced to meet the need for protection of “*those sectors (that) produce large numbers of designs for products frequently having a short market life where protection without the burden of registration formalities is an advantage and the duration of protection is of lesser significance*”, pointing out that “*On the other hand, there are sectors of industry which value the advantages of registration for the greater legal certainty it provides and which require the possibility of a longer term of protection corresponding to the foreseeable market life of their products. (17) This calls for two forms of protection, one being a short-term unregistered design and the other being a longer term registered design.*”.

The requirements for protection are identical both for registered and unregistered Community designs but there are a few differences in terms of duration and scope of protection. These differences lead to different considerations that are important to bear in mind when shaping a design portfolio strategy.

As is widely known, Regulation No. 6/2002 grants automatic protection to unregistered designs which have been disclosed to the public in the EU. The protection of an unregistered Community design starts on the date on which the design was first made available to the public within the Community and lasts for a three-year period, which cannot be extended. Therefore, being able to provide evidence of the disclosure and its date is crucial to design protection.

The protection of a registered design starts on the filing date before the EUIPO and lasts for a five-year period, which can be renewed for further five-year periods up to a total term of 25 years.

Regarding the differences in scope, on the one hand it should be noted that unregistered Community design confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it, only if the contested use results from copying the protected unregistered design. In this regard, it must be taken into account that it is not always easy to prove that a design has been intentionally copied and that the infringer was aware of the existence of the protected design. In addition, it can be also difficult to provide evidence of the disclosure of a design in the European Union and the relevant date of on which the design was first made available to the public.

On the other side, the protection conferred by a registered design is greater and – needless to say – the registration of a design is attested by a certificate. In fact, Registered designs are protected against similar designs (*“any design which does not produce on the informed user a different overall impression”* as stated in Article 10 of Regulation 6/2002) even when the infringing design has been developed in good faith.

In light of the above, it is always advisable to carry out a case-by-case evaluation and decide whether it would be appropriate for the type of product/interests at stake to bear the costs of a design registration or otherwise opt for the protection offered by unregistered Community designs (for example, in sectors with seasonal products, such as the fashion industry, unregistered Community designs are particularly common).

Via L. Manara 13
20122 MILANO

Tel: +39 02 54120878
Email: glp.mi@glp.eu

Viale Europa Unita 171
33100 UDINE

Tel: +39 0432 506388
Email: glp@glp.eu

Via di Corticella 181/4
40128 BOLOGNA

Tel: +39 051 328365
Email: glp.bo@glp.eu

glp.eu

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