CITMA

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European Commission
By Online Upload

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Dear Sir or Madam

Response to Public consultation on Evaluation of EU legislation on design protection

The Chartered Institute of Trade Mark Attorneys (CITMA) is the professional and examining body for Trade Mark Attorneys in the UK, representing over 700 registered trade mark attorneys in the UK, whether in industry or private practice. Total membership is larger than this at over 1,600, with members also taken from the ranks of judges, barristers, solicitors, trainee attorneys and other professionals with an interest in intellectual property. CITMA represents the views of the trade mark profession to policy makers at national, European and international level, with representatives sitting on a range of influential policy bodies both in the UK and overseas.

CITMA would like to provide these comments in response to the consultation and is grateful for the opportunity to do so. This document has been prepared by CITMA's Design and Copyright Working Group, which consists of attorneys, solicitors and barristers with a particular expertise in design and copyright law, having filed a significant number of designs, and having acted on some of the key designs cases in the UK.

Overview: to a large extent, CITMA is very pleased with the design legislation at European level, as well as the operation of the EUIPO, which we find to be very impressive. However, there is always scope for some improvements, and these include in relation to (a) naming of design rights, (b) the number of representations permitted; (c) the period of deferred publication; (d) the extent of reliance on Locarno classes; (e) disclaimers and clarification of what is included and excluded from protection; and (f) what constitutes a disclosure for the purposes of unregistered designs.

Detail:

(a) **Naming of design rights:** we support the proposition made elsewhere that terminology in design law should mirror the recent changes to trade marks, and the design rights should be re-named EU Registered Design

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Rights and EU Unregistered Design Rights. These could be abbreviated simply to EU RDs and EU UDRs.

(b) **Number of representations permitted**: the current limitation on the number of views to 7 is unnecessary and unhelpful. There are some designs where more views are desirable, for instance to show detail of a more detailed design, or to show a moving design. The number of views elsewhere in the world is often very different – for example, 12 views are now permitted in the UK, and other parts of the world do not have any restrictions at all. Having a smaller number of views can – at least in theory – create priority issues and limits the ability for a designer to show the design fully. We propose the restriction is removed altogether or, if that is not feasible, it is limited to either 12 or, say, 20 views.

(c) **The period of deferred publication**: we would like to see this made consistent across EU member states by amendment to the directive to bring it into line with the 30 months permitted by the Regulation.

(d) **Locarno classes**: although we do not propose other changes to the fees, we propose that the requirement for designs in an application to be in the same Locarno class should be dispensed with. The current position makes it difficult to protect designs for parts of products and the complete products in the same application (such as "hairdryers" and "parts of hairdryers") whereas some other completely different products ("chair" and "table") can be included in the same application. This can cause unfairness over the costs of protection. We also suggest that, following recent case law, it is made clear that the inclusion of Locarno classes at all is simply for assistance in searching.

(e) **Disclaimers and clarification on the scope of protection:** it is well established under the current law that the written description allowed under the Regulation cannot be used to interpret the scope of protection of a Registered Design. This has led to difficulties in case law as to whether a design is intended to be restricted by certain features showing in the representation, or not. Most difficult is the question of whether an absence of surface decoration on a design should be seen as a feature in its own right, as it was in the UK case of Apple v Samsung ([2012] EWCA Civ 1339), or seen as meaning the design is for shape only (thereby meaning that surface decoration is not taken into account in an infringement assessment, as in the UK case of Procter & Gamble v Reckitt Benckiser - [2007] EWCA Civ 936). There is also the question of the use of conventions such as dotted lines, that have been interpreted differently in different UK cases (see Kohler Mira v Bristan

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([2013] EWPCC 2), Sealed Air v Sharp ([2013] EWPCC 23), Apple v Samsung (see citation above) for just three examples of different interpretations), let alone across the other EU member states. There is a significant strength of feeling amongst UK practitioners and judges that this needs clarification by the legislature. Either the written description should be published and relevant (perhaps to the extent that it seeks to explain the representation), or tick boxes could be used to identify what category a representation comes into (this would save the need to translate the written description). The tick boxes should, at the very least, ask an applicant to identify if it is seeking to protect "shape only" or not.

(f) **Disclosure for the purposes of Unregistered Designs:** at present, based on the German Supreme Court interpretation of Art 110a, if a French designer shows its product first at the Paris Fashion Week, it gets Unregistered Community Design protection for that design. If, however, it wishes to launch earlier the same year at the New York Fashion Week, that design does not get Unregistered Community Design protection. In most businesses, the first disclosure of a design is not determined by the availability of design protection, but by other commercial concerns. This means that it ends up being a lottery for European businesses whether they get EU design protection, or not. The law is silent on what happens if a design is launched online simultaneously inside and outside the EU (for example, on a website). This lack of certainty is not helpful for design businesses either within our outside the EU. We suggest that the law is clarified, ideally repealing Art 110a altogether but at the very least repealing or clarifying Art 110a(5). We suggest that the requirement is that EU design right subsists from the date of first disclosure in accordance with the wording of Art 7 of the Regulation.

Yours faithfully

John Coldham
Chair of the CITMA Design & Copyright Working Group