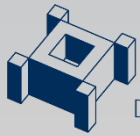


Metroconsult

DEFENDING CREATIVITY WITH TAILORED PROTECTION

IP in Fashion

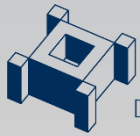
Milan, November 22, 2016



EU design system overview

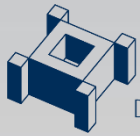


COVERAGE:
28 Countries



What can be protected – Definition (Art. 3 CDR)

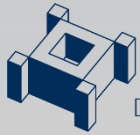
- (a) "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation
- (b) "product" means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;
- (c) "complex product" means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.



Appearance



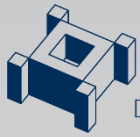
Careful if substantial parts are hidden



Examples of Community Registered Designs in fashion (1)



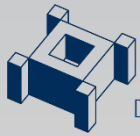
Shoes (Community registered design no. 002767335)



Examples of Community Registered Designs in fashion (2)



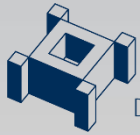
Purses (Community registered design no. 003358589)



Examples of Community Registered Designs in fashion (3)

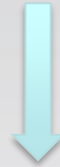


Watches (Community registered design no. 002766618)

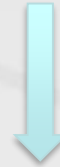


Remark

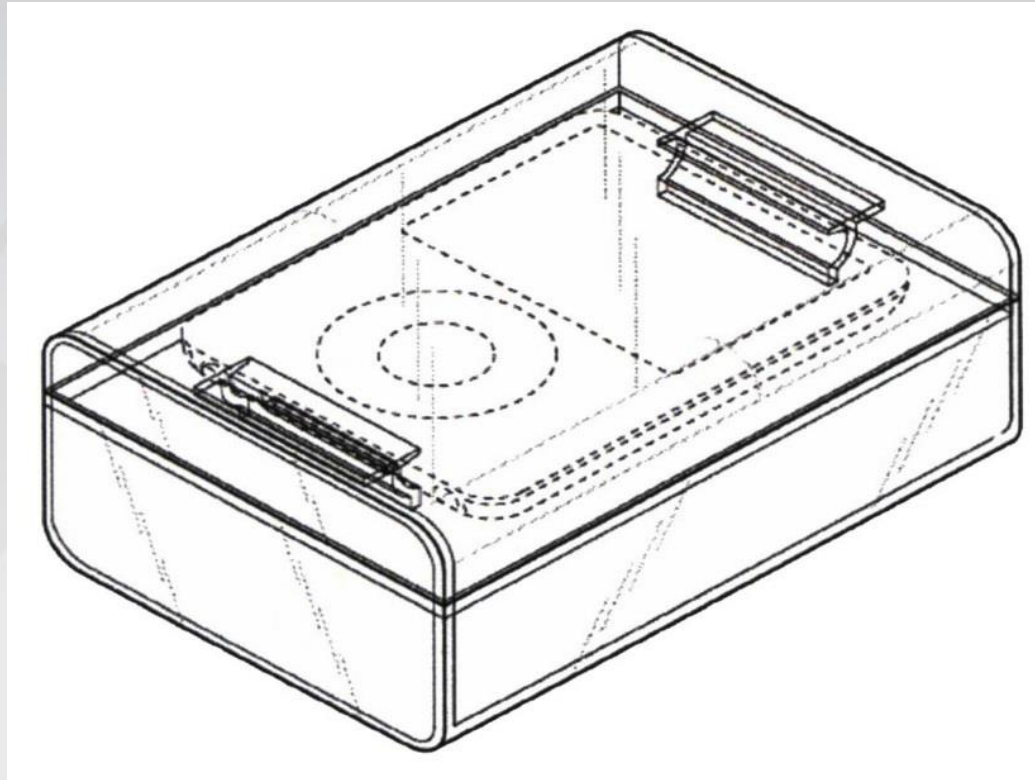
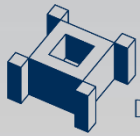
“Fashion” is created not only by the product itself



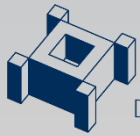
“Fashion” also derives from how the product is presented



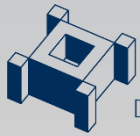
Packaging, appearance of stores (e.g. flagship stores), screenshots, etc. can be considered for design protection



Packaging (Community registered design no. 000891395)



Shop layout (Community registered design no. 003381086)



STOLZE-SPAETH-HOTELS
HOTEL BAYERISCHER HOF
Lindau im Bodensee

Zimmer und Suiten

Gastronomie

Wellness

Konferenzen

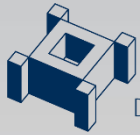
Lindau

Ausflugstipp

Golf

Kontakt

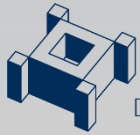
Screenshot (Community registered design no. 000449830)



Requirements for protection (art. 4 CDR)

A design shall be protected by a Community design to the extent that it is new and has individual character.

[...]



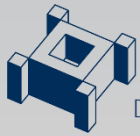
Novelty (art. 5 CDR)

1. A design shall be considered to be new if no identical design has been made available to the public:

(a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;

(b) in the case of a registered Community design, before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.

- 2. Designs shall be deemed to be identical if their features differ only in immaterial details.



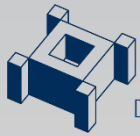
Individual character (art. 6 CDR)

1. A design shall be considered to have individual character if the overall impression it produces on the **informed user** differs from the overall impression produced on such a user by any design which has been made available to the public:

(a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;

(b) in the case of a registered Community design, before the date of filing the application for registration or, if a priority is claimed, the date of priority.

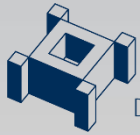
2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.



Unregistered Community design (art. 11 CDR)

1. A design which meets the requirements under Section 1 shall be protected by an unregistered Community design for a period of three years as from the date on which the design was first made available to the public within the Community.

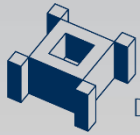
2. For the purpose of paragraph 1, a design shall be deemed to have been made available to the public within the Community if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the Community. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.



Unregistered Community Design



Interesting for quickly changing products
(possible scenario for fashion industry),
but...



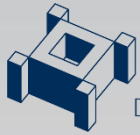
Rights conferred by an unregistered designs

[...]

2. An unregistered Community design shall, however, confer on its holder the right to prevent the acts referred to in paragraph 1 only if the contested use results from **copying** the protected design.

The contested use shall not be deemed to result from copying the protected design 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.

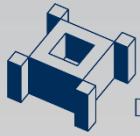
[...]



Informed User (1)

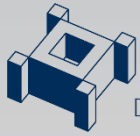
Court of Justice C-281/10

“...that concept must be understood as lying somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, who is an expert with detailed technical expertise. Thus, the concept of the informed user may be understood as referring, not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question.”



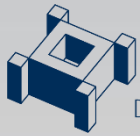
Informed User (2)

...it is true that the very nature of the informed user as defined above means that, when possible, he will make a direct comparison between the designs at issue. However, it cannot be ruled out that such a comparison may be impracticable or uncommon in the sector concerned, in particular because of specific circumstances or the characteristics of the devices which the designs at issue represent.”

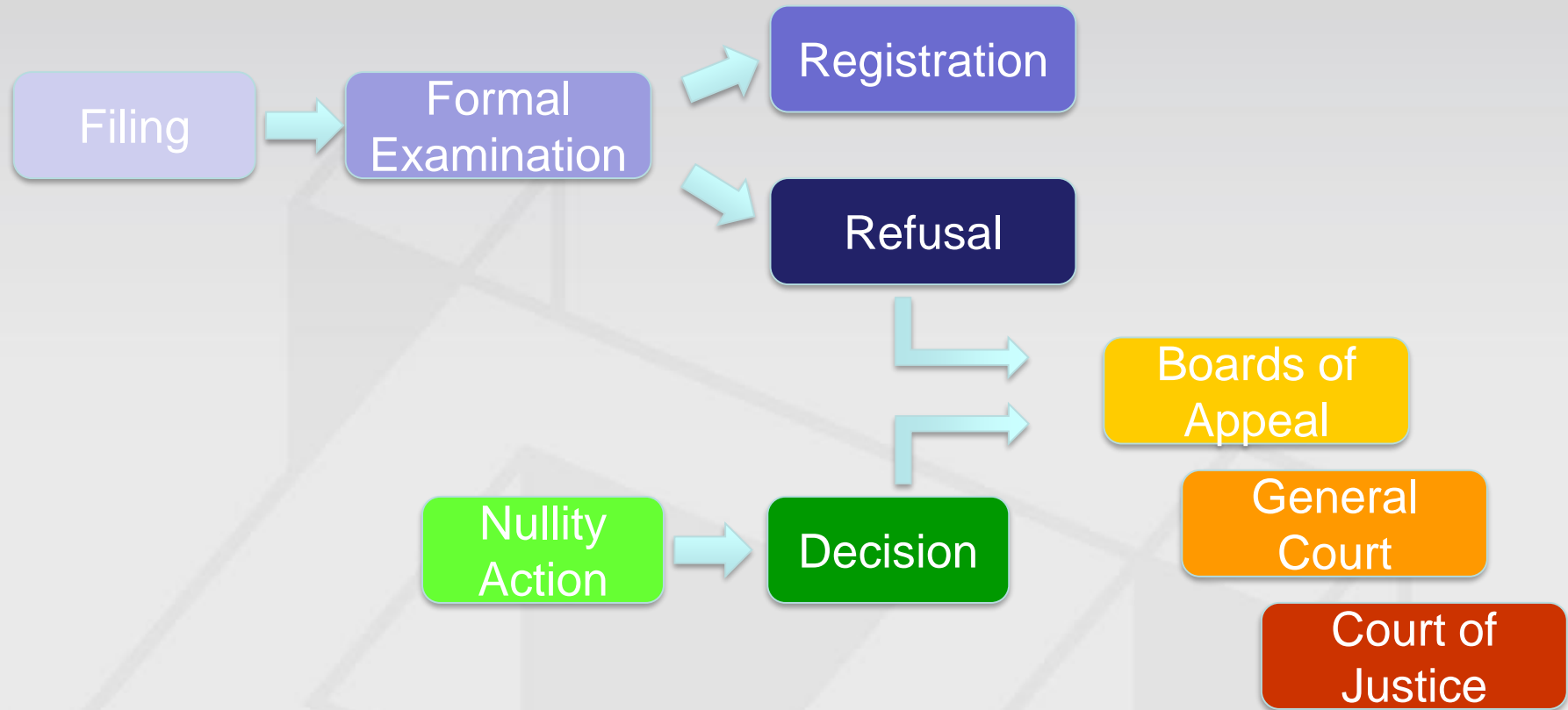


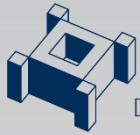
Informed User (3)

...the qualifier ‘informed’ suggests that, without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them.”



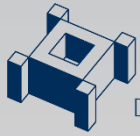
Procedures before the Office





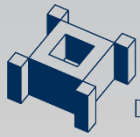
Infringement actions

Infringement actions are dealt with by national courts



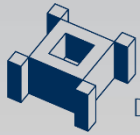
Multiple applications

- One application can comprise one or more designs
- All the designs included in the same application must belong to the same Locarno class



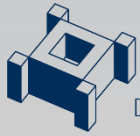
Design & copyright protection

- In line of principle an overlap is allowable
- There is not an harmonized EU copyright law
- The issue has to be solved by national courts
- In general terms, not all products that can be protected as design can be also protected under copyright law
- Protection according to copyright law requires something more than «individual character» -> closer to a work of art



Design & tridimensional trademarks

- In principle it is not excluded that the same shape can be protected both as a design and a trademark
- The particular appearance in addition to having «individual character», must also be «distinctive»
- Trademark protection should not be used to extend for an indefinite time what can be protected only for a limited time



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INTELLECTUAL PROPERTY CONSULTANTS

Thank you for your attention!

Matteo Baroni

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