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Industrial Designs and Their Legal Protection

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INDUSTRIAL DESIGNS

AND THEIR LEGAL PROTECTION



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INDUSTRIAL PROPERTY OFFICE
OF THE CZECH REPUBLIC





What is an industrial design?

An industrial 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. It is therefore a visually perceivable property or component of the product given to the product, in addition to its other components, such as particularly the “what is the product made of” or “how is it technically or structurally arranged in order to perform a certain function” categories, by its designer, who should be an industrial designer in the optimal case. Therefore, it is not a technical, structural, functional, material or other essence of the product, even if that essence is recognizable from the real product or its representation.

A product in the terminology of the legal protection of industrial designs is any industrial or handicraft item, including parts intended to be assembled into a complex product, graphic symbol (e.g. pictogram) and typographic typefaces (writing in the sense of a set of alphanumeric characters), except for computer programs. A complex product is a product which is composed of multiple components which can be replaced permitting disassembly and reassembly of the product. Graphics in itself, without being applied to a specific carrier (which must be a particular spatial or flat product) or integrated in its overall appearance, is not an industrial design because it does not represent the appearance of the product.



Why to seek legal protection of an industrial design?

The general knowledge of the public already includes the awareness of the possibility to legally protect technical and structural solutions by a patent for an invention and by registration of a utility model in the register. The industrial legal protection of an industrial design by registering it in the register of industrial designs is analogy of such protection, but for solutions of another type – for designer solutions. The obtained protection secures an advantage for its owner (e.g. vis-à-vis competitors) in the form of the exclusive right to use the industrial design, to prevent third parties from using it without the owner’s consent, to give consent to the use of the industrial design to other persons (licence) or to transfer the right to the industrial design to other persons. The use of the industrial design means particularly manufacture or marketing of a product in which the protected industrial design is integrated or which it is applied to. By the protection of an industrial design, the entitled person may safeguard and further improve the designer solution on the creation of which that person spent significant costs and effort as well as on introduction of the manufacture of the product in which the industrial design is integrated or which it is applied to.



Legal regulations

The protection of industrial designs, including the definition of rights and relations resulting therefrom, is regulated particularly by the following legal rules:

- *Act No. 207/2000 Coll., on the protection of industrial designs and on the amendment of Act No. 527/1990 Coll., on inventions, industrial designs and rationalization proposals, as amended (hereinafter referred to as “Act on Industrial Designs”),*
- *Act No. 500/2004 Coll., the Rules of Administrative Procedure;*
- *Act No. 634/2004 Coll., on administrative fees, as amended;*
- *Act No. 337/1992 Coll., on the administration of taxes and fees, as amended.*



What industrial design can be protected by registration in the register of industrial designs?

Not all industrial designs can be registered in the register of industrial designs. An industrial design is eligible for protection if it is new and has individual character. An industrial design shall be considered new if no identical industrial design has been made available to the public before the date of filing of the application or before the date on which the right of priority was created. A disclosure shall not be taken into consideration if an industrial design for which protection is sought has been made available to the public by the designer or their legal successor during 12 months preceding the date of filing of the application. Industrial designs shall be deemed to be identical if their features differ only in immaterial details. An industrial design shall 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 industrial design which has been made available to the public before the date of filing of the application. An industrial design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character, if the component part, once it has been incorporated in the complex product, remains visible during normal use of the product, and if the visible features of the component fulfil in themselves the requirement of the novelty and individual character.

In assessing the eligibility of an industrial design for registration, it is necessary to take into account the provision of Section 7 of the Act on Industrial Designs which concerns industrial designs including features dictated by their technical function and industrial designs including features of mutual interconnection.

Even if the industrial design meets all aforementioned basic criteria for registration in the register, it will not be registered if it is contrary to public order or to principles of morality, or if there is an obstacle in the form of the so-called earlier right, which means that an application of an identical industrial design has already been filed with the Office before.



Who is entitled to file an application of an industrial design?

An application of an industrial design may be filed by the designer or their legal successor. The designer is a natural person who created the industrial design by their own creative activity. If the designer created an industrial design to fulfil the task resulting from their employment (the so-called employee industrial design), the right to the industrial design shall pass to the principal, unless it is stipulated otherwise in a contract. The designer who created an industrial design within the framework of the employment relationship is obliged to notify immediately the principal of this fact in written form and to give the principal documents necessary to the assessment of the industrial design. If the principal does not exercise the right to the industrial design within the period of three months from the notification (if the principal exercises this right, the principal may file the application stating that it concerns an employee industrial design), the right shall pass back to the designer and the designer may file the application. If the applicant is a person other than the designer (another natural person or legal entity, and if the application does not state that it is an employee industrial design), the proof of acquisition of the right to the industrial design has to be attached to the industrial design application. The industrial design application must state who the designer is, or the application must contain the designer's written statement that the designer waives the right to be mentioned in the application and/or subsequently in the register of industrial designs.



How to file an application of an industrial design?

Registration of an industrial design is applied for by filing an industrial design application, preferably using an official form available free of charge on the Internet or in the Office's filing office. The form contains basic information for the applicant and detailed instructions for filling in. The application (and most other submissions) can also be sent electronically if provided with an advanced electronic signature. Electronic submission without an advanced electronic signature must be completed with a written original within 5 days in order for the date of the first delivery to be recognized as the filing date. The same applies to filing by fax. (However, we strongly advise against the use of fax because of a possible defective transmission of the design representation, which may even lead to loss of data of the filed application.) An application of an industrial design may also be filed by post or in person in the Office. In order that the application of an industrial design may be considered as filed, it has to contain the applicant's identification data, the manifestation of the applicant's will to apply for registration of the industrial design in the register and the representation of the industrial design which gives a clear idea of the appearance of the

product or its part in a quality that allows its further reproduction. The representation of the industrial design is the most important annex to the application of the industrial design and it has to be executed very carefully because only the representation defines the subject matter and extent of the protection. The representation may be in the form of a photo or a drawing. However, the drawing must not be a production drawing or structural drawing since it should only show the appearance of the product. Five copies of the representation are attached to the application, and possibly another one for each co-designer.



What is a multiple application of an industrial design?

The application can be filed as a single application, i.e. registration in the register of industrial designs is requested for one industrial design only, or as a multiple application, i.e. registration in the register of industrial designs is requested in the application for two or more industrial designs. The possibility to file a multiple application of an industrial design is conditional on the fact that all industrial designs included in that application belong to one class of the International Classification for Industrial Designs (Locarno Classification). The purpose of the institute of the multiple application is to allow applicants, if they find it to be reasonable for their further intentions in dealing with their industrial property, to obtain protection, with a reduced administrative and financial burden, for a number of industrial designs at the same time (within a single procedure) through a single application. A mandatory part of the annexes to the multiple application of an industrial design is a list of industrial designs included in the application. The list must correspond to the number of industrial designs included in the application and to the numbering of their representations including the individual views.



What is the course of the industrial design application procedure?

The industrial design application procedure is conducted by the Office with the applicant or with a representative appointed by the applicant. For all industrial designs included in the filed applications, the Office examines, by operation of law, whether they meet the conditions prescribed for their registration in the register of industrial designs, i.e. substantive examination. In addition, after the application is filed, the Office ascertains whether the application has all necessary formalities. If the application is free of formal defects and its subject matter is free of material defects, the industrial design is registered in the register. The Office issues to the applicant, who became the owner of the registered industrial design at the moment of registration of the industrial design in the register, a certificate confirming this fact. At the same time, the Office publishes the registered industrial design (unless the applicant requested postponement of the

publication in the application) and subsequently announces registration of the industrial design in the Bulletin of the Office.

If the application does not meet the requirements prescribed by law, the Office shall invite the applicant to rectify these deficiencies. The Office shall set a time limit for that purpose. If the applicant fails to rectify these deficiencies within the set time limit, the Office shall suspend the application procedure.

If the subject matter of the application does not meet the conditions for the protection, the Office shall inform the applicant accordingly, providing them with a time limit for making a statement. If the applicant fails to refute the objections, the Office shall reject the application.

»» What is the term of protection of a registered industrial design?

The protection of a registered industrial design lasts for 5 years from the granted filing date of the industrial design application. The owner of the industrial design may renew this term of protection repeatedly, always for 5 years, up to the total term of 25 years from the filing date of the industrial design application. A request for the renewal of the term of protection can be filed during the last year of the respective five-year period. The request is subject to payment of a fee. If the request for renewal of the term of protection was not filed within the said time limit, the owner may file it during the grace period of six months from the date on which it was supposed to be filed at the latest. In such case, the fee for renewal of the term of protection shall double and third-party rights may arise in the meanwhile. The Office does not invite the owners to renew the term of protection of their industrial designs.

»» What are the basic administrative fees associated with the protection of industrial designs?

Filing a single application of industrial design, i.e. application including a single industrial design	1,000 CZK
- if only the designer(s) is (are) the applicant(s)	500 CZK
Filing a multiple application of industrial design, i.e. application including two or more industrial designs	1,000 CZK
- if only the designer(s) is (are) the applicant(s)	500 CZK
- for the second and every other industrial design included in the application	600 CZK
- for the second and every other industrial design included in the application if only the designer(s) is (are) the applicant(s)	300 CZK

Filing the request for the renewal of the term of protection of the registered industrial design

- *for a period of five years for the first time* 3,000 CZK
- *for a period of five years for the second time* 6,000 CZK
- *for a period of five years for the third time* 9,000 CZK
- *for a period of five years for the fourth time* 12,000 CZK

The administrative fee for the filing of the application is not the only cost item associated with the application for the protection of an industrial design. Costs associated with the making of truly high-quality representations (be it in the form of photographs or drawings) which define the overall appearance of the product (the representation gives the scope of protection of the registered industrial design) are certainly a comparable item. If the applicant has the application prepared by a professional representative and is represented in the filing of the application and in the further procedure, the applicant must count with additional costs.

How to obtain the protection of an industrial design abroad?

The owner of an industrial design protected by registration in the register of industrial designs, administered in the Czech Republic by the Office, has their industrial design protected only on the territory of the Czech Republic. If the owner wishes to have it protected in other state(s) as well, the owner has to obtain protection there.

The law of the Czech Republic leaves it entirely at the decision of the applicant, or the holder of the right to the industrial design, where and how they will apply for protection of their industrial design. Applying for the industrial design abroad is then always governed by the respective law of the state or regional unit where the application for granting the protection is directed.

National industrial property offices generally do not have any competences for a service which would consist in applying for the protection of industrial designs abroad for persons (natural persons or legal entities) residing in the territories of states that established these offices. The Office does not have such competence either; it can only help applicants by providing general information.

For applying for industrial designs abroad, the so-called "Union priority" is an important concept. This institute makes it possible to maintain the right of priority from the first filed application even for application with the same subject matter filed in other states. The precondition is that the industrial design application claiming the Union priority must be filed within 6 months after the filing date of the first application (the so-called priority application) which established the Union priority.

An applicant having their seat in the Czech Republic who wants to protect their industrial design abroad has the following possibilities:

1. Protection in the individual states of the world through the so-called national route

One of the ways to obtain the protection of an industrial design abroad by registration (most often by registering the industrial design in the national register but e.g. in the USA by patent) is to file the application directly with the relevant office of each target state in which the industrial design is to be protected.

If the filed application and its subject matter meet the formal and substantive requirements, the applicant shall obtain a set of individually territorially acting and mutually independent protections in the selected states.

As regards the substantive and formal requirements of the application and the application procedure before the foreign office itself, the rules set by the state which established that office shall apply. These rules often vary between the individual states, particularly as regards the formal aspect of the application and the procedure before the office. In the vast majority of states, the applicant, having the seat abroad from their point of view, must choose a qualified, i.e. authorized for such service in the given state, representative for communication with the office in that state. All information concerning the filing of the application of an industrial design abroad, the application procedure itself and the amount of fees including the time limits for their payment can be obtained from the local office or local authorized representatives, or from members of the Czech Chamber of Patent Attorneys or members of the Czech Bar Association who have established contacts with their professional partners abroad.

Material conditions for registration of an industrial design in the register are usually similar across countries but they may vary. Therefore, an industrial design that has achieved protection in the Czech Republic may not achieve it in another state and vice versa. The valid act on the protection of industrial designs in the Czech Republic is harmonized, as far as material conditions are concerned, with analogous legal regulations in the EU countries.

2. Protection in regional units

An applicant with the seat in the Czech Republic may apply for their industrial design and obtain protection also for certain supranational territorial units.

A) Benelux

The protection of an industrial design for the entire territory of all three Benelux countries can be obtained by filing an application with the Benelux Office for Intellectual Property. For detailed information, see <http://www.boip.int/>.

B) European Union

An applicant with the seat in the Czech Republic may obtain protection for their industrial

design by registering a Community design, the protection of which applies to the whole territory of the member states of the European Union.

The place for filing a Community design application is the European Union Intellectual Property Office (EUIPO, formerly OHIM) in Alicante, Spain. It is also possible to use the so-called indirect filing of a Community design application through the national industrial property offices of the EU member states, i.e. also through the Office. All information about the Community design is available at <https://euipo.europa.eu>.

The applicant for a Community design having their seat in the territory of the EU does not have to be represented, but may be represented by a representative authorized to represent in matters concerning industrial designs before EUIPO. These representatives are listed by EUIPO in the eSearch plus database available at that office's website.

The registered Community designs (the system was launched on 1 April 2003) became retroactively effective also for the territory of states that joined the EU on 1 May 2004. Should there be a collision with an industrial design registered using the national route in the Czech Republic, the earlier right shall prevail for the territory of the Czech Republic.

There is also the form of protection using the so-called "unregistered Community design" existing in the territory of the European Union; this protection is created without any application and subsequent registration simply by placing the product in which the respective industrial design is incorporated on the EU market.

3. The Hague System for international registration of industrial designs

The international system for registration of industrial designs is based on the Hague Agreement which consists of three mutually independent Acts: the London Act (1934), the Hague Act (1960) and the Geneva Act (1999).

Since 1 January 2008, the European Union has also become a member party to the Geneva Act of the Hague Agreement. Applicants who have their place of permanent or habitual residence in the territory of the EU, are citizens of a member state of the EU or have an establishment in the territory of the EU may obtain protection of their industrial designs under the Geneva Act (the latest of the three valid agreements) in states or intergovernmental organizations that are also members of the Geneva Act of the Hague Agreement. The advantage of this system when compared with applying for industrial designs through the national route (see Clause 1 of this Chapter) is cost savings consisting in the filing of one international application with the International Bureau of the World Intellectual Property Organization in Geneva (hereinafter referred to as "WIPO") which administers the Hague System for the International Registration of Industrial Designs. Detailed information about applying for industrial designs through the international route is available at WIPO's website <http://www.wipo.int> in the Industrial Designs section.

Where can you get further information?

Industrial Property Office

Employees of the Office are ready to answer your questions related to industrial designs, to provide general information on formal requirements for applications or the circumstances of proceedings concerning these applications, on administrative fees and performance of searches.

The Industrial Property Office provides, inter alia, the following services for the area of industrial designs:

- *industrial design searches – the outer appearance of the product is assessed*
- *searches for the legal status of registered industrial designs*
- *searches for the name of the designer or owner of a registered industrial design*
- *allowing to perform one's own industrial design search in the Internet databases (both national and foreign) as well as in materially classified files of registered industrial designs in Czechoslovakia and the Czech Republic on the basis of providing the necessary instructions (free of charge)*
- *making copies of the register cards of registered industrial designs*

Information Centre of the Office

Information related to the issue area of the protection of industrial designs or to the industrial design application procedure will be provided to you by the Information Centre.

Internet

Information about the activities and services of the Office can also be obtained on the Internet at www.upv.cz.

On its website, the Office provides access to information about the individual subject matters of industrial property, provided services, relevant legal regulations and activity of the Office's educational facility – the Industrial Property Training Institute. The presentation of the individual subject matters of industrial property includes the relevant application forms. As part of the extension of services to the Internet users, the Office placed on its website, in addition to the information and application forms, also order forms that can be used to order online industrial design searches, Bulletins of the Office and publications of the Industrial Property Training Institute.

Naturally, the Office is still developing electronic services. The individual industrial rights classifications are available through the Internet (in PDF format), so is the Bulletin of the Office.

A search database of registered industrial designs is also available free of charge.

Industrial Property Office

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Office hours of the public reading room and the Information Centre:

Monday 8:00 a.m. – 5:00 p.m.
Tuesday 8:00 a.m. – 4:00 p.m.
Wednesday 8:00 a.m. – 5:00 p.m.
Thursday 8:00 a.m. – 4:00 p.m.
Friday 8:00 a.m. – 2:30 p.m.

Attorneys and patent attorneys:

Attorneys and patent attorneys provide expert advice and assistance to natural persons and legal entities in industrial property matters, arrange preparation of applications, their filing and representation in proceedings before the Office.

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