

# The Trademark

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## Lawyer

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# EU design law: strategic considerations for Registered Community Designs

**Verena Schladt of KUHNER & WACKER Intellectual Property Law Firm PartG mbB details the required process for successfully registering an RCD in Europe with guidance for international protection.**

**R**egistered Community Designs (RCDs) are an excellent option for the protection of product designs as they offer many advantages for the applicant. They provide quick and EU-wide protection, whilst being cost-efficient and easy to handle for the applicant.

The volume of applications received by the European Union Intellectual Property Office (EUIPO) is constantly high. In 2022, the EUIPO received more than 100,000 RCD applications (including direct filings and filings through the WIPO Hague System). According to the recently published Consolidated Annual Activity Report 2022 of EUIPO, the unstable global situation only led to a slight decrease in RCD applications compared with 2021.

In day-to-day legal practice, however, the picture is often quite different. In many companies, there is a lack of sensitivity as to which new products could be protected as designs or Community designs, and why such protection is advisable.

## Save time, effort, and money by registering EU designs

For applicants seeking design protection in the European Union, it is regularly recommended to apply for an RCD. These rights are administered by the EUIPO based in Alicante/Spain and are valid in all member states of the European Union.

Providing the applicant operates exclusively in one EU member state, an alternative option is seeking registration for a national design with the IP office of this EU member state covering a single country only. For example, German applicants can apply for a national design with the German Patent and Trademark Office (GPTO) in Munich. This right only provides protection throughout Germany and is somewhat less expensive than an RCD. However, as soon as a further country is to be covered, national designs generally



Verena Schladt

have a financial disadvantage compared to RCDs.

Of course, natural or legal persons based outside the European Union, who do not have their domicile or principal place of business or a real and effective industrial or commercial establishment in the EU, can also apply for an RCD. They are generally obliged to appoint a representative within the EU for all proceedings before the Office, other than filing the application.

It is important to understand that there are two different options to pursue the RCD application: it can be filed directly with the EUIPO resp. the central industrial property office of an EU member state or, alternatively, be included in an international design application with the World Intellectual Property Office (WIPO) designating the European Union. Either way, the RCD provides uniform protection for all (currently) 27 EU member states.

## Résumé

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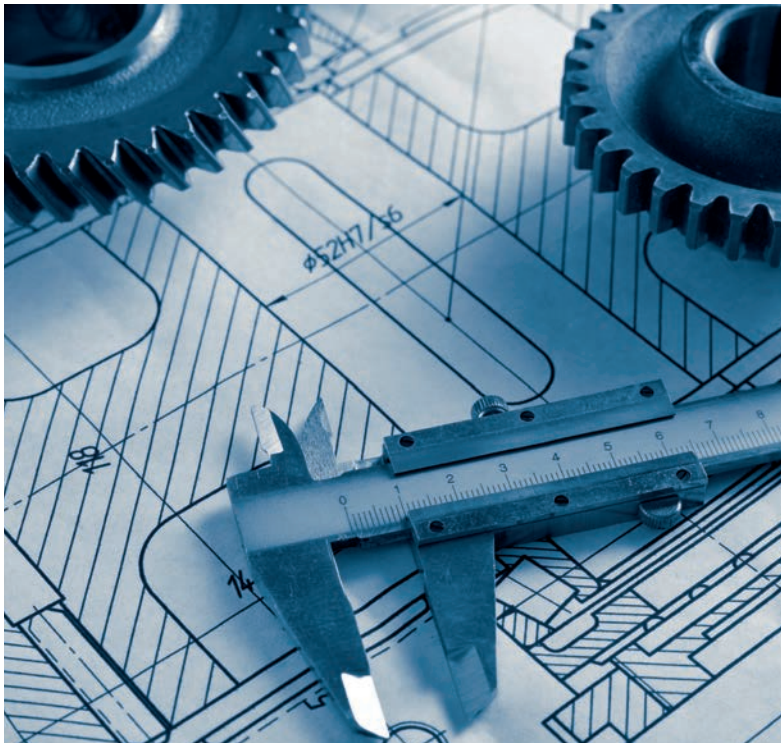
Verena Schladt joined the renowned IP firm KUHNER & WACKER in 2017. Having studied law at the University of Regensburg and worked as a junior barrister at the Nuremberg Higher Regional Court, Verena Schladt joined the Bar Association in 2009 and obtained her PhD from the University of Regensburg in 2013.

As one of KUHNER & WACKER's certified IP Lawyers of the legal, trademark, and design department, she has filed a multitude of EU trademark and EU design applications and is deeply committed to obtaining and enforcing IP protection for K&W's international and national clients. Her special fields cover trademark law, design law, competition law, copyrights, complaint proceedings, infringement proceedings, license and cooperation agreements, and product piracy. Before joining KUHNER & WACKER she worked for an IP law firm in Munich.

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A single application is sufficient, which can be filed in any official language of the European Union. The fees for the application are also payable solely to the EUIPO.

If the applicant seeks protection not only for the product itself, but also for some variations, for example, different color combinations, or a certain product line, several designs can be combined in a multiple application. A multiple application contains two or more designs within the same application but each of the designs is examined and treated independently. As the costs for a multiple application are substantially lower (varying depending on the number of designs) than filing separate design applications for each product, this feature enables applicants to get the best possible protection at reasonable costs, provided that the products in which the designs are to be incorporated or to which they are to be applied belong to the same class according to the International Classification for Industrial Design ("Locarno class").

These circumstances make it clear that the RCD brings many advantages: it saves the applicant time, money, and administrative effort, especially in comparison to filing national designs with the competent authorities of the individual EU member states.

Within the application procedure, EUIPO only examines the formal requirements for registrability, i.e., compliance with the definition of the design of Article 3 (a) Community Design regulation (CDR) (appearance of an industrial or handicraft item), and if it is not contrary to public policy or to accepted principles of morality pursuant to Article 9 CDR, whereas the validity of the RCD is not verified.

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**They provide quick and EU-wide protection, whilst being cost-efficient and easy to handle for the applicant.**  
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This limited scope of examination regularly enables a simple and straightforward registration of the design applied for. If the application meets the substantive requirements, the RCD is registered at the EUIPO without any objection from the examiner in charge within approx. two-four months. In the end, the EUIPO makes a unitary decision on the registrability of the RCD for all EU member states. Thereafter, the applicant may invoke a registered right to protect their product.

The RCD should not be confused with the unregistered Community design. Even without registration, it provides protection for three years from the date on which the design was first made available to the public within the territory of the EU. However, rights based on an unregistered Community design can only be claimed against an infringing design which is an intentional copy of the protected one, made in bad faith, and is thus much more difficult to enforce in the end.

### Take care of the graphic representation

In contrast to national design registrations in various countries, the scope of protection of an RCD is determined exclusively by the graphic representations filed with the application. Applicants should select the graphic representations very carefully, as errors can easily occur. In the worst case, bad representations may lead to the invalidity of the design.

Above all, care must be taken to file a clear and complete graphic representation of the product. According to EU law, one up to a maximum of seven views of the product to be protected is required for the design application. (Computer) drawings or photographs are particularly suitable for this purpose. The views may be in plan, elevation, cross-sectional, in perspective, or exploded. This graphic representation should include all the features of the design so that the object of protection of the design can be determined clearly and unambiguously based on the view(s), in order to ensure legal certainty. Although the application can contain further indications, such as descriptions, the graphic representation of the designs alone is decisive for the scope of protection of the design.

EU law allows applicants to protect a multitude of special types of designs, some of which are inadmissible in other jurisdictions. It is remarkable that one single figure of a design is sufficient, and, in some cases, a single illustration may provide broader protection than a complete representation of the product from all sides. Even if the overall impression of the designs to be compared is similar as regards the front view, the later design can have individual character because it differs in the side and back view. However, if the front view of the prior design is

protected as a single view, this argument cannot help the infringer.

Often, in addition to a perspective view, the applicant selects other views encompassing the front view, rear view, top view, side view, and others. All figures of an application must refer to the same product. The application will only be correct if all views are consistent. Besides the product, no other objects may be depicted in the background. Furthermore, no other elements may be added to explain the design, such as an indication of measurements or proportions.

The easiest and most efficient way to protect a portion or part of a product is to file a separate design just for this specific part, either as a fully separate EU design or as part of a multiple design application. Under EU law it is admissible to simply file one view showing a part of the full product, with protection for this part only.

Various types of views are also permitted, including partial or sectional views, and exploded views. Exploded views are views where parts of a product are shown disassembled, to clarify how the parts fit together. All the product's parts must be shown disassembled in a separate single view and combined with at least one view of the assembled product.

Similarly, the partial views (showing part of a product in isolation) must be combined with at least one view of the assembled product where the different parts need to be connected to each other. It is important to note that in this case, protection is granted for the design in total and not for its parts individually.

It is also possible to protect "moving designs", i.e., a short sequence of views used to show a single animated design at different specific moments in time, in a clearly understandable progression, for example, animated icons or animated graphic user interfaces.

These various design types allow the applicant to choose the best option, depending on the characteristics of the product for which protection is sought.

### International filing strategies

For design protection outside the EU, applying for an International Design at the International Bureau of the World Intellectual Property Organization (WIPO) should be considered. In addition to the EU, many other economically interesting countries, such as the USA, Switzerland, Norway, Great Britain, Japan, and China, can be covered by this protective right. Instead of filing individual applications with the respective national offices, a single application is sufficient for this purpose – similar to the RCDs.

Unlike the EUIPO, the application process for an International Design does not end with the completion of the formal examination by WIPO.

A further substantive examination may follow, if this is required according to the regulations of the countries in question. The offices of all designated countries examine whether the application complies with the national requirements for registration, for example, whether the designs are not contrary to morality, whether descriptions are attached, and in some cases whether the designs are new. Therefore, when applying for an International Design, care should be taken to consider the specific provisions of the individual countries, especially with regard to EUIPO's special design types that are not automatically admissible according to national law.

### Outlook: planned design law reform of the European Commission

As the Design protection system in the EU is more than 20 years old, the existing EU design law is currently being revised with the aim to update the design protection to the challenges of the digital age and at the same time make it even more efficient for applicants.

The European Commission presented their suggestions for a revised Regulation on November 28, 2022. Amongst others, the definitions of the terms "design" and "product" shall be specified. The new definitions explicitly cover digital forms, for example, movements or animations, as well as spatial arrangements of goods and other items (such as store interiors), graphical user interfaces, and logos. In addition, the protection regarding software for 3D printing is extended. These and further planned expansions aim to close existing gaps of design protection in view of the technological achievements and to further simplify the registration process. Another update concerns the terminology. Due to harmonization reasons, the designation "Community design" is to be replaced by "EU designs" in the future.

The intended changes mean an important step toward further optimization of the EU design law in favor of the applicant. But already today, the RCD offers quick and effective protection of one's own product against possible competitors. Since, in principle, almost any new product can be suitable as a design application, entrepreneurs should keep this in mind as early as the product development stage.

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