

# Industrial Designs

LEGAL PROTECTION

and

# Legal Protection

INDUSTRIAL DESIGNS

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## WHAT IS AN INDUSTRIAL DESIGN?

Industrial design means the appearance of the whole or a part of a product, resulting particularly from the features of the lines, contours, colours, shapes, textures and/or materials of the product itself and/or its decoration. It involves a visually perceivable complex of product features (the appearance), which has been incorporated into a product or its part in addition to other features, particularly of such categories as „the materials a product is made of“ or „how it is technically or structurally arranged in order to fulfil a certain function“ by its author, who would optimally be a professional designer. Consequently, industrial design does not involve the engineering, structural, functional, material or other nature of the product, and, if registered, its scope of protection does not cover the technical aspects of a product (even if these aspects could be recognizable from the actual product or representation thereof).

In the terminology of industrial design legal protection, the product means an industrially or hand-made object, including parts intended for assembly into a complex product, or a graphic symbol (such as a pictogram), typographic typefaces (script or lettering in the sense of a concrete set of alphanumeric characters that are usually exploited through printing) except for computer programmes. The complex product is a product consisting of several replaceable parts enabling disassembly and reassembly of the product. Graphics alone, without being applied to a carrier (a concrete three-dimensional or two-dimensional product) cannot be considered an industrial design, because it does not represent the product's appearance.

## WHY SHOULD YOU REGISTER YOUR INDUSTRIAL DESIGN?

To a certain extent, the public is aware of possibility of legally protecting technical solutions through a patent or utility model. Legal protection of an industrial design by registering it in the industrial design register is parallel to this, but is for solutions of another kind - design solutions. The protection acquired brings its owners advantages (with respect to competitors, for example). This advantage consists of the exclusive right to use the registered industrial design, to prevent use by a third party without approval, to provide licenses for other individuals to use the registered design or to transfer the design rights.

The term „to use the industrial design“ means in particular the manufacture or marketing of the product incorporating the registered industrial design or the one to which it is applied. By protecting an industrial design, the individual who is entitled to do so can assure and further increase the value of that design solution, which cost a great deal of time and effort to create.

## LEGAL REGULATIONS

The protection of industrial designs, including the definition of rights and relations derived from it is regulated by the following legislation:

- Act No. 207/2000 Coll. on Protection of Industrial Designs and Amendment to Act No. 527/1990 Coll. on Inventions, Industrial Designs and Rationalization Proposals in the wording of its later amendments (hereinafter „Industrial Design Act“),
- Act No. 500/2004 Coll. on Administrative Procedure (hereinafter „Administrative Regulations“),
- Act No. 634/2004 Coll. on Administrative Fees, in the wording of its later amendments.

The goal of this booklet is to provide public with basic information on the protection of industrial designs in understandable form and language. Together with other booklets published by the Industrial Property Office (Technical Solutions and Trademarks), the Office helps the public to get basic knowledge about different industrial property rights and the ability to distinguish among them.

Because space in this booklet is limited, its purpose is to emphasize the most important selected aspects of the given relevant questions. This booklet will not attempt to cover every part of the relevant legal regulations.

## WHICH INDUSTRIAL DESIGNS QUALIFY FOR REGISTRATION?

Not every industrial design can be registered in the industrial design register. An industrial design is qualified for protection if it is new and has an individual character. An industrial design is considered new if no identical design has been made available to the public before the application date of design for which protection is claimed or, if priority is claimed, the date of priority. The novelty of an industrial design is not affected if it was made available to the public by its author or successor within 12 months prior to application filing date. Industrial designs are considered identical if their features differ only in non-essential details. An industrial design is considered to have an individual character if the overall impression it evokes in an informed user differs from the general impression evoked in such a user by any design which has been made available to the public prior to the date of application filing or prior to the date of priority right if it is claimed.

The industrial design incorporated or applied to component part of a product is considered to be new and has an individual character only when the part remains visible (during normal use of the product) and when the visible features of the part comply with the requirement of novelty and individual character.

When assessing the eligibility of an industrial design for registration, it is necessary to consider Section 7 of the Industrial Design Act, which relates to designs containing features, dictated solely by their technical function as well as designs containing features of mutual interconnection.

Even though an industrial design complies with the aforementioned basic criteria for registration, it will not be registered if it is contrary to public order or morals, or if there is an obstacle represented by a so-called prior right, which

means simply that an identical industrial design has already been registered at the Office for protection.

## WHO CAN FILE AN APPLICATION?

Only the industrial design author (the designer) or his successor in title is entitled to file an application. The designer is the individual who created the industrial design through their own creative activity. If the designer created the industrial design as part of their employment (so called employment industrial design), the right to such industrial design belongs to the employer unless otherwise stated in a contract. The designer who accomplished an industrial design in an employment relationship is obliged to notify the employer immediately, and to submit all documents necessary for an industrial design assessment. If the employer fails to stake the claim to the industrial design within three months from the date of the notification, the rights revert to the designer and they can file the application themselves. If the employer decides to file for registration of this employment industrial design, this fact should be stated in the application.

If the applicant is not the designer (another individual or legal entity) and if there is no statement in the application that the industrial design is of the employment type, the industrial design application must be accompanied by a document certifying assignment of the right to the respective industrial design to the applicant. The designer must either be indicated in the industrial design application, or the application must contain a written declaration from the applicant that the designer has waived his right to be indicated in the application and eventually in the industrial designs register.

## HOW TO APPLY FOR AN INDUSTRIAL DESIGN?

Industrial design registration is applied for by filing an application, ideally by using an official form available free of charge in the Office or through its website. The form is accompanied by basic information for the applicant and detailed instructions. The industrial design application must be submitted to the Office either by the postal service or filed in person.

Applicants can also file electronically, either by e-mailing the application or via the direct e-filing service provided on-line on the Office website; a certified electronic signature should accompany electronic filings. If the electronic filing does not include a certified electronic signature, a hard copy of the filing must be submitted within 5-days. The same applies for sending applications by fax. However, applicants are strongly advised not to send their applications by fax due to the high probability that design representations would be destroyed during transmission, potentially resulting in the loss of filing date.

The industrial design application is considered filed on the condition that it contains information relating to the applicant, expression of their willingness to register the respective industrial design, as well as an industrial design representation giving a definite picture of the appearance of the product (or part

of a product) provided in a good quality enabling subsequent reproduction. Representation of the industrial design is the most important enclosure of the industrial design application and therefore its high quality is desirable because only the representation defines the scope of protection, i.e. what is protected. The representation can be made in the form of a photograph or a drawing. The drawing should represent the appearance of the product only and must not be of a construction or manufacturing nature. Five copies of this representation should be enclosed in the application, with one additional copy for each second and next co-applicant optional, if applicable.

### WHAT IS A MULTIPLE APPLICATION?

There are two types of applications - single and multiple. A single application can be filed when the registration is requested only for one industrial design. A multiple application means that the application is for the registration of two or more industrial designs. The condition for filing a multiple application of an industrial design is that all the designs included come under a single class of the International Classification for Industrial Designs (the Locarno Classification). The purpose of a multiple application is to enable the applicant to acquire complete protection within one application (within a single procedure) for a series of industrial designs with less administrative and financial cost, provided the applicant finds it reasonable for their further intentions with respect to treatment of industrial property. A multiple application must contain a list of the industrial designs as an enclosure. This list must correspond to both the numbers of the industrial designs contained in the application and numbering of their representations.

### HOW IS AN APPLICATION EXAMINED?

The Office conducts registration procedures on an application either with the applicant or a representative appointed by the applicant. The Office carries out examination of all industrial designs contained in the application to determine whether they meet the conditions prescribed for their registration in the industrial design register. This kind of examination is called substantive examination. Besides substantive examination, the Office examines whether the application complies with all formal requirements prescribed by law. If the application is free of formal deficiencies and its subject matter has no material defects, the industrial design is registered. The applicant is given a certificate which certifies the fact that they are the holder of a registered industrial design. At the same time the Office makes the registered industrial design available to the public (unless the applicant applied in the application for the deferment of publication) and the industrial design registration is subsequently published in its Official Bulletin.

If the application does not comply with the formal requirements prescribed by law, the Office will invite the applicant in writing to remedy these deficiencies within a fixed term. If the applicant fails to remove the defects within the fixed term, the Office will terminate the application procedure.

If the design does not meet the conditions for protection, the Office will raise an objection to its registration in writing to the applicant and give them a time limit for response. If the applicant is unable to overcome the Office's objections through evidence within the fixed term, the Office will reject the application.

## HOW LONG ARE REGISTERED INDUSTRIAL DESIGNS VALID FOR?

The protection period of a registered industrial design is 5 years from the filing date. The protection period can be repeatedly renewed upon request for an additional 5 years (up to 25 years). The registration holder shall file the request for renewal during the last year of each five-year protection period.

The request is subject to a fee. The renewal of registered industrial design protection period is solely under the owner's responsibility.

## WHAT ARE THE BASIC ADMINISTRATIVE FEES?

Single industrial design application (the application contains only one design)	1 000,- CZK
- if the applicant(s) is (are) exclusively the designer(s)	500,- CZK
Multiple application (the application contains two or more designs)	1 000,- CZK
- if the applicant(s) is (are) exclusively designer(s)	500,- CZK
Each design from the second onwards submitted in the multiple application	600,- CZK
- if the applicant(s) is (are) exclusively the designer(s)	300,- CZK
Renewal fees:	
- first renewal period	3 000,- CZK
- second renewal period	6 000,- CZK
- third renewal period	9 000,- CZK
- fourth renewal period	12 000,- CZK

If the request for renewal was not filed within the above-indicated term, it can be still filed within six months after and the fee is doubled. Nevertheless, rights of the third persons can come into being in the meantime.

It must be mentioned here that the application fee is not the only cost item connected with an industrial design registration. Expenditures for making high-quality representations (only such representations can completely define the product's general appearance and consequently the scope of the registered

industrial design protection) can cost the as much as the application fee or more. If the applicant intends to hire a professional representative for making an application and conduct further procedures before the Office, they must count on extra costs.

### HOW DOES ONE ACQUIRE A PROTECTION OF AN INDUSTRIAL DESIGN ABROAD?

The owner of a registered industrial design with the Czech Industrial Property Office has their industrial design protected only on the territory of the Czech Republic. If the owner needs to be protected on another territory, they must acquire the protection there.

National industrial property offices usually do not have any competency for the filing or mediation of filing applications abroad, such as providing services for individuals or legal entities who have either their domicile or their principal place of business or a real and effective industrial or commercial establishment on the territory of the states which have established the aforementioned national industrial property offices. This also applies to the Office. The Office may only assist such applicants by providing information such as this booklet.

The first option for an applicant with domicile in the Czech Republic to acquire an industrial design registration abroad is to ask for protection using the so-called „national way“. This means that the applicant has to file their application directly in any of the countries in the world which have established a system of industrial design protection and where the owner of a design wishes to acquire industrial design registration. The applicant must file applications for the registration at the industrial property offices in each individual country in which registration is sought. The applicant will thus acquire a set of individual territorially active registrations which are independent of each other. As concerns the material and formal application requirements and procedures relating to application filing with certain industrial property office, the rules set by the country which established the industrial property office in question apply. These rules often differ from country to country, especially with regard to the formalities of the application. In the majority of countries, a foreign applicant (from the point of view of the country in question) is obliged to be represented before the national office by a qualified representative who is authorised to undertake communication with the industrial property office in the given country. Information concerning industrial design registration abroad, the actual procedures for application filing and relevant fees, including the deadlines for the payment, can be obtained at any industrial property office and their local authorised representatives. It is also possible to use the services of members of the Czech Chamber of Patent Attorneys or the members of the Czech Bar Association who have established relations with their professional partners abroad.

The substantial conditions for the registration of industrial designs are usually similar in the individual countries. Nevertheless, they may differ in such a way that an industrial design which has been registered in the Czech Republic may not acquire registration in another country and vice versa. However, the Industrial Design Act

is harmonised with the analogous legal regulations of the EU members, at least in terms of the substantial design registration conditions.

An applicant with a domicile in the Czech Republic may also gain industrial design protection in supranational or regional areas.

One such area is Benelux. It is possible to acquire industrial design registration for all three Benelux states by filing an application at the Benelux Office for Intellectual Property (more detailed information can be found at <http://www.bbtm-bbdm.org/>).

Another option for an applicant with domicile in the Czech Republic is to gain protection for an industrial design within the territory of European countries by the instrument called a „Registered Community Design“, the protection of which applies to the entire territorial unit of the European Union. (The form of protection known as an „Unregistered Community Design“ also exists and protection by this instrument is acquired without any application or subsequent registration only by making the industrial design available to the public within the EU). Registration for Registered Community Designs is handled by the Office for the Harmonisation in the Internal Market (OHIM) in Alicante, Spain. It is possible to file for Registered Community Designs indirectly via the national industrial property offices of the member states of the European Union. This service is subject to a fee. A complete information about the Community Design is available at the OHIM website at [www.oami.eu](http://www.oami.eu). We also recommend reading information on Community designs at the Office's website. Anybody can apply for a Community design, including applicants with domicile outside the European Union.

In order to apply for a Community Design registration, applicants do not need to be represented. However, if the applicant does not have either his domicile or principal place of business or a real and effective industrial or commercial establishment on the territory of the EU they must be represented by an authorised representative in further procedures concerning the application with OHIM.

The institute of Community Design has the following specific characteristics: The Community Design system came into effect on 1 April 2003, and came into retroactive effect for the territories of the member states, which became EU members as of 1 May 2004.

If a conflict occurs among any Community design and a design registered through the national way in the Czech Republic, the older of the two rights will be decisive for the territory of the Czech Republic.

As of January 1, 2008, any person who is an EU citizen, or has a domicile, a habitual residence or a real and effective industrial or commercial establishment on the territory of the EU, may apply for international registration of industrial designs according to the Hague Agreement Concerning the International Registration of Industrial Designs.

The system is administrated by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland, and consists of three independent treaties: the London Act (1934), the Hague Act (1960) and the Geneva Act (1999).



The EU is a member of the Geneva Act, which means that the applicant entitled for filing, as defined above, may apply for the protection of their industrial designs with the Contracting Parties (states or intergovernmental organizations) of The Geneva Act of the Hague Agreement. The Hague system is merely an agreement for international procedure. Any substantial aspect of the protection is entirely a matter for the domestic legislation of each Contracting Party. The advantages of international registration lie in the savings resulting from filing a single international application in one language and in the payment of a single set of fees in one currency at one Office (International Bureau), while seeking protection in several Contracting Parties.

Detailed information on international registration of industrial designs is available on WIPO's website <http://www.wipo.int/>.

An important term when applying for the registration of industrial design abroad, is the so-called "Union priority". This institute enables claims of the right of priority derived from the first application filing date for any further applications containing identical design filed in other Convention countries or regional units. A successful claiming of such priority can only occur on condition that the further design applications are filed within 6 months from the filing date of the first application based on which the Union priority was established.

## WHERE CAN YOU GET MORE INFORMATION?

### INDUSTRIAL PROPERTY OFFICE

Employees of the Industrial Property Office are ready to answer questions connected with the industrial design protection, to provide general information on the formal requirements for applications or the circumstances of application procedures and administrative fees and public searches.

### THE OFFICE PUBLIC READING ROOM PROVIDES THE FOLLOWING SERVICES AND MORE:

- Mediation of industrial design searches in classified collections registered in Czechoslovakia and in the Czech Republic provided by specialists of the Office
- Enabling self-service searches for industrial designs in classified collections of registered designs in Czechoslovakia and in the Czech Republic based on specific instructions (free of charge)
- Searches for registered industrial design legal status,
- Searches by designer or possibly the name of the registered industrial design holder
- Providing copies of registered industrial designs from the register,
- Express copying services.

## INDUSTRIAL PROPERTY OFFICE INFORMATION CENTRE

Employees in our Information Centre will be happy to provide all necessary information connected with relevant questions on the protection of industrial designs or industrial design application procedures.

### INFORMATION CENTRE OPENING HOURS:

Monday	8.00 - 12.00	13.00 - 17.00
Tuesday	8.00 - 12.00	13.00 - 16.00
Wednesday	8.00 - 12.00	13.00 - 17.00
Thursday	8.00 - 12.00	13.00 - 16.00
Friday	8.00 - 12.00	13.00 - 14.30

### INTERNET

**<http://www.upv.cz>**

The Office website at [www.upv.cz](http://www.upv.cz) provides access to information on individual subjects such as industrial property, services and fundamental legal regulations. It also contains electronic forms which make it possible to order on-line industrial design searches. Office Journals and publications of the Industrial Property Training Institute are also available on the website.

The Office continues to develop its electronic services. It currently provides access to individual classifications from the field of industrial property rights (in PDF format), the Official Bulletin, etc. An on-line database of registered and published industrial designs is available for carrying out searches free of charge.

## **Industrial Property Office**

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### **Reading Room is open to the public:**

Monday	8.00 - 17.00
Tuesday	8.00 - 16.00
Wednesday	8.00 - 17.00
Thursday	8.00 - 16.00
Friday	8.00 - 14.30

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Thursday	8.00 - 12.00	13.00 - 16.00
Friday	8.00 - 12.00	13.00 - 14.30

### **Patent attorneys and lawyers:**

Patent attorneys and lawyers provide professional assistance on industrial property matters for individuals and legal entities. They provide professional advice and represent you before the Industrial Property Office.

Contacts:

#### **Chamber of Patent Attorneys of the Czech Republic**

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