Design is everywhere

This Bulletin issue is largely dedicated to this form of intellectual property representing an undoubted factor of competitiveness for any business.

Design is essential for the success of products: it makes them attractive and appealing, increasing their commercial value and marketability. As a consequence, protecting valuable designs should be a crucial part of the business strategy of any designer or manufacturer. Reading the first article of this Bulletin issue, you will discover how our lives are surrounded by design and the different available options to protect it in Europe.

In the following, the Office for Harmonization in the Internal Market (OHIM) introduces Designview, the largest on-line consultation tool for designs, allowing users to search for already registered designs and to analyse market tendencies and competitors activities.

Moreover, our article on design in EU-funded projects highlights new design innovation funding opportunities included in the Horizon 2020 Work Programme 2016-2017.

The next article addressing the management of intellectual property in trade fairs offers you practical tips to minimise the risk of infringement when exhibiting your product in public showcases.

In case of infringement, a valid alternative to intellectual property litigation is constituted by mediation. In his article Professor Thomas Gergen explains the advantages and risks of this dispute resolution mechanism.

This issue also provides the point of view of a Luxembourgish designer, Ms. Julie Conrad, interviewed by the European IPR Helpdesk to find out her perception of design and intellectual property.

As always we also inform you about our past training and events.

Furthermore, this issue also brings you fresh news on the Helpline service. Would you like to know which the hottest topics at the Helpline are? Which kind of questions we are receiving?

Discover also our design crossword and test your knowledge on patent searching through our usual quiz.

Wishing you inspiring reading!

Your Editorial Team
Design is everywhere...

The European IPR Helpdesk

You suddenly woke up from your wave-shaped bed and realised that -somehow in your sleep- you had snoozed your I-phone.

Double checked the time with your crossword puzzle-like wall clock (you always find it very different and in fact that is why you bought it), and noticed that you were already late. God!

Headed to your retro design bathroom faucet to wash your face, but you hit your bare foot to your son’s plastic laser sword of Anakin Skywalker in front of your bedroom door. Decided to shave very quickly with your six bladed razor. But this fuss made you cut your face a bit, got angry, tried to find a plaster, while your blood is dripping down to the mosaic design bathroom tiles. Rashly opened and closed the drawers with curved handles in a hurry, however what you only found was your daughter’s plaster, which have pretty colourful animal images on it. Run into the kitchen, grabbed a slice of bread and put it in the toaster that looks like a radio. Went to bed again, took your slim fit exclusive colour shirt (you haven’t noticed before that you cut shirt) and your tie with geometric ornaments on it, suddenly smelled the smoke of burned bread that turned totally black in the toaster. But no time left. Saw your wife’s Zara design white shirt, without your pants, you had forgotten to wear. Angry and embarrassed. Rapidly took the newspaper from your oval shaped mailbox with stripes on it, and finally saw it: God, it is Sunday!

What is the moral of the story for you? Maybe the first one would be “always listen to your wives”, but let’s talk about on another takeaway from this story: “design is everywhere...”.

What is a design?

Design is the appearance of the product, i.e. its shape, colours, patterns... and is created by the intellectual efforts of its designer. With this broad meaning, designs are applied for almost any product in our lives from electronic equipment to textiles, vehicles to logos or any device or tool.

"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"

Article 3 of the EU design regulation

Design as an intellectual property right

At the EU level the appearance of the whole or a part of a product resulting from the features can benefit from design rights protection. Design rights protection grants its owner the exclusive right to prevent the others from making, offering, putting on the market, importing, exporting or using the product in which the design is incorporated or to which it is applied, when such acts are undertaken for commercial purposes within the territory of protection.

In IP literature; design, industrial design and can be used interchangeably.

Registration is mandatory to benefit from “registered design rights” protection. However in some jurisdictions design can be protected without registration, such as in EU under so-called “Unregistered Community design”, which we detail later on.

The national EU Member States’ laws on the protection of industrial designs are substantially harmonised. In principle, in order to be protected, a design has to be new and original -presenting individual character and non-functional-.

The definitions of “novelty” and “individual character” vary in the different jurisdictions. However, an industrial design is considered to be novel, if no identical design has been made available to the public before the date of filing of the application for registration or the date of priority if claimed. Some legislations provide for a “grace period”, where public disclosure in a certain time limit (generally 6-12 months) prior to the application has no effect on novelty and individual character.

As the second requirement, a design is considered to have an individual character or original as long as the overall impression that design produces to the “informed user” differs from the known designs (regarded individually). The “informed user” is a fiction (imaginary user) and refers to a person with knowledge of designs in the applicable field of activity. In addition to above two criteria, it must also be pointed out that a design must not subsist in features of appearance of a product, which are solely dictated by its technical function. In other words, it is likely that an ordinary round shaped yellow tennis ball without any aesthetical features cannot be protected as design.
Once the design is registered, generally the registration term is for 5 years with the opportunity to extend this period for four additional times, each for 5 years, completing the whole registration period to 25 years.

**Design protection routes**

Design protection is territorial, meaning that you need to file application in each country, where you would like to have protection. For this reason, applicants must follow the exact design procedures of each country where protection is sought, and generally appoint a representative such as IP attorney in each state, unless the applicant has a citizenship, domicile or establishment there.

However, there are some regional and international registration procedures under which application formalities are reduced - single language of filing, single handling of the request and of the right and significantly lower costs.

**Registered Community Design (RCD):** The system allows the holder to have a registered design valid in all 28 members of the European Union, following up just one procedure, in a single application, in one language. The application can also be made on-line. An RCD is initially valid for 5 years from the date of filing and can be renewed in blocks of five years up to a maximum of 25 years.

It is possible to apply for more than one design in the same application (so-called “multiple application”) and benefiting from lower costs as long as they belong to the same Locarno class.

The application for RCD is examined by the Office for Harmonization in the Internal Market (OHIM) as to formal requirements without checking its novelty and individual character, as these claims can only be raised by the third parties during the invalidation proceedings after the registration.

It must be noted that the RCD is an *all-or-nothing* deal, meaning even if there is a ground for rejection or cancellation in just one country, your registration will fail in the entire EU. In such case, you may consider filing national or international applications for the remaining countries.

**Unregistered Community Design (UCD):** Alternatively, the unregistered Community design system allows the holder to have three years of protection in 28 EU countries, without registration, starting from the date of your first disclosure to public within the EU territory.

**International Registration of Industrial Designs under the Hague Agreement:** Administered by the World Intellectual Property Organization (WIPO), this system allows applicants to have a design registration in over 64 member countries/territories with one registration procedure with a single application in one language.

The cost for registration can differ in each country and is calculated according to the selected (“designated”) countries under your application.

To ease the application process and calculation of costs, WIPO offers a very useful “fee calculator” that can be used to estimate the total costs for registration in the selected countries.

WIPO does not carry out any substantive examination on novelty or originality and just checks formal requirements. However, after publication of the registration, the intellectual property offices of the designated countries might carry out substantive examination. In countries where national design law appraise such examination, design might not be registered if it does not fit the aforementioned requirements.

<table>
<thead>
<tr>
<th></th>
<th>RCD</th>
<th>UCD</th>
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<tbody>
<tr>
<td><strong>Registration</strong></td>
<td>Application for registration is needed. Depending on the number of designs, the costs are starting from 350 EUR for all 28 countries in the EU.</td>
<td>No need for registration, automatically protected after the first disclosure within the EU.</td>
</tr>
<tr>
<td><strong>Duration of protection</strong></td>
<td>Valid for 5 years from the filing date and can be renewed in blocks of five years up to a maximum of 25 years.</td>
<td>Limited for 3 years from the date on which the design was first disclosed within the EU.</td>
</tr>
<tr>
<td><strong>Scope</strong></td>
<td>Protected against similar designs even when the infringing design has been developed in good faith, i.e. without knowing of the existence of the earlier design.</td>
<td>Right to prevent commercial use of a design only if that design is an intentional copy of the protected one, made in bad faith, i.e. knowing of the existence of the earlier design.</td>
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1. The rules applicable to the different registration procedures can be found on the corresponding national IP offices’ websites or at OHIM’s website in respect to Community Registered design. As an example, China SME IPR Helpdesk’s guide on “Understanding and using China’s design patent” and Latin America IPR Helpdesk’s publication on “Designs in a nutshell” give an in-depth overview of national design protection for the respective territories.

2. Locarno Classification is the international classification system for designs. OHIM has also developed a search tool called Eurolocarno, which automatically classifies the products into the correct Locarno classes and subclasses. There is one exception for the requirement for being in the same Locarno class for multiple applications: ornaments, which are decorative elements of products, can be combined with any Locarno Class in a multiple application.
Further proceedings such as oppositions or observations are also carried out nationally and does not have any effect on other applications/registrations.

It must also be noted that the European Union may be designated for RCD under the Hague Agreement as well.

Copyright protection for designs

At European level the requirements for copyright protection of designs have not been harmonised and therefore can vary depending on the jurisdiction. Therefore the extent to which, and the conditions under which, copyright protection of designs is conferred is determined under the national legislation of each country.

Copyright usually protects artistic works, as long as they meet the criteria of creativity and originality. As a general rule, in order to be protected under copyright law a design must be the result of a personal intellectual creation and contain the imprint of its author’s personality. The level of originality required is determined under the applicable national law.

Copyright arises automatically from the moment of the work’s creation and no registration or other formality is required. In some countries cumulative protection both by Copyright and Design Law can be obtained (France, Benelux). France and Benelux countries apply the principle of “unité de l’art,” which refers to the fact that entitlement to copyright protection for applied and other art works shall be determined under the same criteria.

Just a head start

Regardless of which protection route you choose, the real outcome for a design registration is actually measured by how you enforce it. In other words, registration is just a beginning, a head start.

In most countries designs are not examined substantially with regard to novelty and originality, which means that design rights holders should monitor new registrations (official bulletins) in order to be sure that no identical or similar design are registered and used within a relevant territory. Such monitoring also provides invaluable information on competitors’ products and how the trends are evolving in a specific market.

Acting against the infringers by opposing their registrations, sending cease and desist letters, negotiations and/or taking civil or criminal court measures are effective ways for “looking after” your design rights.

5Ws FOR DESIGN REGISTRATION

| What to protect? | Aesthetic appearance of the products, which have novel and original characteristics. |
| Who can file? | Companies or individuals holding the right to apply. |
| Under RCD | Designer(s) can also be cited, although it is not mandatory. If the proprietor does not have an establishment or domicile in the EU, a representative must be appointed before the OHIM for all proceedings, except for the filing of an application. |
| Under the Hague System | Applicants must have an establishment or domicile in one of the contracting parties of the Hague Agreement. Citing of the designer(s) in the application could be mandatory, depending on the designated countries. |
| When to file? | In general, before disclosing it to public. However, depending on the applicable law, you may have 6-12 months grace period to apply for registration following to your public disclosure (e.g. 12 months for RCD). |
| Why to register? | In order to obtain exclusive rights allowing to prevent the others from making, selling or importing the articles bearing or embodying the design or copy of the design, when such acts are undertaken for commercial purposes. |
| Where to register? | OHIM for RCD, WIPO for international applications under the Hague Agreement (including RCD) or national IP offices for national applications. |

Final words

Now, lean back to your beautifully designed couch, have a coffee with your favourite Garfield design mug and see how our environment is full of different designs, which make your life colourful and livelier and always keep in mind to protect and enforce your design rights to better benefit from your creative and innovative works – and ...

Do not forget to listen to your wives!

What to protect?

Aesthetic appearance of the products, which have novel and original characteristics.

Who can file?

Companies or individuals holding the right to apply.

Under RCD: Designer(s) can also be cited, although it is not mandatory. If the proprietor does not have an establishment or domicile in the EU, a representative must be appointed before the OHIM for all proceedings, except for the filing of an application.

Under the Hague System: Applicants must have an establishment or domicile in one of the contracting parties of the Hague Agreement. Citing of the designer(s) in the application could be mandatory, depending on the designated countries.

When to file?

In general, before disclosing it to public. However, depending on the applicable law, you may have 6-12 months grace period to apply for registration following to your public disclosure (e.g. 12 months for RCD).

Why to register?

In order to obtain exclusive rights allowing to prevent the others from making, selling or importing the articles bearing or embodying the design or copy of the design, when such acts are undertaken for commercial purposes.

Where to register?

OHIM for RCD, WIPO for international applications under the Hague Agreement (including RCD) or national IP offices for national applications.
Designview - the on-line consultation tool for designs

Office for Harmonization in the Internal Market (OHIM)

**Why Designview was developed?**

As businesses develop and internationalise, they seek to protect their designs in multiple countries at national, regional or international level. Before deciding to apply for design protection, it is important to be aware of already registered designs in the countries of interest. Finding out which designs are already registered can be useful for any business, to analyse market tendencies and competitors activities.

Searches for registered designs in different countries are usually possible using on-line databases and tools provided by the respective countries’ National IP Offices. When doing this, businesses and users are confronted with different search facilities with diverse layouts and functions and available in different languages.

The Office for Harmonization in the Internal Market (OHIM) and the European National Offices represented in the European Trademark and Design Network (EUTMDN) have decided to provide a helpful solution for users by developing an all-in-one search tool for designs.

**A history of success**

For enhanced accessibility and interoperability of the diverse national search facilities and tools, OHIM started developing a design search tool called Designview in 2010. The final goal was to enable the users of the IP system to search design applications and registrations in Europe and beyond by using a single search platform.

In 2012, Designview was made available to the public with the design data from several European countries’ IP Offices, and the database has been growing exponentially since then. Due to the successful international cooperation efforts of OHIM, major non-European economies have joined the tool, making their designs available in the database. These include for example the Republic of Korea, Morocco, Mexico, Russian Federation, Tunisia, Turkey, Canada, China and USA. The most recent integrations added more than 4.2 million designs in total - some 150,000 designs from Canada, 3.3 million designs from China and almost 725,000 designs from US.

Today, Designview is the largest on-line consultation tool for designs, allowing any Internet user to search, free of charge, more than 8.8 million design applications and registrations from 41 countries’ IP Offices including OHIM – and the database keeps growing. The tool is easy-to-use and available in 31 languages, and operated through a single and unique platform available 24h/7d.

Since 2012, Designview has served about 1.41 million searches conducted by users from 141 different countries. The top three countries from which searches are conducted are Germany, Spain and the UK.

**Why using Designview?**

The implementation of Designview considerably changed the way information about the designs is accessible to users. Any person is able to perform a design search and to generate a printable and customised search report in a very simple manner. Entrepreneurs and Small and Medium-Sized Enterprises (SMEs) can use this report to analyse the market, discover what their competitors are protecting, and thus obtain valuable information about markets in different countries and regions by better exploiting their design search results.

Designview offers a variety of benefits and services, making it a powerful tool for users, including SMEs, to effectively manage their design portfolio:

- Free of charge: get instant access to more than 8.8 million design applications and registrations
- Multi-language: carry out design searches in 31 languages
- Availability: check the availability of your design 24 hours a day, 7 days a week
- Daily updated information: the participating IP offices all around the world update the information in the database daily, through a single and unique platform
- Easy to use: the tool provides you with easy access to post-registration services in a harmonised way. These services include: email alerts on name changes (when there is a change of the applicant/owner of a selected design), on status changes (when there is a change of the status of a selected design) and notifications when the expiry date of a design is coming close and eventual steps are required for renewal.
- Time and cost saving: users can check existing designs from a single common platform, instead of consulting several different platforms
- Design watch: receive an email notification when a competitor registers a new design that may be similar to your defined criteria
- Enforcement support: the tool may be used by decision-makers and enforcement authorities (such as courts and customs) to see the designs that have been registered, to inform their decisions in case of conflict between parties and anti-counterfeit actions.

Building on the success of Designview, a design search tool for Southeast Asian Nations has been launched in August 2015. The “ASEAN Designview”, makes some 100,000 design registrations from ASEAN Member States available and accessible to the public. Brunei Darussalam, Cambodia, Lao PDR, Malaysia, Philippines, Singapore, Thailand and Vietnam have already added their designs, and further countries will be added soon.

On-line consultation tools for IP are key sources of information for a competitive and robust business strategy that capitalizes on the intellectual business assets. Harmonization of the information and facilities provided across different countries brings considerable benefits to the users, as demonstrated by the success of common tools like Designview and TM View (the trade mark search tool).

**USEFUL LINKS**

- Designview
- ASEAN Designview
Funding opportunities for design innovation

At European level design innovation has been identified as key factor for competitiveness as it contributes to the implementation of new original ideas to market.

Design innovation enhances product and service development and therefore is essential for the evolution of the quality of life.

A range of opportunities to increase the awareness and ensure a distinctive European design innovation has been adopted in recent years. Some of them are focused on increasing design capabilities and encouraging the use of design within organisations, others on design investment (private and public investment in design), design research (collaborative research) and design networking. It is important to highlight that more often design is supported indirectly, usually as part of innovation funding.

Indeed, a number of funding calls dedicated to creative industries and digital technologies has been included in the Horizon 2020 Work Programme 2016-2017, thus providing for new design innovation funding opportunities.

Three programme sections under Horizon 2020 set out calls relevant to the creative and design industries:

- “Europe in a changing world - inclusive, innovative and reflective Societies” – specific calls on “Co-creation for growth and inclusion”;
- “Information and communication technologies” – specific calls on “Tools for smart digital content in the creative industries” and “Support technology transfer to the creative industries”;
- “Cross-cutting activities” – specific calls on “New technologies and life cycle management for reconfigurable and reusable customised products” and “Business models for flexible and delocalised approaches for intensified processing”.

Information on the overall objectives of the respective calls and the topic conditions within each call are available on the Horizon 2020 Participant Portal.

In increasingly competitive markets, design is seen as an important intangible value and design products and services as key tangible assets.

The EU funding create opportunities for Small and Medium-sized Enterprises, as well as to large companies and research institutions to grow through design innovation.

Manage and deliver design innovation in collaboration is a complex process that involve among others intellectual property considerations with international dimension. This is particularly relevant for collaborative design research, where the projects outcomes are developed on the basis of the knowledge and IP (e.g. design rights) brought by a number of partners having different commercial or research interests. Having a clear and sound IP management strategy is thus essential for successful collaborative design innovation especially in the context of EU funded projects.

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1 The Horizon 2020 Work Programme 2016-2017 is available on the Participant Portal under the Reference Documents section.
Intellectual property at trade fairs in Europe

The European IPR Helpdesk

Trade fairs, trade shows and exhibitions are valuable ways of introducing or displaying your products and/or services. They are also an opportunity to analyse market tendencies and competitors’ products: nowhere else a company can compare its own products with those of its competitors as easily as at exhibitions. Therefore, it is not surprising that, time and again, exhibitors find out imitations of their products during these events. As a consequence, important Intellectual Property (IP) issues need to be considered before attending such an event in order to:

- minimise the risk of your IPR being infringed;
- avoid infringing third parties’ IPR;
- effectively react if you experience infringement.

Before attending a trade fair

i) Identify the intellectual property rights you own

Before participating in a trade fair, it is essential to be aware of the intellectual property rights you own to take effective measures against possible counterfeiters.

ii) Protect your rights

Intellectual property rights are territorial: they are effective only in the country or region where protection is granted. Therefore, once you have identified your rights on a certain product, it is recommended that you protect your rights in the country where the fair is held, in order to prevent any infringing conducts.

The protection of the intellectual property is generally granted through registration at the competent Intellectual Property Office (IPO). As for design products, some legislations provide also a form of protection that does not need registration. For example, at European Union level, you can rely on the Unregistered Community Design (UCD), granting a protection for three years from the first disclosure: Once protection is granted, it is important to inform that your products/services are protected by intellectual property rights: this can be done by a simple notice underlining that your products/services are protected and their unauthorised use is not allowed.

In particular, when taking part to a trade fair, you can:

- rely on priority rights: a disclosure at a fair exhibition during the priority period does not destroy the novelty of your invention or design.
- obtain an exhibition priority certificate: this certificate is a proof that a trade mark or design described therein was presented at the exhibition, allowing the exhibitor (under certain conditions) to file an application claiming the priority date of the product disclosure at the exhibition.
- exhibit your design product during the grace period: during this period, earlier disclosures of products are not prejudicial, provided that an application is filed within a fixed time limit from the disclosure.
- exhibit your invention at official exhibitions.

iii) Avoid prejudicial disclosure

Protecting your rights before attending a trade fair is important to avoid prejudicial disclosure. Indeed, novelty is a requirement both for inventions and designs protection and any prior disclosure could impede it. Generally, products displayed at trade fairs are brand new and their market success at an early stage of development is still uncertain. In some cases, assessing the commercial potentials of a product before incurring IP registration costs is likely to be more reasonable. In this regard, under certain circumstances the exhibition of new products/services at a trade fair is not considered prejudicial for IP protection.

Examples of intellectual property notices

- **Patents**: the terms “patent pending” or “patent applied for” can be used for the product once patent application has been filed;
- **Trade marks**: the symbol ® is commonly applied to products/services protected by trade mark;
- **Design**: the design registration number can be attached to the product or packaging;
- **Copyright**: © [name of copyright owner], [year of creation].

1. It is not the case of copyright arising from the moment of the work’s creation so that no registration or other formality is required.
2. For further information read our article “Design is everywhere”.
3. While relying on the UCD, within one year from the first disclosure, you will be able to file an application to obtain a Registered Community Design (RCD) granting protection up to 25 years from the filing date.
4. If you have already filed a trade mark, a design or a patent application in one country, within a fixed period (priority period), you can extend its protection to other countries with the advantage that the subsequent applications will be regarded as filed on the same date as the first application.
5. This certificate is available only if you expose in an official international exhibitions. For a list of the officially recognised international exhibitions visit: Bureau International des Expositions at http://www.bie-paris.org/site/en/
6. Please consider that the exhibition priority certificate is generally not recognised for patents by European IPOs.
7. Grace period allows the public disclosure of a design without affecting the validity of a subsequent registration, provided that a complete application is filed within 12 months from the disclosure. Grace period for patents is provided in the USA, Canada, Japan and Australia but not in the EU, with the exception of Estonia and Romania.
8. Grace period for Community Registered design is one year from the first disclosure.
If you plan to take part to a trade fair without a prior IP registration, it is strongly recommended that you consult an experienced IP attorney who can assist you with the assessment of the risks surrounding disclosures of new products/services in such events.

iv) Consider third parties’ intellectual property rights

While preparing your participation as an exhibitor, it is important not only carefully protect your intellectual property rights, but also to avoid infringing intellectual property rights of others. PerformingFreedom-to-Operate (FTO) searches is therefore recommended before the trade fair if you plan or you are already commercialising the exhibited product.

v) Get ready to react

As trade fairs are being held only for a short period of time, often even at weekends, it is crucial for exhibitors to get ready to react immediately in order to effectively face possible infringement.

Recommendations for exhibitors in trade fairs

✔ Protect your IP
✔ Avoid prejudicial disclosure
✔ Consider third parties’ intellectual property rights

In case you experience infringement:
✔ Review carefully the terms and conditions of the exhibition stand contract
✔ Contact a local attorney and file an application at the local custom authorities
✔ Collect evidences during the fairs
✔ Ask assistance from the trade fair organiser or from a local attorney
✔ With the assistance of an attorney, take proper steps after the trade fair using the evidence collected

In most countries, trade fair organisers cannot take any action to withdraw infringing products from their exhibitions without either a court order or a contractual provision in their stand contracts with exhibitors. Furthermore, the measures available at trade fairs are not harmonised in Europe.

For this purpose, it is advisable to:

- review carefully the terms and conditions of the exhibition stand contract to check if the trade fair organiser can take action to withdraw infringing products and if it offers any legal assistance;
- contact a local attorney, providing him with a power of attorney and other proof of IP ownership so that legal actions can be taken swiftly;
- file an application at local customs, if you believe that another exhibitor is infringing your rights; custom authorities have the power to prevent the entry of infringing goods into a certain country;
- provide a proof of IP ownership (titles, certificates).

During the event

Be proactive

If it occurs that another exhibitor is infringing your intellectual property rights (IPR), the concrete action to take will depend on several factors, including the IP enforcement rules of the country, where the event is being held. Nevertheless, these events are always excellent opportunities to collect evidence of suspected infringing goods.

As a consequence, it is advisable to:

- check out exhibitors: if you see an exhibitor you suspect of violating your IPR, try to obtain a sample and/or brochure along with his contact information;
- if available, seek for legal assistance offered by the trade fair organisers. In lack of any valuable assistance provided, ask advice to a local attorney who will be able to suggest an appropriate action to take.

After the trade fair

If you need to enforce your IPR and no action has been taken during the trade fair, the evidence gathered should be analysed and passed on to your legal advisor, who will help you to take the necessary measures against the identified infringers.

Acting promptly is generally important to avoid that counterfeit products enter the large commercialisation stage.

Exhibiting outside Europe?

If you plan to attend a trade fair outside Europe, have a look at the following resources made available by the other IPR Helpdesks.

Latin America IPR SME Helpdesk
- Factsheet on “IP at Trade Fairs in Brazil”.
- On-line learning module on “IP key aspects in Trade Fairs in Brazil for EU SMEs”

South-East Asia IPR SME Helpdesk
- Guide on “Protecting your IP at Trade Fairs in Southeast Asia”

China IPR SME Helpdesk
- Handbook on IP Strategies for EU SMEs at trade fairs in China

For a list of the officially recognised international exhibitions visit: Bureau International des Expositions at http://www.bie-paris.org/site/en/. For information on Freedom-to-Operate searches please consult our fact sheet on “How to search for patent information” and “Intellectual property relevance in internationalisation” available in our library. In some countries, trade fairs organisers provide a list of experienced local attorneys. In order to benefit from custom protection you should be the owner of a registered IP right in the relevant territory. For further information on IP custom protection see “EU IP customs action: a cost-effective weapon against counterfeiting”, European IPR Helpdesk Bulletin N° 17, April - July 2015, available in our library.
Mediation of IP Disputes

Prof. Thomas Gergen
eufom European University for Economics & Management, Luxembourg

What is mediation?

The Mediation Directive (Art. 3a) defines mediation as a structured process whereby two or more parties to a dispute attempt, on a voluntary basis, to reach an agreement on the settlement of their dispute with the assistance of a mediator.

Mediation in the field of intellectual property

There is no doubt that mediation is in many ways more effective than the classic litigation. This difference goes beyond just the confidential character of proceedings. Let us have a closer look on mediation of intellectual property disputes, i.e. disputes regarding industrial property and copyright and related rights. The idea is to show what opportunities mediation brings in comparison with classic conflict resolution mechanisms in the case of patent, utility model, design, trade mark, employee inventions or copyright related disputes. At the same time, potential risks of choosing mediation should be exposed and specified.

Pro mediatione – mediation in business practice

Supporting mediation is the fact that multiple lawsuits can be confidentially dealt with in one single proceeding. Mediation in its classic variant of Alternative Dispute Resolution (ADR) shall thus be considered as more cost effective than a conventional lawsuit. Furthermore, the prevalent use of internet makes the Online Dispute Resolution (ODR) especially attractive for stakeholders to the dispute. A wisely implemented mediation may bring positive effects inasmuch as the parties agree that no extensive information shall be requested and that already existing and valuable illegal goods shall not be destroyed, as in case of a classic destruction claim. A request for financial compensation for the unauthorised use of a trade mark, or even an agreement on market segmentation, can be good examples of reasonable solutions in such cases.

Moreover, mediation offers significant opportunities and possible advantages when compared to classic litigation. It can be usually concluded faster, with lower cost and it leads to mutual satisfactory results. Parties choose a mediator by themselves; they have full control of the procedures and the mediation outcome. The mediation process can have a confidential character and is especially convenient for settlement of long-lasting, cross-border and complex conflicts. In addition, it helps avoid incalculable litigation risks, it has a high success rate, and consequently, it leads to a high level of satisfaction of the involved parties.

Risks and adverse effects

Occasionally, it might happen that the mediation mechanism is misused by one party for the purpose as a sort of “delaying” tactic. Furthermore, mediation has a limited field of application – it can only be chosen with respect to comparable subject-matter. It has, for example, no application to precedents. It should not be used with the purpose of reaching convictions with strong public outreach effects nor in order to obtain interim relief either. Further risks of mediation are associated with the fact that its results do not always correspond to the party’s original expectations.

Conclusion: Mediation – more flexibility, more options

Mediation leaves room for manoeuvre. While choosing this form of dispute resolution, the innovation potential of a company can be effectively used. It triggers an increased commercial creativity, and consequently, a new quality in business relations which can be developed in a sustainable manner and with an eye to the future. In mediation parties do not risk their reputation in case of failure as it may happen in case of court judgments. The latter creates, furthermore, a winner-looser relation between the parties which practically excludes the opportunity to cooperate in the future.

If mediation parties find a solution to all the relevant conflicting matters on their own under the guidance of one or more mediators, mediation brings cost advantages, it is time-saving, it takes account of the autonomy and independence of the involved parties, and it gives an opportunity to permanently settle a dispute with the opportunity to continue business partnership.

Mediation works well not only in a cross-border environment but it also plays an important role in national legal disputes. In cross-border disputes which, due to their nature, require a complex translation process, a mediator is additionally expected to play the role of translator.

Useful resources


Thomas Gergen is Professor at the eufom University in Luxembourg and a Board Member of EIKV (European Institute for Knowledge and Value Management, Luxembourg).

1 Kihn, P./Ladebeur, O./David, B./Bill, J.-Ph.: La propriété intellectuelle au Luxembourg, Luxembourg 2012, p. 16-60 with a comprehensive overview of the subject matter
“For me as a designer the dilemma is: do I need to register my creations or largely communicate them to the public.”

Julie Conrad is a visionary Luxembourgish product designer. We met her on a cold October morning in her design studio, where culture, art and creativity trigger inspiring designs. The following lines are a summary of our open discussion with Ms. Conrad and show how a young independent designer perceives intellectual property.

What do you associate with the term Intellectual Property (IP)?
The term Intellectual Property has a positive connotation. Seen from my perspective as a designer it is associated with protection of ideas resulting in creations.

Do you think that design creations need to be protected by Intellectual Property Rights (IPR)?
Yes, in principle, I do think that it is important to consider IPR protection. What is difficult to determine is whether a design creation is protectable and needs to be protected via IPR. For me as a designer the dilemma is: do I need to register my creations or largely communicate them to the public. For example, when I have created my room divider, I had such concerns. Finally, I decided to apply for registered design. However, not all designs deserve to be protected in the same way – a chair is a chair. It can be a very nice or clever chair, though, and be protected for that added value. So instead of thinking of it as an “invention”, which it usually isn’t, it is the aesthetics, function or production method that makes it stand out and makes people easily associate it with its original author. Such association creates by itself guarantee for designers.

Thinking about “communication” to public, the Internet is most probably one of the most efficient ways to make people know about your creations. Do you think that the Internet might also have some negative consequences particularly on the IPR protection of designs?
In the Internet era we have the impression that designers’ creations are easily accessible for everyone and therefore vulnerable to copying. On the other hand, giving a lot of exposure to your designs (on the Internet and in publications, exhibitions...) to make people associate the design with your name can be a protection as well. Since designers are following styles and trends, similitudes between designs can appear. For this reason I would say that although my designs are formally protected I sometimes have the impression of not being really protected. It clearly is a double edged sword.

You mean that it is more difficult to enforce your rights?
Yes, as I mentioned there are no guarantees that a design protected by registered design or by copyright will not be copied. Entering into procedures against infringers could be complicated and often expensive. For this reason I prefer, in addition to registering them, to make my designs accessible to public. It is more beneficial showing them and being recognisable as their author.

You have mentioned copyright. Do you think that designers know enough about copyright protection?
I have met some designers that did not know copyright well and were unaware that copyright applies to logos for example, and generally to design objects. I’m often creating logos for third parties and copyright guarantees that my logos are protected. But, you need to know how copyright works or how you can use it to protect your work. That’s why I think that it is needed to raise awareness in this field.

You have followed some IPR lessons during your studies in Paris and acquired some knowledge on IP. Do you think that designers need to be trained on IPR?
The most relevant thinks to know are not so complicated, once you have understood how IPR work. Workshops and discussions can be very valuable to make designers aware of the IPR protection strategies and more generally knowing how to use IPR. For example, the i-depot (or the Soleau Envelope) solutions are not commonly known by designers mostly while they’re still at university and I know how important it could be to have evidence of authorship in case of disputes. Even a person that is not a specialist can submit a Soleau Envelope, I used it for some of my creations. I also think that experiences are important. Indeed, facing real situations is learning about IPR. I can give as an example the grace period which applies for designs. I was aware that in my case I have 12 months for filing an application for registration of an industrial Community design after its disclosure. I almost missed the delay and filed at the last moment, but I learned from the experience.

The grace period is a specificity of design and patent law. Could it be considered as an advantage for designers for instance?
I think that having such a period is very useful for independent designers like me. It offers time to decide whether a design has the chance to be successful on the market and gather funds needed for registration.

Do you think that it is necessary to consult an IPR lawyer before taking decisions on the protection of your creations?
Yes, it is important to get personalised support in order to have clear and coherent ideas on what needs to be protected and how. Although I found that registering a Community Design, for instance, could be relatively simple I have preferred being advised. Moreover, in situation of disputes it is always better to have a professional support. Indeed, this gives you the further assurance.
Your IPR queries matter to us: Ask the Helpline

The European IPR Helpdesk Helpline answers your questions concerning intellectual property (IP) within three working days. You get practical, first-line support directly from our IP experts, and free-of-charge.

If you are curious about the type of IP queries that the Helpline has recently been dealing with, these are shown in this illustration.

If you would like to talk to one of the IP experts of our helpline, please dial +352 - 25 22 33 – 333

www.iprhelpdesk.eu/helpline

Frequently Asked Questions received at the Helpline

I have created drawings that I plan to exhibit at art galleries and use to participate in competitions, and maybe one day sell them. What can I do to protect my works?

Your drawings could be protected by copyright. Copyright gives the author the right to publish, reproduce his/her work and grant permission to third parties to use its work for the said purposes. Work means any result of the creative activity of an author which shows originality.

In theory, to qualify for a copyright protection your drawings must exist in a physical form, be original and be the result of at least some creative efforts. Copyright protection extends only to physical expressions (in your case: drawings as such), but not to ideas or methods behind them. Copyright protection arises automatically as soon as the work is created and no registration formalities need to be taken.

Copyright confers on you a right to prevent copying, unauthorised distribution, communication to the public etc. However, copyright does not prevent the publication or reproduction of similar drawings where the substantial part of the work has not been copied. Whether a substantial part has been copied or not will is assessed on a case by case bases by the competent jurisdiction.

Does a parent company have access rights to background and results as an affiliate company, considering that the latter is a partner in a H2020 project?

According to article 2.1(2) and in conjunction with the article 8.2 of the Rules for Participation, an affiliated entity means any legal entity that is:

- under the direct or indirect control of a participant, or
- under the same direct or indirect control as the participant, or
- directly or indirectly controlling a participant.

Pursuant to this definition, a parent company should be considered as an affiliated company and enjoy access rights to both background and results if this is needed to exploit the results generated by the beneficiaries to which they are affiliated. It is to be noticed that this approach is significantly different from the one in FP7 projects (Article II.1.2 of the model Grant Agreement), according to which a parent company was not considered as an affiliated entity.
The European IPR Helpdesk on tour: Take a look at a selection of our recent events

The world is turning and during the last 3 months the European IPR Helpdesk Team had the chance to be part of several IP events which were organised in various places all over Europe offering wide-ranging thematic orientations. In addition the training team provided several IP workshops building capacities in IP management among SMEs and researchers. Here a bunch of our recent events:

Upcoming IP training events
• 30 November 2015, Brussels / Belgium @ Horizon 2020: Exploitation and valorisation of project results, workshop by NCP and EEN Brussels
• 30 November 2015, Brussels / Belgium Horizon 2020: Research and Innovation Seminar 2015, in cooperation with Swiss Core

Upcoming webinars
• 2 December 2015: Impact and Innovation in H2020
• 16 December 2015: Maximizing the impact in H2020 projects

The schedule for the first half of 2016 is already online available.

Fancy a little quiz?

As you know in every issue we include a quiz to help you develop your patent searching skills using Espacenet. Why don’t you try using Espacenet today? Here comes our new quiz:

QUIZ

Back to the future

In the 1989 film Back to the Future II, the protagonist travelled to the date of October 21 2015 and discovers all sorts of new technologies like hoverboards, dog-walking drones and self lacing Nike shoes.

Those shoes became reality as can be seen here.

Try finding patents covering such self lacing shoes using Espacenet.
The System for the International Registration of Industrial Designs is administered by _____.

2. _____ Community designs grant the right to prevent commercial use of a design only if that design is an intentional copy of the protected one.

3. All the designs in one application must belong to the same _____ class.

6. The _____ System for the International Registration of Industrial Designs provides a practical business solution for registration of designs in over 64 territories.

7. The protection term for unregistered Community design starts from the date of first _____ within the EU territory.

10. Funding _____ dedicated to design innovation have been included in the Horizon 2020 Work Programme 2016-2017.

11. _____ allows the parties to reach an amicable settlement in appeal proceedings in order to resolve the disputes out of the court.

12. There is one exception for the requirement for being in the same class for multiple design applications: _____.

Across

4. The exhibition _____ certificate is a proof that a design described therein was presented at the exhibition.

5. The _____ period for Community designs is one year from the first disclosure.

8. RCDs and UCDs are quite different in terms of scope of protection and _____.

9. The unregistered Community design system allows the holder to have a _____ years of protection.

13. _____ is the largest on-line consultation tool for designs allowing users to search millions of designs from more than 40 IP offices.

14. The two main requirements for registration of the designs are _____ and individual character.

Down

1. The System for the International Registration of Industrial Designs is administered by _____.

2. _____ Community designs grant the right to prevent commercial use of a design only if that design is an intentional copy of the protected one.

3. All the designs in one application must belong to the same _____ class.

6. The _____ System for the International Registration of Industrial Designs provides a practical business solution for registration of designs in over 64 territories.

7. The protection term for unregistered Community design starts from the date of first _____ within the EU territory.

10. Funding _____ dedicated to design innovation have been included in the Horizon 2020 Work Programme 2016-2017.

11. _____ allows the parties to reach an amicable settlement in appeal proceedings in order to resolve the disputes out of the court.

12. There is one exception for the requirement for being in the same class for multiple design applications: _____.

DESIGN CROSSWORD
Riding the wave of desalination

With the permanent expansion of world population, the need for new sources of potable water has been long recognised. These needs have led to the development of devices for extracting fresh water from the ocean. One way is to combine the availability of wave energy with the proximity of seawater and have desalination systems that are powered by wave energy and that do not require an external power supply.

Try finding patents covering wave powered seawater desalination systems using Espacenet.
Step one: To find similar patents, identify the most pertinent aspects of the invention – common technical features that may be found in related patents – and for each aspect, define a comprehensive set of synonyms. To perform the search, the following concepts – groups of synonyms covering the different aspects of the invention – can be defined:

- desalinat*
- wave*

In this case, the concepts to combine are rather straightforward as there are not many synonyms for those concepts to consider.

The very basic combination desalin* wave* yields this list of patents that contains many relevant documents as the ones listed below:

<table>
<thead>
<tr>
<th>Patent Name</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>WO2013049590 (A1)</td>
<td>Wave-Powered Desalination System</td>
</tr>
<tr>
<td>US2011006005 (A1)</td>
<td>Desalination System and Method</td>
</tr>
<tr>
<td>US2010229545 (A1)</td>
<td>Energy Extraction Method and Apparatus</td>
</tr>
<tr>
<td>US5186822 (A)</td>
<td>Wave powered desalination apparatus with turbine-driven pressurization</td>
</tr>
</tbody>
</table>

Quite clearly there are many patents covering this type of desalination systems. This field is heavily patented.

Step two: To continue the search you can use relevant classification symbols assigned to this relevant patent and combine them with properly chosen keywords to cover the concepts that should be present in relevant patents.

Amongst the classification symbols assigned to the relevant found patent, one covers sea energy producing systems Y02E10/30.

Combining Y02E10/30 with desalination results in a good list of documents many of them relating to the invention we were looking for:

<table>
<thead>
<tr>
<th>Patent Name</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>US2011006005 (A1)</td>
<td>Desalination System and Method</td>
</tr>
<tr>
<td>US2010229545 (A1)</td>
<td>Energy Extraction Method and Apparatus</td>
</tr>
</tbody>
</table>

To continue the search, one can combine other classification symbols relating to the process used to desalinate seawater like osmosis or distillation and combine them with wave or tidal energy producing systems. This can be done using the right classification symbols or keywords.

It is interesting to note that many Chinese applicants have filed patents in this field. This is often the case for the green energy fields.

One obvious way to know that the field is heavily patented is to do a simple internet search combining desalination and wave. The many relevant hits illustrate the commonness of such systems and their great diversity. Inventive minds have no difficulty understanding why using sea energy to desalinate seawater is an obvious and advantageous process.
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