

Protection by French Design Law

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In France, a design or a model may be protected by Copyright and Design Law.

A. What is protected ?

Design Law protects the appearance of whole or part of industrial or commercial products. Products are functional goods with esthetic shape.

Are not protectable ideas or styles which are not materialized or products exclusively esthetic. Furthermore, software are expressly excluded from the protection by Design Law.

To be protected a design has to be "new" and have an "individual character". When the design does not fulfill these requirements, it still may be protected by Copyright.

a) Novelty

A design is new when no prior identical design exists already.

➤ Prior art

Prior art can be found everywhere at any time.

Designs are deemed to be identical when their features differ only in immaterial details. When the design can be distinguished from the prior art, it meets the novelty requirement.

A combination of unprotected elements may still be protected by Design Law. In this case, the combination only is protected as a whole.

➤ Disclosure of the prior art

▪ Prior art barring novelty

A design lacks of novelty when it can be found in a single prior art.

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Furthermore, the prior art shall be disclosed prior to the filing date of the design application or before the claimed priority date.

A design is deemed to have been disclosed when it has been made available to the public by any publication, use or other means.

However, the design is not deemed to have been disclosed when professional trading into the European Community could not reasonably know the design according to the common business practice in the field concerned.

- Prior art not barring novelty

Some designs or models previously disclosed are not considered barring the protection:

- A disclosure due to a breach of a confidential agreement,
- A disclosure occurred during the 12 months period preceding the filing date if the disclosure is due to a fraud on the inventor or if the disclosure is due to the creator himself or someone else from information given by the designer.

Thus the designer has 12 months to assess the commercial potential of the design before filing a design application.

b) Individual character

The design has to have an "individual character"

A design lacks of individual character if the overall impression it produces on the informed user differ from the overall impression produced on such a user by any design which has been made available to the public prior to the filing date of the design application or the claimed priority date.

As for the novelty requirement, several prior designs can not be combined to assess the "individual character" of a design. However, a previous design merely similar may bar the right in the design concerned. Pursuant to Design Law also, when assessing the "individual character" it is taken into account that the degree of freedom of the designer is limited in so far as the device has to fulfill its functions.

c) Designs excluded from protection

The following designs are not protected even though they may fulfill the "novelty" and "own character" requirements:

- Designs contrary to public policy or morality,
- Features of appearance of a product which are solely dictated by its technical functions (the protection by Patents Law may be sought for these products),
- Designs of interconnection under specific conditions.

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B. How to obtain protection for a design in France?

a) Filing in the "Institut National de la Propriété Industrielle" (INPI)

The designer has to file a design application in the "Institut National de la Propriété Industrielle" (INPI). An unique application can cover several designs. However all of the designs have to be included in the same "class" of designs. The classes of designs are defined in the "Classification of Locarno".

The basis filing fee is 38 Euros. An additional fee of 22 Euros is due for each reproduction in black or white and 45 Euros for each reproduction in color*. These reproductions define the scope of the protection. The elements which are not shown on the reproductions won't be protected.

b) Review of the application by the "Institut National de la Propriété Industrielle" (INPI)

The design application is mainly checked for formalities.

The "Institut National de la Propriété Industrielle" (INPI) does not review the "novelty" and "own character" requirements. Furthermore a third party cannot file an opposition with the "Institut National de la Propriété Industrielle" (INPI) to prevent the registration of a design.

However a registered design can be declared unenforceable by a court when:

- the "novelty" and "own character" requirements are not fulfilled,
- the applicant is not the designer,
- the design infringes the rights in a prior design enforceable in France, filed or registered before and published after the filing date or the priority date of the design concerned,
- the design infringes a prior copyright or includes a prior protected mark not having the consent of the owner.

C. What are the design rights?

The applicant is presumed to be the owner of the rights in the design.

a) Term of protection

The protection duration is 5 years with 5 years renewal terms up to a maximum of 25 years.

b) Conferred rights

The owner of the rights in the design has an exclusive right to use it and to prevent any third party not having his consent from using it. The use covers in particular the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or on which it is applied, or stocking such a product.

There are some limitations to the rights in the design, including:

- Use of the design privately or for non commercial purposes,
- Use for experimental purposes,
- Reproductions for making citations or for educational purposes provided that such reproductions are

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compatible with faire trade practice and do not unduly prejudice to the normal exploitation of the design , and that mentions are made of the registration and the name of the designer.

c) Transfer of ownership of the design

The owner of the design can assign his rights in the design. He can also grant license agreements concerning his design.

A transfer concerning a registered design does not need to be recorded in the "Institut National de la Propriété Industrielle" (INPI) to be valid between the parties. However the recordation is required to make the transfer public and to sue anybody infringing the rights conveyed.

d) Infringement

Any person infringing the rights of the owner in the design may be sued in front of a criminal or a civil court.

However, the applicant has to wait the registration of the design to bring an action based on his design and he can only pursue the infringements committed after the publication of the design, except if he can proof that the plaintiff was aware of the registration before it publication.

In any case, infringement committed before the filing date cannot be pursued by the owner of the design based upon the Design Law. However such infringement may be pursued based on Copyright Law. The protection by Copyright Law and Design Law can both be claimed before the judge for the protection of a design.

Protection in a foreign country

A. Why to extend the protection abroad?

a) Territoriality

The design is enforceable only within the country in which it was registered.

The owner of a design protected in France cannot prevent a person from registering or using such design in other country. Furthermore, if a person registers the same design in a foreign country, the first owner can no more commercialize his design in this foreign country without infringing the rights of the owner of the design in this foreign country.

For this reason a design application has to be filed in all the countries on which a protection is sought.

b) Priority date

The owner of a design in a contracting party of the Paris Convention for the Protection of Industrial property or the World Trade Organization can extend the protection of the design in a contracting party, within 6 months from the first filing date, claiming the priority of the date of the first filing (the "priority date").

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During 6 months from the priority date, the same design cannot be registered by someone else than the recipient of the priority date.

The extension under priority date can be a national application, a Community Design application or an International Design application.

B. How to extend the protection in a foreign country?

1. Filing a national design application

A design application may be filed in each country in which the protection is sought.

The applicant has to conform to Design Law of each country.

For example, a design is protected by Patent Law in the United-States. Some countries don't provide a design with protection under Copyright and Design Law concurrently.

2. Filing a Community Design

A Community Design application may be filed either directly in the Office of the Harmonization for the Internal Market (OHMI) in Spain or in a national office.

A Community Design covers all the countries of the European Union and the scope of the protection can not be limited to certain countries of the European Union. The Community Design is either valid or invalid in the European Union as a whole.

There are two different Community Designs: a registered Community Design and an unregistered Community Design.

➤ Unregistered Community Design

An unregistered Community Design is protected for a period of 3 years from the date on which the design was first made available to the public within the territory of the European Community.

The unregistered Community Design has to meet the same requirements than the registered Community Design to be protected.

The owner of the right in an unregistered Community Design has an exclusive right to use the design in all the countries of the European Community and can prevent a third party from copying.

If the owner wants a protection for the design up to 3 years, a Community Design application has to be filed within 12 months from the date on which the design was made available to the public. After 12 months from its disclosure, the design lacks of "novelty".

The unregistered Community Design is an inexpensive protection and appropriate for fashion and textile industries dealing with a lot of designs which are commercialized during a short period of time.

➤ Registered Community Design

The owner of a registered Community Design has the exclusive right to use the design and prevent any third

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party from using it anywhere on the territory of the European Union. The rights in the design include the making, offering, marketing, importing, exporting or use of a product in which the design is incorporated or to which it is applied, or holding stock of such a product.

The registered Community Design is protected first for 5 years from the filing date and can be renewed in periods of 5 years up to the maximal of 25 years.

The fees are 350 Euros* and include registration and publication fees. The fees vary according to the number of designs included in the application.

The designer can market a design during 12 months before filing a design application. After 12 months, the design lacks of novelty and can no more be registered.

3. Filing an International Design application

The Hague Agreement is an international registration system which offers the possibility of obtaining protection for industrial designs in number of states or intergovernmental organizations (contracting parties) by means of a single international application filed with the International Bureau of the World Intellectual Property Organization (WIPO) located in Geneva, Switzerland.

It is possible to designate the European Community in **an international application for an industrial design.**

The applicant has to be a national of a contracting party, or have a domicile or a real and effective industrial or commercial establishment in the territory of a contracting party.

An international registration produces the same effects in each of the designated countries as if the design had been registered there directly unless protection is refused by the competent Office of that country.

The basic fee is 397 Swiss Francs* for one design. A fee of 17 Swiss Francs is due for each additional design included in the same international application. The publication fees are 17 Swiss francs for each reproduction and 150 Swiss Francs for each page, in addition to the first, in which the reproductions are shown. Supplemental fees are required for the designation of the countries on which the protection is sought.*

**The fees as indicated are the fees in force on April 1, 2009. The fees may not include additional fees related to the registration of the design and the fees for the renewal of the design. The fees don't include the fees of a patent agent or patent attorney also.*

***Fees in Swiss Francs may vary according to the exchange rate. On May 2009: 150 Swiss francs are around 100 Euros.*

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