



European Communities Trade Mark Association

**MARQUES's seminar
"Brand Owner's Guide to Community Design"**

Reported by Béatrice Thomas, Member of the ECTA Design Committee, FR

On 19 January 2010, MARQUES held an evening seminar entitled "*Brand Owners Guide to Community Designs*" in Paris, France. The seminar was hosted by Simmons & Simmons.

After welcoming words by Simmons & Simmons lawyers, David Stone, Counselor of MARQUES and Chairman of its Designs Team and Alexandre Regniault, the floor was given to three speakers.

The first speaker Laurent Venetz, Global Counterfeit Counsel and Nestlé Legal/Brand IP Counsel, talked about *The design protection of the brand & marketing properties*.

He started by explaining the "brand properties" and "marketing properties" which cannot be protected by trade marks but for which protection is required due to frequent look-alike products adopted by third parties. A diagram explained Nestlé's interests in designs over the years. He then explained the object of the design protection in view of Nestlé's or third parties' labels, logos, packaging etc.

Laurent Venetz insisted on the advantages of the design protection in comparison with trade marks as follows: (1) absence of the rule of specialty and thus the possibility of licensing in other fields than Nestlé's ones, (2) no obligation of use, which gives time for the implementation of projects, (3) rapidity for obtaining design registrations (about 4 months), (4) presumption of validity of the title. He recognized afterwards the weakness of the title due to very few legal cases.

According to Laurent Venetz the following best practices should be adopted: (1) specifying a strict geographical area of design protection taking into account that two dimensional designs cannot be protected in certain countries (2) preserving the novelty of the design (3) maintaining the priority rights in particular due to difficulties for obtaining "apostille" or public notary certification of International designs (3) obtaining proofs of the assignment rights (4) filing the best representations of the design .

In conclusion, Laurent Venetz insisted on a "cost effective" design strategy in view of a product project distinct from a corporate project.

The second speaker, Grégoire Bisson, Head, International Designs Registry, WIPO, made a presentation on the Hague System.

He presented the Hague System and its advantages in view of national design protections. He moved on to the Hague system and the Community Designs systems which are complementary. He also referred to the recent development and future perspective of the Hague System. Finally, he strongly advised to use the Hague system for obtaining protection of Community designs.



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For those who could not attend the MARQUES seminar, it is worth mentioning that Grégoire Bisson will present the advantages of the Hague System at ECTA's Annual Conference on 16 June 2010 in Barcelona.

The third speaker, Sarah Bailey, lawyer at Simmons & Simmons, lectured about the emerging design law cases.

A recall of the sources of the ECJ's decisions, the judgments of Community Design Courts and OHIM's decisions concerning Community Designs was performed. See:

- www.oami.europa.eu/ows/rw/pages/RCD/caselaw/decisionsoffice
- www.oami.europa.eu/ows/rw/pages/RCD/caselaw/judgmentsRCDCourts

Finally, the key notions of the validity and counterfeit criteria were studied in view of the Council Regulation (EC) n° 6/2002 of 12 December 2001 on Community Designs and OHIM's decisions or judicial decisions and reference to the following cases was made:

- On article 6: (Individual character): see R887/72008-3;
- On article 5.2: (novelty): see R1276/2008-3;
- On article 7: (disclosure): see ICD3010;
- On article 6.2: (the degree of freedom of the designer): see R316/2008-3;
- On article 8.1: (designs dictated by their technical function excluded from protection): see R 690/2007-3.