



General Information Concerning

THE REGISTRATION OF INDUSTRIAL DESIGNS



OIFIG NA bPAITINNÍ
IRISH PATENTS OFFICE



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Introduction

The information available in this booklet is not intended to be fully comprehensive. It is a general guide and not a legal interpretation of the law relating to Industrial Designs.

It summarises certain important provisions and requirements of the Industrial Designs Act, 2001 and the Industrial Designs Regulations 2002 with regard to the registration of Industrial Designs. It also includes information about the Community Design system. It does not analyse every aspect of the process of registering a design or address particular legal provisions, which may affect a particular application. As with all guides it, of necessity includes a number of generalisations and simplifications and should not be regarded as a substitute for the legislation itself.

The Patents Office cannot undertake to prepare an application to register a Design on behalf of the applicant.

Copies of the Acts, Rules and Regulations may be accessed on www.patentsoffice.ie or purchased directly from the Government Publications Postal Trade Service. Their Call Centre is open Monday to Friday 09.30 to 13.00 and 14.00 to 17.00 to assist callers and accept order payments. There is also a dedicated email address, with all queries responded to on the next working day.

Tel: 01-6476834 or email: publications@opw.ie

Some information may have changed since publication

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1. What is an Industrial Design?

Section 2 of the Industrial Designs Act, 2001 defines “design” as meaning the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colour, shape, texture or materials of the product itself or its ornamentation. “Product” is defined as any industrial or handicraft item, including parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographical typefaces, but not including computer programs.

In everyday language, an industrial design generally refers to a product’s overall form and function. An armchair is said to have a “good industrial design” when it is comfortable to sit in and we like the way it looks. For businesses, designing a product generally implies developing the product’s functional and aesthetic features taking into consideration issues such as the product’s marketability, the costs of manufacturing or the ease of transport, storage, repair and disposal.

From an intellectual property law perspective, however, an industrial design refers only to the ornamental or aesthetic aspects of a product. In other words, it refers only to the appearance of an armchair. Although the design of a product may have technical or functional features, industrial design, as a category of intellectual property law, refers only to the aesthetic nature of a finished product, and is distinct from any technical or functional aspects.

Industrial design is relevant to a wide variety of products of industry, fashion and handicrafts from technical and medical instruments to watches, jewelry, and other luxury items; from household products, toys, furniture and electrical appliances to cars and architectural structures; from textile designs to sports equipment. Industrial design is also important in relation to packaging, containers and the “get-up” of products.

The following are examples of some registered designs:

		
Mobile telephone handset Registration No.20433 NOKIA CORPORATION	A bottle Registration No.20797, PEPSICO, INC	Golf Iron Head, Registration No.20511 KARSTEN MANUFACTURING CORPORATION
		
A wristwatch, Registration No.20448 MONTBLANC-SIMPLO GmbH	Character holding a shield Registration No.20109, Paul Martin	Shoes, footwear soles Registration No.20565, TOD'S S.p.A.

2. Why protect designs?

An industrial design can add value to a product. It can make a product attractive and appealing to customers, and it may even be its unique selling point. So protecting valuable designs should be a crucial part of the business strategy of any designer or manufacturer.

- By protecting an industrial design through its registration the owner obtains the exclusive right to prevent its unauthorized copying or imitation by others. This makes business sense as it improves the competitiveness of a business and often brings in additional revenue in one or more of the following ways:
- By registering a design you are able to prevent it from being copied and imitated by competitors, and thereby strengthen your competitive position.
- Registering a valuable design contributes to obtaining a fair return on investment profits.

Industrial designs are business assets that can increase the commercial value of a company and its products. The more successful a design, the higher is its value to the company.

- A registered design may also be licensed (or sold) to others for a fee. By licensing it, you may be able to enter markets that you are otherwise unable to serve.
- Registration of industrial designs encourages fair competition and honest trade practices, which, in turn, promote the production of a diverse range of aesthetically attractive products.



3. What can be registered as an industrial design?

Section 11 of the Act provides that a design that is new and has individual character is registrable under the Act.

The design must be “new”. A design is considered to be new if no identical design has been made available to the public before the date of filing of the application for registration or, where priority is claimed, the date of priority. The Patents Office does not carry out a novelty check on design applications and the onus is placed on the applicant to establish the novelty of the design which is the subject of the application for registration.

The design must have “individual character”. This requirement is met if the overall impression produced by a design on an informed user differs from the overall impression produced on such a user by any earlier design that has been made available to the public.

4. What cannot be registered as an industrial design?

Designs that are prohibited from registration include the following:

- Designs that do not meet the requirements of novelty and individual character (as explained above in paragraph 3).
- The features of appearance of a product which are solely dictated by its technical function.
- Designs that are in conflict with a prior design.
- If the applicant for registration of the design is not the proprietor of the design.

The Controller may refuse an application for the registration of a design as follows:

- Designs incorporating protected official symbols or emblems (such as the harp).
- Designs that are considered to be contrary to public order or morality.
- Where the design constitutes an infringement of a copyright work under the Copyright and Related Rights Act, 2000.

5. How do you obtain protection for industrial designs?

Design protection is territorial; in effect a design registered in Ireland is only valid in Ireland. To register an industrial design you must file an application with the Patents Office.

If you wish to register an industrial design in the European Community then the application may be filed directly with the European Union Intellectual Property Office (EUIPO) or it may be filed with the Patents Office for transmission to EUIPO on payment of a transmittal fee. For protection abroad, see paragraph 16.

In the European Union, legislation has made it possible to obtain limited industrial design protection for unregistered designs for three years from the date on which the design has been published in the European Union.

The unregistered design provides companies with the opportunity to test market their products before going through the effort and expense of registering all designs, many of which may not succeed in the marketplace. In addition, some designs may remain on the market for a very short time, especially in the fashion industry. For such products, the unregistered design provides a good alternative. However, once the design enters the public domain, designers have up to 12 months in which to register it. The protection provided to an unregistered design is limited, in that it is more difficult to enforce than for a registered design, and shorter, as it lasts for three years as opposed to the 25 years provided to registered designs in the European Union.

While this information booklet focuses mainly on registered industrial designs, it is important to point out that, there may be alternative ways of protecting industrial designs:

- One such alternative for protecting designs is copyright law. Copyright generally provides exclusive rights for literary and artistic works. As some designs may, be considered works of art or applied art, copyright protection may apply and may represent an attractive option for Proprietors.
- In addition, if an industrial design functions as a trade mark in the marketplace, then it may be possible to protect it as a three-dimensional mark. This may be the case when the shape of the product or its packaging is considered to be distinctive.

If you wish to protect your industrial design under a registration system, keeping the design confidential is absolutely crucial. The reason for this is that the central requirement for design protection is generally, that the design must be “new”. If you show your design to others it is advisable to have confidentiality clauses in written agreements, clarifying that the design is confidential.

A design that has already been disclosed to the public by, for example, advertising it in your company’s catalogue or brochure may no longer be considered “new”. It becomes part of the public domain and cannot be protected, unless the application for design registration is filed within 12 months of the design being made available to the public or the priority of an earlier application can be claimed.



6. Who may apply to register an industrial design?

The applicant for the registration of the design must be the proprietor i.e. owner of the design. The author (person who creates the design) is regarded as the proprietor of the design unless the design is created by an employee in the course of employment, in which case the employer is the proprietor of the design, subject to any agreement to the contrary.

7. How to apply for registration of an industrial design

A person claiming to be the proprietor of a registrable design(s) may apply to register their design(s). The application should be made online via the Patents Office website www.patentsoffice.ie. This e-filing facility introduces an easy to navigate application form and facilitates the electronic payment of the design registration fee by credit or debit card. Alternatively, application forms may be downloaded from the site.

Under the legislation, it is possible to apply for up to 100 designs in a design application. This is known as a Multiple Application. This is subject to the condition that the products in which or to which it is intended to apply the designs, all belong to the same class of the Locarno system of International Classification, except in cases of ornamentation.

In addition to the basic application fee, a multiple application is subject to payment of the additional application fee per design. These costs are significantly less than the cost of filing a separate application for each design.

Where the multiple application contains a request for deferment of publication, the additional fee for deferment of publication applies in respect of each design that is subject to the request.

Each of the designs contained in a multiple application should be numbered consecutively by the applicant using Arabic numerals inserted on the back or reverse side of the representations of the designs filed. Where more than one representation of a particular design is submitted, each of the representations of that design should be assigned the same identification numeral.

Minimum requirements for a filing date.

It is possible to secure a filing date without a fully completed application form for registration of a design, so long as each of the following is submitted:

- *A request to register a design*
- *Representation/s of the design/s*
- *The Name & address of applicant*
- *The prescribed fee*

An application made in this manner will have to be followed by a formally completed application form.

Representations

Any number of representations (illustrations, line drawings, photograph etc) may be submitted but must be suitable for reproduction.

Where more than one view is submitted, each one must be on a separate page and identified as perspective view, front view, side view, etc.



Views of designs with a repeating pattern should be such as to show the complete pattern and include enough of the repeat to fully illustrate the entire design.

Representation must not be less than 9cm x 12 cm or greater than 18cm x 24cm in size and these should be on an A4 page.

In the case of multiple applications the design identification numeral must be written on the back of each representation.



8. Classification of Designs

The Locarno Agreement concerning the International Classification of products for the purposes of the registration of designs is an international agreement under the aegis of the World Intellectual Property Organization.

Its purpose as the name suggests, is to provide an internationally recognised classification system of products in respect of which designs may be registered. Ireland is a member of the Nice Union of countries and applies this classification system to the registration of Designs.

Under the Locarno Classification, products are categorised in classes each of which relate to a particular field of related products, consequently it is possible to search designs databases using products as the search criteria. The classification system is regularly updated to take account of changes and advances in commercial practices. This classification system can be access via the Patents Office website www.patentsoffice.ie. You should consult this classification prior to completing your application to register your design.

9. Priority

A right to priority for a period of 6 months may be claimed by an applicant who has already applied for registration of the same design in a country party to the Paris Convention. The filing date of the earlier application becomes the priority date of the new application. The rights of such applicants take precedence over other applications filed during the priority period in respect of the same design.

Where an application to the Patents Office claims priority, the “priority document” i.e. a certified copy of the original application as filed in the original country must be received not later than 3 months from the date of application. This certified copy should be obtained from the office where this earlier application was made.

Similarly, applicants may claim priority in other states based on an earlier Irish application and in such cases applicants can obtain for this purpose a certified copy of the Irish design application from the Patents Office on payment of the prescribed fee.

10. The application process

The process of registration of an industrial design generally takes 3 – 4 months or longer, depending on a number of issues, such as whether any objections are raised or clarification is required by the design examiner.

For a multiple application all of the designs in that multiple application are allocated application numbers, each one corresponding to one of the designs contained in the multiple application. Similarly, each of the designs is allocated a separate registration number upon registration.

The application is then checked by an examiner to determine that the formal requirements are complied with. If an examiner has a query or requests clarification, the applicant will be contacted and will be given time in which to respond. It should be noted that an examiner does not carry out a novelty check on design applications and the onus is on the applicant to establish the novelty of the design prior to making the application for registration to the Patents Office.

When the application is accepted and in order for registration it is then registered and a certificate of registration is issued to the proprietor. The registration of the design is published in the Patents Office Journal (published fortnightly) although this will not happen immediately upon registration if there has been a request for deferment of publication and the period of deferment is still running. The notice published in the Journal includes a representation of the design; if more than one representation of the design is filed, the representation published is usually the first in the series filed, unless the Applicant has requested otherwise.

Publication of a design may be deferred at the request of the applicant for a period of up to 30 months from the filing date, or where priority is claimed, for a period of up to 30 months from the date of priority on payment of the prescribed fees.

Upon the expiry of the period of deferment, or at any earlier date on request by the registered proprietor, the Register shall be open to public inspection in respect of that design and the registration of the design will be published.

The Patents Office Journal is available free online at www.patentsoffice.ie or copies may be purchased from the Patents Office.



11. How long does industrial design protection last?

When a design is registered, protection is granted initially for 5 years. Protection can then be renewed for four further periods of five years each (on payment of the prescribed fee), giving a maximum of 25 years protection from the date of registration.

12. The Register of Designs

The Patents Office maintains a register for all designs registered under the Industrial and Commercial Property (Protection) Act 1927.

This is a paper based register.

The Industrial and Commercial Property (Protection) Acts, 1927 to 1958 continues to apply to registered designs and applications for registration of a design that were pending on 1/7/2002 (other than pending applications where conversion had been requested) when the new legislation came into effect.

The life of a design registered under the 1927 legislation remains a maximum of 15 years from the date of registration.

A person inspecting the 1927 Act register must furnish either a registration number or sufficient information to enable the design to be identified. As this is a paper register, the Register can only be inspected in our office in Kilkenny. It can only be done in the presence of a member of staff and on payment of the appropriate fee. In practice, designs that are registered for less than two years (except textile piece goods, which is five years) are not open to inspection except by the proprietor or a person authorised in writing by him, a person authorised by the Controller or by the Court. The person inspecting the register cannot make copies.

Where the statutory period has expired, the design is open to public inspection by any person, on payment of the appropriate fee and copies may be made of the registered design.

The Patents Office also maintains a register for all designs registered under the Industrial Designs Act, 2001.

This is an electronic register.

This register may be viewed online at www.patentsoffice.ie and is also open to inspection in the Patents Office Information Centre in Kilkenny. Copies of entries in the register can be obtained, on payment of the prescribed fee.

The following information is available:

- The registration number;
- The name, address and nationality of the registered proprietor;
- The address for service;
- The description of the design;
- The product or products to or in which the design is to be applied or incorporated and the class or classes thereof, including sub-classes;
- The date of registration;
- The date of publication of the registration. Where deferment of publication is requested, the date of publication shall only be entered on the Register upon such publication;
- The priority date (where any) claimed, the name of the state, country, territory or area and the filing number;
- Any disclaimer or limitation subject to which the design is registered;
- Where the first proprietor is not the author of the design, the name of the author;
- The representation or representations of the design;

13. Design searches

The Register established under the 2001 Legislation is in electronic format and contains details of all published designs and can be searched free of charge online at www.patentsoffice.ie. In addition to viewing the design register it is possible to carry out a search of the designs database.

In relation to a design registered under the 1927 legislation, a search can be made of the paper register in the Office to ascertain whether or not a Registered Design is still in effect. Applications for a search should provide sufficient information, in writing, to enable the design to be identified. This may be done by submitting the following:

- The name of the design,
- A representation of the design and
- The class, if known,
- The prescribed fee of €15.00



The applicant for the search is informed if the design, the subject of the search, is still registered, the classes of goods for which the design is registered, the date of registration and the name and address of the registered proprietor.

Searching Registered Community Designs (RCD)

It is possible to carry out a search online of the registered community design database (Design View) maintained by the European Union Intellectual Property Office (Trademarks and Designs) at <http://tmdn.org/tmdsview-web/welcome>

14. Statutory Design fees

The fee for an application to register a single design is €70.00.

In the case of a multiple design application, the fees payable are the basic registration fee (€70) plus the additional fee of €25 for **each design** included in the multiple application for registration e.g. a multiple application consisting of 10 designs, the amount is €70.00 plus €25.00 x 10. Total = €320.00.

Deferment of publication of the design registration may be requested and is subject to payment of the following fee:

- For a period of up to 30 months	€35
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In order to keep a registered design in force it must be renewed on the fifth anniversary of the registration date and every five years after that, up to a maximum of 25 years. The fee for the renewal of a design for:

- A second period of 5 years	€50
- A third period of 5 years	€70
- A fourth period of 5 years	€80
- A fifth period of 5 years	€100

There are various other fees for matters such as requests to amend an application and requests to record transactions such as assignments and licenses etc.

A copy of the schedule of fees relating to designs is available online at

www.patentoffice.ie or on request from the Patents Office.

Payment

The following methods of payment will be accepted.

- Online - this option should be used for all fees relating to national Designs registered under the Industrial Design Act 2001. You can pay by Debit or Credit card on www.patentsoffice.ie
- By telephone - our office is open Monday to Friday 9.30am to 5pm
- EFT - Please see www.patentsoffice.ie

If you choose to use the services of a registered patent agent or registered trade mark agent to file your application, there will also be costs associated with the hiring of the services of the agent.

15. Agents – Patent and Trade Mark agents

Design law, procedural rules and the operation of time limits can be complicated. Proprietors of designs may find the assistance of an intellectual property professional beneficial when filing an application for design registration or generally advising in relation to intellectual property rights. A registered patent agent or a registered trade mark agent may represent their clients in dealing with the Patents Office in relation to design registration.

Where an agent is appointed by an applicant, all enquiries should be directed to that agent and all official communications from the Patents Office are with the appointed agent.

A list of registered patent agents and a list of registered trade mark agents are available on the Patents Office website (www.patentsoffice.ie) or on application from the Patents Office.

16. Protection Abroad

If you intend to export products bearing an original design, or intend to license the manufacture, sale or export of such products to companies in other countries, you should consider protecting your designs in such countries in order to enjoy the same benefits of protection abroad. You may seek protection by applying separately to the national Industrial Property offices of each country in which you wish to obtain protection. The process can be rather cumbersome and expensive as translation into the national languages is generally required as well as payment of administrative (and sometimes legal) fees. The Patents Office website www.patentsoffice.ie provides links to many of these countries websites.



The Registered Community Design

European Union Intellectual Property Office
(Trade Marks & Designs)
Avenida de Europa 4
E-03080 Alicante, Spain



A useful possibility for proprietors wishing to obtain design protection in Europe is the Registered Community Design (RCD). This is a single design registration valid in all the countries of the European Union.

Holders of Registered Community Designs have exclusive rights to use the design concerned and to prevent any third party from using it anywhere within the European Union.

The Registered Community Design

- Gives the exclusive right to use the design in commerce and take legal action against infringers and to claim damages,
- Serves as a deterrent against infringement,
- Is a rapidly obtained right with few formalities,
- Is a right valid throughout the EU market,
- Is a protection that allows you to :
 - forbid unauthorized production of your design in all the EU countries;
 - stop imports into the EU at all possible entry points..

What criteria must a design meet to be eligible for protection as a Registered Community Design?

To be eligible for protection, designs must be new and must have an individual character. In other words it must be apparent to the public that they are different from products which existed previously.

How to apply

An applicant for a Registered Community Design (RCD) may apply directly to the Office for European Union Intellectual Property Office (EUIPO). Community Designs may be applied for on-line using [e filing](#). Please note that the EUIPO is not able to accept Community Design forms via email.

Applications can also be submitted by post to:

European Union Intellectual Property Office
(Trade Marks & Designs)
Receiving Unit
Avenida de Europa 4
E-03080 Alicante, Spain

Alternatively the application may be forwarded via the Irish Patents Office together with a handling fee of €25. If an application for a RCD is made via the Irish Patents Office, the Office will acknowledge receipt of the application and immediately forward it to EUIPO. Its filing date will be the date of receipt at this Office. With the exception of the handling fee, all other fees including the filing fee must be paid directly to the EUIPO.

The application form may be obtained from the EUIPO (Information Section telephone 00 34 96 51 39 100. An electronic version in *PDF format* is available from the EUIPO Website <http://euipo.europa.eu/>

Registration

Applications are mainly checked for formalities. There is no in-depth substantive examination, except to verify that the application is for a design and that the design is not contrary to public policy or morality. If an application meets the requirements for registration the design will be registered.

The RCD Register is a database containing particulars of all designs registered and published by the EUIPO. The Register is constantly updated, to take into account any change, such as a transfer of ownership, a change of name or address, the granting of a licence. The Register may be consulted online via the EUIPO website.

The Cost of the RCD

The EUIPO fee is in two parts.

The registration fee is: -	€230 for a single application (one design) or the first design of a multiple design application ;
	An additional €115 for each extra design up to 10; and
	An additional €50 for each extra design above 10.
The publication fee is:	€120 for a single application (one design) or the first design of a multiple design application;
	An additional €60 for each extra design up to 10; and
	An additional €30 for each extra design above 10.

You can ask EUIPO to delay or 'defer' publication by paying the following fees instead of the publication fee, but the deferment fee must be paid on application.

- €40 for one design;
- An additional €20 for each extra design up to 10; and
- An additional €10 for each extra design above 10.



The publication fee will still be payable when the design registration is published.

The registration fee and publication fee must be paid at the same time, together with the filing of the application. Where the application includes a request for deferment, the deferment fee will replace the publication fee. At the end of the requested deferment period (which may be shortened if earlier publication is requested by the holder), the publication fee must be paid for the design, or for those designs in a multiple application which the holder wishes to be published.

Registered Community Designs are protected for a period of five years. They can be renewed four times giving a maximum life of 25 years of protection. **Renewals** will cost €90 for a first renewal up to € 180 for a maximum fourth renewal.

Payment

You must pay when you apply. All fees with the exception of the Irish Patents Office transmittal fee must be paid straight to EUIPO

You can pay EUIPO:

- by cheque;
- straight from an EUIPO current account; or
- by bank transfer to either of the following accounts.

Bank	Banco Bilbao Vizcaya Argentaria	La Caixa
Address	Rambla Mendez Nuñez, 42 – 1ª planta E-03002 Alicante SPAIN	Calle Capitán Segarra,6, E-03004 Alicante SPAIN
Account number	0182-5596-90-0092222222	2100-2353-01-0700000888
BIC code *	BBVAESMMXXX	CAIXESBBXXX
IBAN	ES88 0182 5596 9000 9222 2222	ES03 2100 2353 0107 0000 0888
Bank charges **	>OUR	>OUR

* Some computer programmes do not accept the last three digits XXX of the BIC code. Should this be the case, users must indicate BBVAESMM or CAIXESBB.

** It is important to make the transfer indicating OUR as the method of payment for the bank charges in order to allow full reception of the amount.

Comprehensive details relating to the Community Design Registration System, including application forms and notes regarding completion of same, fees and methods of payment may be obtained from the EUIPO website <http://euipo.europa.eu/ohimportal/en/fees-and-payments>

Representation before EUIPO

You can file your application yourself. However, you may find it useful to employ a professional representative to act on your behalf in prosecuting your design application and to deal with the sometimes complex procedural arrangements. Only legal practitioners, qualified in one of the member states of the EU and professional representatives entered on the lists kept by EUIPO can act as representatives in matters before EUIPO. Entry on the list of professional representatives is restricted to people qualified to act before national industrial property offices. A list of Irish registered patent agents and a list of registered trade mark agents are available on the Patents Office website (www.patentsoffice.ie) or on application from the Patents Office.

Other useful websites:	
European Union Intellectual Property Office	www.euipo.europa.eu
World Intellectual Property Organisation	www.wipo.org
Intellectual property issues from a business perspective	www.wipo.int/sme

The Patents Office may be contacted at:

Patents Office
Government Buildings
Hebron Road
Kilkenny

Tel: 056 – 7720111
Lo-call: 1890-220223 (within Ireland)
Fax: 056 – 7720100
Lo-call fax: 1890-220120 (within Ireland)

E- mail: patlib@patentsoffice.ie

Patents Office website: www.patentsoffice.ie



**The Patents Office is open to the Public from
9.30 am to 5.00 pm including lunchtime.**