

# PATTERNS AND DESIGN PROTECTION SYSTEMS IN ROMANIAN LAW

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## Abstract

*Because of the significant differences among the laws of member states in the field of design and patterns, by Council Directive No. 98/71/EC of 13 October 1998 on the legal protection of patterns and designs, the European Parliament has implemented a patterns and design protection system adapted to the needs of any domestic market. Based on Directive No. 98/71/EC, the Council Regulation (EU) No. 6/2002 of 12 December 2001 on community designs and patterns has been issued, being compulsory in all its elements and applying directly to all member states. Thus, a special legal protection has been provided, which is meant to encourage individual creators to bring forward innovation, the development of new products and investments in their manufacturing. In order to implement the provisions of Regulation (EU) No. 6/2002, the Commission Regulation (EU) No. 2245/2002 of 21 October 2002 has been adopted. All these regulations are intended to provide protection of designs and patterns, and for this purpose two forms of protection are deemed necessary, i.e. a long-term one, corresponding to unregistered designs or patterns, and a short-term one, corresponding to registered designs and patterns.*

*In this paper we shall present in detail these forms of protection, as well as the substantive and formal conditions necessary to be fulfilled for the registration of designs and patterns. The presentation shall be founded on the legal regulations mentioned above that are enforceable and binding also on the Romanian territory, a legal protection of design and patterns being thus provided not only inland but also intra-community. The purpose of this paper is to also highlight the necessity of design and patterns protection, a sine-qua-non condition for the development of new products and investments.*

**Keywords:** *design and patterns legal protection, innovation, formal conditions, unregistered design or patterns, registered design and patterns*

## Introduction

The field covered by the theme of the proposed study pertains to intellectual property law, specifically protection matters (in the case at hand, design and patterns protection).

The importance of this study and its objectives results from the contemplated aims hereof, *i.e.* the identification of the design and patterns protection system applicable to Roman law, as regulated by Directive No. 98/71/EC, and subsequently by Commission Regulation (EC) No. 6/2002 of 12 December 2001 (enforced based on Commission Regulation No. 2245/2002 of 21 October 2002) on community industrial design and patterns, which is mandatory in its entirety and applies directly to all member states of the European Union.

The manner in which this study envisages to identify such matters consists in the presentation of all forms of protection, namely, a short-term one corresponding to unregistered design and patterns, and a long-term one corresponding to registered design and patterns, of the conditions related to both content and form that must be met in view of registering patterns and designs, as well as of the stages that must be gone through, or any other relevant procedures.

The research is essential for gaining significant knowledge of the applicability of international regulations in this respect, *i.e.* Directive No. 98/71/EC and Council Regulation (EC) No. 6/2002 of 12 December 2001, which represent the foundation of the field of design and patterns protection, applicable also to community law, as well as for the identification in principle of existing protection systems and their application (effects) at community level. Since all previous studies on this theme

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are quite technical, this review is aimed to be, besides technical, novel (paying attention to matters such as domestic implementation and applicability), mentioning that, at such internal level there are several studies/publications/books on the same subject matter, any references thereto being made both in footnotes, and the body of this paper.

### Content

As domestic doctrine states “the intellectual property cannot be constrained easily to territorial boundaries, as it naturally has a much rather international scope. Products of the human spirit and genius defy any barrier placed before their free circulation, and modern information and communication media favor such movement. (...) Products of the human spirit must also be protected outside the national borders of the territory where their author resides, when being utilized, according to their intended purpose, in the territory of other states (...)”<sup>1</sup>.

As regards the notions of design and pattern, it is worth mentioning that, globally, two concepts are being used in this field, with one and the same meaning, respectively: English-speaking “common law” countries use the term “design”, while French-speaking countries use the notions “design or pattern”, case applicable also to community Roman law.

Because of the significant differences between the laws of member states in the field of design and patterns, by Council Directive No. 98/71/EC of 13 October 1998 on the legal protection of patterns and design, the European Parliament has implemented a patterns and design protection system adapted to the needs of any domestic market. Based on said directive, the Council Regulation (EU) No. 6/2002 of 12 December 2001 on community designs and patterns has been issued, being compulsory in its entirety and applying directly to all member states (community Roman law inclusively).

Ensuring the protection of designs and patterns can be done in two ways, namely a short-term protection corresponding to unregistered design and patterns, and a long-term protection for registered design and patterns.

The two Regulations contain the necessary provisions for the development of the procedure for registration of a community design or pattern, the administration of registered community design and patterns, the proceedings for challenging the decision of the Office, and the procedure for cancelling a community design or pattern, such provisions having to be known since they are the foundation of the registration process relating to any community design and pattern.

The Directive mentions that the community design or pattern should meet, inasmuch as possible, the needs of all Community economic sectors<sup>2</sup>.

Some of these sectors produce huge quantities of designs or patterns of products that oftentimes have a brief economic life cycle, their protection thus becoming necessary and efficient, yet without undergoing each and every registration stage, or, on the contrary, there are economic sectors where registration is advantageous and which require protection of their designs or patterns for longer periods of time, according to their foreseeable life duration on the market.

At the same time, it is deemed that, in order to be considered valid, a community design or pattern should be new and individual – differentiating itself from other designs or patterns<sup>3</sup>. By new it is thus understood that no other identical design or pattern should have been made public before the date of submitting the registration request, in the country and abroad, for the same category of

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<sup>1</sup> Viorel Roș, Dragoș Bogdan, and Octavia Spineanu Matei, *Copyright and Other Related Rights Treatise (Dreptul de autor și drepturile conexe Tratat)*, (Bucharest: All Beck Publishing House, 2005), 24.

<sup>2</sup> Council Regulation (EC) No. 6/2002 of 12 December 2001, item 15 “*The community design or pattern should meet, inasmuch as possible, the needs of all Community economic sectors.*”

<sup>3</sup> Council Regulation (EC) No. 6/2002 of 12 December 2001, item 19 “*In order to be considered valid, a community design or pattern should be new and individual, differentiating itself from other designs or patterns.*”

products; as regards designs and patterns, identity refers to the fact that their essential features differ only in terms of insignificant details.

Thus, it is considered that the individual character of the design or pattern results from the effects it has on the user, respectively if such effect is different from the one any other previously publicized design or pattern has had on the same user, that is, before the submission of the registration application.

In this case it is deemed that two forms of protection are necessary, *i.e.* a short-term one corresponding to *unregistered design or patterns*, and a long-term protection related to *registered design or patterns*.

According to the Regulation, the designs and patterns meeting the aforementioned conditions are called “community designs and patterns”, as follows:

A community design or pattern is protected:

a) as an “*unregistered design or pattern*”, if it is made public as per the procedures provided for in the regulation. One may conclude that the protection of an unregistered community design or pattern is automatically acquired further to disclosing to the public the products that incorporate the respective designs or patterns, by means of publishing, exhibiting, marketing, making public by any other means of advertising, in order to be made widely known in the activity media from the sector concerned, on condition that the disclosure is carried out within the territory of the European Union. If the disclosure is performed outside the above-mentioned territory, no protection can be enjoyed.

b) as a “*registered design or pattern*”, if registered as per the procedures provided for in the regulation.

Also, the regulation defines the main relevant terms:

– “*design or pattern*”: the external aspect of a product or a part thereof, resulting from the combination of its main features, especially lines, contours, colors, shapes, textures and/or materials and/or the decorations of the product itself;

– “*product*”: any industrial or crafted product, including, *inter alia*, pieces designed to be assembled into a more complex product, packaging, presentation, graphical symbols and typographical fonts, excluding computer software;

– “*complex products*”: a product made up of several replaceable pieces that allow disassembly and reassembly of such product.

Situated “at the crossroads between art and industry”<sup>4</sup>, designs and patterns are known both in Romanian law and in the law of other countries, as “applied art” or “decorative creations”<sup>5</sup>, the protection being possibly given for all the products included in the Locarno Classification.

Apart from the aforementioned clarifications, the Regulation identifies in detail all procedures and stages that must be undergone so as that a community design or pattern that is subjected to intellectual property rights may benefit from protection; it also comprises information on how to draft the application, the format conditions needed for the registration of designs and patterns, the capacity of the person submitting the application, how the application is submitted, priority rights, application examination, certificate issuance, payment of certain charges, and the duration of the granted protection.

The Regulation sets forth both the items that can be registered and protected as community designs and patterns, and the ones that cannot be registered and protected as community designs and patterns, as follows:

– a community design or patterns does not give rights over the aspectual features of a product, which are imposed exclusively by the product’s technical functionality;

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<sup>4</sup> Y. Eminescu, *The Protection of Industrial Designs and Patterns*, (Bucharest: Lumina Lex Publishing House, 1993).

<sup>5</sup> J. Schmidt – Szalewski, *Droit de la propriete industrielle*, (Paris: Dalloz, 1997).

– a community design or pattern does not give rights over the aspectual features of a product, which must be mandatorily reproduced in their exact form and dimensions so as that the product in which they are integrated, or which the design or pattern is applied to, can be mechanically connected to another product, or so as that it can be placed inside or around another product, or put in contact with another product, in such a way that allows each of them to achieve their own functionality;

– by derogation from the provisions of para. (2) above, a community design or pattern gives rights over another design or pattern that observes the conditions established in the Regulation at Art. 5 and 6, and which aim at allowing the multiple assembly or connection of certain interchangeable products within a modular system.

- a community design or pattern does not confer any rights at all if that particular design or pattern infringes public order or good morals principles (and, during the process of national registration of a design or pattern, consideration should be given to the fact that the concepts of “public order” and “good morals” may differ from one member state to another); it is possible at times to identify cases in which a design or pattern registered with a national office from one member state be denied in another country on account that it infringes public order or good morals principles.

The rights on community designs or patterns are set forth in Art. 14 of the Regulation, which stipulates that “the right on a community design or pattern belongs to their author or their successors in rights”<sup>6</sup>; furthermore, it is stated that, if several persons have created a design or pattern together, the rights on such community design or pattern are jointly held by all of them; also, the rights on the so-called “professional” designs or patterns, if they have been conceived by employees of a company at the express request of their employers, belong to the latter, save for the cases regulated under any other contrary provisions governing such matters as set forth in conventions concluded between employers and employees, or in the text of the relevant national legislation in force.

The importance of registering patterns and designs resides in the fact that, further to registration, the titleholders will have the right to use such intellectual property items and to prohibit any third party from using the same, without their express consent in relation thereto, being also able to set forth the conditions of such use (pecuniary inclusively, as the case may be). Unregistered community designs or patterns do not give their titleholders the right to prohibit the performance of any activities in relation thereto unless the challenged use thereof results from copying such protected designs or patterns.

*De facto*, practice showed that all products, especially the ones with a particular design or pattern and with a greater commercial success, are actually being counterfeited, which causes immense financial troubles and losses to the entitled owners, and confuses consumers, who can thus purchase products of a quality that is inferior to the original products they think they are actually buying, and who pay the same price for the fake products as they would for the originals. The registration of designs and patterns is thus a guarantee given to the holder of such registration certificate, whereby he/she can prohibit third parties, without his/her consent, to reproduce, manufacture, market, offer for sale, or use the design or pattern of the product within which they are incorporated, throughout the European Union.

“Titleholders may choose among the various manners of national and international protection, and the designs or patterns registered and administered by The Office of Harmonization for the Internal Market (OHIM), which, starting from 2003, are available, and which can cover all 27 member states of the European Union in one application<sup>7</sup>.”

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<sup>6</sup> Council Regulation (EC) No. 6/2002 of 12 December 2001, Art. 14 “*the right on a community design or pattern belongs to their author or their successor in rights*”.

<sup>7</sup> Constantin Duvac, and Ciprian Raul Romitan, *The Legal and Penal Protection of Designs and Patterns (Protecția juridico – penală a desenelor și modelelor)*, (Bucharest: Universul Juridic Publishing House, 2009), 103.

The Regulation stipulates that the contested use is not considered to result from the copying of the protected designs or patterns if it originates in the independent creative work of an author who can affirm, in a grounded manner, that he/she had no knowledge whatsoever about the existence of the design or pattern disclosed by the titleholder.

This study now continues to discuss the Regulation provisions regarding the rights transmitted to the titleholder, the limitation of such rights, the duration of the granted protection, as well as the termination of such rights.

#### **Rights conferred to the titleholder**

The rights conferred to the titleholder are different function of whether the design or pattern is registered or not, as follows:

*Registered community designs or patterns* give their titleholders the exclusive right to use them and to prohibit any third party from using them without the agreement of the titleholder. By use it is understood, in the sense of the Regulation, especially the manufacturing, inclusion in an offer, marketing, export or the use as such of a product in which the concerned design or pattern has been integrated or applied to, as well as the storage of the respective product in order to be used for the purposes mentioned above.

*Unregistered community designs or patterns* do not give their titleholders the right to prohibit the activities specified at para. (1), unless the contested use results from the copying of the protected design or pattern.

The Regulation mentions, in Art. 19, that the contested use is not deemed as resulting from the copying of the protected design or pattern if it originates in the independent creative work of an author who can affirm, in a grounded manner, that he/she was not cognizant of the design or pattern disclosed by the titleholder.

#### **Limitation of rights**

Art. 20 of the Regulation specifies the cases in which the rights conferred by a community design or pattern cannot be enforced, as follows:

- activities developed for private non-commercial purposes;
- activities developed for experimental purposes;
- activities related to multiplication for didactical or bibliographical purposes, provided that such activities are compatible with fair trade practices, do not infringe the normal use of the design or pattern concerned, and also indicate the source.

Moreover, the rights conferred by a community design or pattern cannot be enforced in the case of:

- the equipment used onboard ships or aircrafts registered in a third party country and which temporarily cross Community territory;
- the imports in the Community of parts and accessories dismantled from vehicles in view of being used for the repair of the same vehicles;
- the performance of repairs onto such vehicles.

Also, Art. 23 of the Regulation mentions one more situation in which the right of the titleholder cannot be enforced: when the community design or pattern is used by the government of a member state for security and defense purposes.

#### **Protection Duration**

The duration of the protection is different for registered and unregistered designs and patterns, as set forth at Art. 11 and 12 of the Regulation.

A design or pattern meeting the conditions stipulated in the Regulation at Section 1 is protected as *unregistered community design or pattern for a period of three years* as of the date when the design or pattern was disclosed to the public for the first time at Community level.

In the sense of para. (1), it is considered that a design or pattern was disclosed to the public at Community level if it has been published, exposed, marketed or made public in any other way, such that, in the course of normal business operations, it can be presumed that the respective action would

have become known to specialized groups from the concerned economic sector at Community level. Nevertheless, it is not deemed that a design or pattern is disclosed to the public if divulged only to one third party, with the explicit or implicit condition of preserving their secrecy.

By the registration with the Office, a design or pattern that meets the conditions of Section 1 of the Regulation is protected as *registered design or pattern* for a period of five years starting from the date when the application was submitted. The titleholder of the right may extend the duration by several five-year terms, up to a maximum of twenty five years as of the date when the application was submitted.

### Termination of Rights

Art. 21 of the Regulation mentions that the rights conferred by the community design or pattern are not enforced in the case of a product into which it has been incorporated or onto which the protected community design or pattern is applied, if such product was placed on the market on the territory of the Community by or with the agreement of the titleholder of the respective community design or pattern.

## PROTECTION SYSTEMS

Designs and patterns find protection as regards intellectual property rights in many various ways, such variety being explained both through the particular features of such type of intellectual creations, and, as already mentioned above, through the fact that they are at the crossroads between industrial property and copyrights, and also by the constant existence of certain disputes regarding the legal nature of the rights on industrial designs and patterns, the up-to-date character of the field and the diversity of the legislative solutions adopted<sup>8</sup>.

Depending on the particular features of such creations, there are three main systems for the protection of designs and patterns:

- the system of integrated cumulation of protection,
- the system of partial cumulation of protection,
- the system of specific protection.

Each of these systems is dealt with in various national legislations.

Thus, **the system of integrated cumulation of protection**, both in doctrine and in specialized literature, is known as “the system of cumulated protection”. In my opinion, the concept of system of integrated cumulation of protections is more relevant and recommendable for use, since, by doing so, the distinction between the other systems is being strengthened, and especially the one in which similar criteria are being used, namely the system of partial cumulation of protection as regards designs and patterns.

This system has been consecrated in French law. Designs and patterns are regulated both in the Special Law of 14 March 1909, and the Law of 11 March 1957 on literary and artistic property.

The solution of the cumulation of protection is explained by the theory of the unity of art. Due to the impossibility of finding a single objective criterion to appreciate it, art in itself cannot be separated from applied arts. French jurisprudence stated that designs or patterns must be new and not a result of hazard; apart from this fundamental condition, there is another formal condition related to storage, which consists in the fact that the latter should be prior to the sale of the product, and which has the capacity to confer rights.

The most significant advantages of the cumulation of protection are: in the absence of storage, which conditions the acquiring of protection, the creator’s rights can be capitalized as copyrights; the protection of copyrights lasts longer; the action against counterfeiting involves simple proceedings in the case of copyrights, and the sanctions are more serious.

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<sup>8</sup> Nathalie Dreyfus, and Beatrice Thomas, *Marques, dessins & modeles – Protection, defense, valorization*, Second Edition, (Paris: Dalmas Publishing House, 2006).

The author of a design or pattern may choose a cumulative protection or another alternative. The granted protection is not conditional upon the artistic value of the design or pattern in question.

This principle of cumulative protection of designs and patterns has known a more recent recognition in Art. 17. of EC Directive 98/71. We can notice, therefore, that, at community level this principle has been recognized after many years from the operation, in the Romanian system, of the protection of intellectual property rights applicable to designs and patterns, which leads us to believe that the Romanian legislative system is a modern one, able to anticipate a complex protection for such works, and offering, at the same time, titleholders the possibility of getting increased protection for their creations.

### **The system of partial cumulation of protection**

The system of partial cumulation of protection is traditional to German law. The German system is based on the distinction being made, depending on the predominant features of the artistic elements, between applied artwork, susceptible for copyright protection, and the designs and patterns themselves. In order to benefit from copyright protection, designs and patterns should be original. According to this system, the theory of art unity is rejected, while the distinction between designs and patterns and applied artwork is being made based on the criterion of artistry of the respective creation. Consequently, this system stipulates that originality is an essential condition for granting protection. Should the originality condition not be met, the design or pattern will only benefit from the specific protection given to industrial design and patterns. A similar system exists in Benelux as the Uniform Law of 1 January 1975, which also sets forth originality as criterion for the granting of double protection.

### **The system of specific protection**

The system of specific protection is used in Italian law. The Italian system excludes any cumulation of protection; designs and patterns can only be the subject of protection in specific terms. Industrial designs and patterns are protected by specific regulations only, as established under Royal Decree No. 1411 of 25 August 1940, amended by Law No. 60/14 February 1987, as subsequently completed. By totally excluding cumulation, designs and patterns benefit from a unique protection system. Designs and patterns are referred to as decorative creations. Their legal status is the same as in the case of utility patterns.

In Romanian law, industrial designs and patterns enjoy a specific protection under Law No. 129 of 1992, which does not exclude the protection conferred by other legal provisions on intellectual property rights. To date, industrial designs and patterns have been subject to copyright protection.

The importance of this theme is also given by the fact that, for a while, the Romanian (and other) lawmakers have avoided providing a definition of designs and patterns, preferring instead to establish the fundamental conditions that they should meet in order to be protected, but, in the light of the new regulations, such definition has been enunciated in concrete terms and therefore, there is no shadow of a doubt as regards such topic – which this study attempted to focus on and clarify.

Regulation No. 6/2002 does not exclude the enforcement, in the case of designs and patterns, of protected community designs and patterns, regulations on industrial property or other relevant regulations pertaining to the member states, as well as the ones referring to the protection acquired by registration, or the ones concerning unregistered designs or patterns, onto commercial trademarks, patents and other utility patterns, or onto the ones regarding unfair competition and tort liability.

The rights on designs and patterns are property rights, as defined under civil law, which allows their creators to receive benefits from capitalizing their output. These rights are real, exclusive and absolute. Moral and patrimonial rights are recognized to the creators of designs and patterns.

Moreover, in the absence of a complete harmonization of the legislation on copyright matters, the Regulation imposes the principle of cumulating specific protection for community

designs and patterns with the protection offered by copyrights, at the same time giving member states unrestricted freedom in establishing the degree of protection provided by copyright and the conditions for the granting of such protection.

### Conclusions

The main directions approached by this study refer to the identification of a protection system applicable to designs and patterns valid in community law, as regulated by Directive No. 98/71/EC, and Council Regulation (EC) No. 6/2002 of 12.12.2001; it has briefly presented the aforementioned enactments, and discussed the various steps that must be followed in pursuing the procedure for obtaining protection and which, in my opinion, deserved such attention and analysis. Another focus of this study was the identification of available protection systems, and the review thereof, in order to better understand the applicability of said enactments and their importance in practice.

The expected impact of this study is to increase awareness on the importance of the legislative enactments applicable at European level on the subject matters discussed herein, and to understand the achievements in the field of intellectual property protection of designs and patterns. This aspect has known a growing importance in domestic and worldwide economy.

On a last note, I suggest expanding the analysis of this theme so as to include casuistry, as well as copyrights, trademarks and other components of intellectual property rights.

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