

**Information Note on specific aspects of the Industrial Designs
Act 2001 and the Industrial Designs Regulations 2002**



**Department of
Enterprise, Trade
and Employment**

Intellectual Property Unit

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This Information Note is intended as a brief and non-comprehensive guide to some of the provisions of the Industrial Designs Act 2001 and the Industrial Designs Regulations 2002. The information contained herein does not purport to be a legal interpretation of industrial designs legislation and persons requiring legal advice should consult an appropriate legal practitioner. The Patents Office will provide advice on matters relating to the registration of industrial designs.

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(i) GENERAL OVERVIEW OF THE INDUSTRIAL DESIGNS ACT 2001 AND THE INDUSTRIAL DESIGNS REGULATIONS 2002

The Industrial Designs Act 2001 (No. 39 of 2001) and the Industrial Designs Regulations 2002 (S.I. No. 280 of 2002) came into effect on 1 July 2002.

- **The Industrial Designs Act 2001** establishes a complete code governing the registration of industrial designs and completely replaces previous industrial designs legislation i.e. the Industrial and Commercial Property (Protection) Acts 1927 to 1958. Although, the Industrial Designs Act is essentially concerned with the protection of designs by registration, it does contain some tidy-up provisions in respect of, for example, copyright and designs. The Industrial Designs Act implements the EU harmonising Directive of the European Parliament and of the Council on the Legal Protection of Designs (Directive 98/71/EC of 13 October 1998). This Directive requires Member States to harmonise substantive provisions of their industrial designs law, notably the conditions for validly registering an industrial design and the rights conferred by registration. The Act also allows the Minister to make provision by regulations to give effect in Ireland to the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs and to certain provisions of the Agreement on Trade-Related aspects of Intellectual Property rights (TRIPS).

- **The Industrial Designs Regulations 2002** prescribe the fees payable, forms to be used and the procedures to be observed in connection with the registration of industrial designs under the provisions of the Industrial Designs Act 2001.

(ii) FILING DATE

Section 25 of the Industrial Designs Act 2001 establishes the criteria that will decide the filing date to be applied to an application for registration of an industrial design. The filing date is the date on which all of the items specified in section 25 are received by the Patents Office i.e.:

- the prescribed fee (€70),
- a request for registration of the design,
- a representation of the design suitable for reproduction, and
- the name and address of the applicant.

The documents, including representations, referred to in section 25 must, under **Regulation 16** of the Industrial Designs Regulations 2002, be furnished in a form that is legible and suitable for reproduction. Further, **Regulation 11** of the Industrial Designs Regulations 2002 sets out detailed requirements for the format in which representations must be submitted to the Patents Office. It also sets out procedures for applications where the representation cannot be submitted in the legally required form at the time of filing. This means that, if an applicant, at the initial application stage, is not in a position to provide representations in the format set out in Regulation 11, he or she may submit a representation of the design in any form suitable for reproduction and still achieve a filing date. In such circumstances, the applicant must provide representations of the design, which fulfil the requirements of Regulation 11 within 3 months of the filing date.

(iii) MULTIPLE APPLICATIONS

Regulation 19 of the Industrial Designs Regulations 2002 provides that 2 or more designs, subject to a maximum of 100 designs, may be combined in one multiple application for registration. Except in cases of ornamentation, this possibility is subject to the condition that the products in which the designs are intended to be incorporated or applied all belong to the same class of the Locarno system of International Classification. A multiple application for registration facilitates the submission of applications for different designs in the same class in one application to the Patents Office rather than having to submit a separate application for each design. The process of multiple applications is designed to make registration of designs cheaper and more attractive for proprietors of industrial designs. For example, a textile designer can submit all of his or her designs for, say, dresses for the upcoming season in a simple and cost-effective manner.

The exception for designs of ornamentation follows the approach in Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs and can be explained as follows. The multiple application system basically aims to allow for simple administrative procedures for registration of designs that have a unitary character. This unitary character is based on the designs of products that are in the same class. However, in the case of ornamentation, it is typical that the designs are to be applied across different products and classes. So, for example, for interior design purposes, ornamentation on wallpaper (class 05) may also be intended for application to curtains (class 06) and this unitary use should be allowed to be the subject of a multiple application as well. Different designs that consist of ornamentation may therefore be included in a multiple application, even where the products to which they are applied are in different classes. This exception to the general rule is to facilitate the special nature of ornamentation which more than other designs tends to be applied to sets or

ranges of products across classes rather than to be applied to single items or numbers of items within the same class.

Each of the designs contained in a multiple application may be dealt with separately from the others after the application stage. This means that all of the designs in a multiple application will have a separate legal status, and can, be surrendered, renewed or assigned separately. Regulation 19 also sets out the manner in which multiple applications must be filed with the Patents Office and Schedule 2 to the Industrial Designs Regulations 2002 sets out the relevant Multiple Application Form.

FEES FOR MULTIPLE APPLICATIONS

Schedule 1 of the Industrial Designs Regulations 2002 prescribes the standard application fee of €70 plus an additional fee of €25 for each design in a multiple application. This scale of fee produces a potentially substantial saving in the cost of registration for owners of designs.

Example

A multiple application containing 10 designs costs €70 + (€25 x 10) i.e. €320.

10 separate applications for the same design would cost €70 x 10 i.e. €700.

(iv) DIVISIONAL APPLICATIONS

Regulation 20 of the Industrial Designs Regulations 2002 provides for the division of multiple design applications following a request made by the applicant for registration. A divisional application could arise for many reasons, for example, where it transpired that a multiple application does not meet the requirements set out in Regulation 19 i.e. the designs in the multiple application do not all belong to the same class of the Locarno system of International Classification (it should be noted that this is not a requirement for designs of ornamentation). An applicant might also decide to divide a multiple application where some of the designs subject of the application are to be sold to another person or, for some other administrative reason.

The request for division of an application must take place prior to the registration of the designs in the multiple application and must identify the design or designs which are to be separated out from the original application. The divisional application shall retain the same filing date and date of priority as the original application made to the Controller.

FEES FOR DIVISIONAL APPLICATIONS

Schedule 1 of the Industrial Designs Regulations 2002 prescribes a fee of €45 for each divisional application. The fee for dividing a multiple application containing 10 designs into 10 separate applications is therefore €450 (10 x €45).

Example

A multiple application containing 10 designs costs €320. The fee for dividing this multiple application into 10 separate applications is €450 (10 x €45).

The total cost of applying for these 10 designs is therefore €770.

(v) NOVELTY

Section 12 of the Industrial Designs Act 2001 makes provision in respect of novelty requirements for the purposes of registration of industrial designs.

- Section 12(1) of the Industrial Designs Act provides clarification on the term “new”. Under this provision, a design will be considered new where no design identical to it has been previously made available to the public before the filing date for registration or, where priority is claimed, before the date of priority.
- Section 12(2) defines the term “*identical*”. Under this provision, a design shall be considered to be identical to a design which has been previously made available to the public where its features differ only in immaterial details.

Section 2 of the Industrial Designs Act defines the term “*made available to the public*” as

“published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within a Member State of the EEA”.

This definition is based on Article 6 of the EU Directive on the Legal Protection of Designs (Directive 98/71/EC of 13 October 1998) and sets out the forms of making a design available that will destroy its novelty and individual character. It is very important to note that, where an act of making a design available (such as a sale or exhibition of products incorporating the design) occurs in circumstances

such that the relevant sector of industry in the EEA could not reasonably have known of that sale or exhibition, then the design shall be deemed not to have been made available by virtue of that sale or exhibition alone. This would apply where, for example, the design was applied to jewellery and put on sale or exhibition. That sale or exhibition would not prevent the same design being considered novel if applied to a carpet or curtain, because the carpet or curtain sector may not have reasonably known that the design in question was in the public domain (not being interested in, or experts in, the jewellery field). A firm operating in the textile sector could then subsequently register the design in respect of a carpet or curtain.

It should be pointed out that some allowance is made for disclosures of a design which will not affect the novelty status of the design and these are set out in section 2(7) of the Industrial Designs Act 2001.

It should also be noted that the Controller will not carry out a novelty check on design applications and the onus is on the applicant to establish the novelty of his or her design prior to making the application for registration to the Controller. Section 47(1)(a) of the Industrial Designs Act provides for the invalidation of registrations at the request of interested persons where designs are subsequently found not to have been novel at the time of application.

(vi) DISCLOSURE OF DESIGNS PRIOR TO REGISTRATION

Under **Section 11** of the Industrial Designs Act 2001 a design must be new to be registrable under the Act. **Section 12(1)** of the Industrial Designs Act 2001 states that “a design shall be considered to be new where no design identical to it has been previously made available to the public before the filing date for registration or, where priority is claimed, the date of priority”.

Under **Section 2(7)** of the Industrial Designs Act 2001, a design shall not be deemed to have been made available to the public in the following cases:

- a) If it has been disclosed to another person under explicit or implicit conditions of confidentiality. For example, for market research reasons a carpet manufacturer might wish to disclose a newly designed carpet to his/her distributor /supplier. Such a manufacturer does not want to have the expense of registering this new design if it is unlikely to be commercially viable and this provision enables him or her to “test the market” without losing the right to register the design.
- b) Where it is made available to the public less than one year before the filing date of the application for registration or the priority date, which ever is earlier, as a result of information provided or action taken by the author or his or her successor in title. This means that the author or his or her successor in title can use the design and test it on the market during twelve months prior to applying for registration without risk of destroying the novelty and individual character of his or her design. The provision has the effect of a “grace period” for the designer. This provision is particularly relevant when the author files an application for a variation of the design which had originally been published or publicly used. Where this is done within the period of grace, the presence of individual character cannot be denied by invoking the earlier publication.

- c) Where a design has been made available to the public without the authorisation of the author or his or her successor in title. In other words, if someone steals or pirates a design and subsequently uses it on products for public sale, that making available of the design, due to its illegal nature, shall not prevent the author from subsequently registering and gaining protection for that design.

Section 2(7) of the Industrial Designs Act implements a substantial part of Article 6 of the EU Directive of the European Parliament and of the Council on the Legal Protection of Designs (Directive 98/71/EC of 13 October 1998).

(vii) POWER OF CONTROLLER TO REFUSE REGISTRATION OF A DESIGN.

Section 21 of the Industrial Designs Act 2001 gives the Controller the power to refuse registration of a design on specific grounds.

- Section 21(1)(a) implements one aspect of Article 11 of the EU Directive of the European Parliament and of the Council on the Legal Protection of Designs (Directive 98/71/EC of 13 October 1998) and gives the Controller the power to refuse to register designs which are contrary to public policy or to accepted principles of morality. The power to reject applications for the registration of intellectual property on these grounds is a common feature of intellectual property law.
- Section 21(1)(b) implements Articles 11.2(b) and 11.4 of the EU Designs Directive, giving the Controller the power to refuse registration of a design, on application by the copyright owner, on the grounds that the design is either an unauthorised copy of a copyright work or infringes copyright in some other way. This provision acts as a supporting measure to the Copyright and Related Rights Act 2000.
- Section 21(1)(c) implements Articles 11.2(c) and 11.6 of the EU Designs Directive. It provides that the Controller may refuse to register designs where use of the design constitutes an improper use of national emblems, badges, flags etc. of states, including Ireland, party to the Paris Convention on Industrial Property or of certain international organisations. It also protects against the registration of emblems and other escutcheons of certain international intergovernmental organisations such as the European Environment Agency, the International Atomic Energy Agency, the European Investment Bank, the African Intellectual Property Organisation and many more. The relevant provisions of the Trade Marks Act, 1996 are invoked to ensure that the new designs law respects fully

the provisions in respect of the use of such emblems under trade mark law.

Section 21(2) implements Article 11.7 of the EU Designs Directive by permitting the registration by the Controller of a design in an amended form where the form in which the design is expressed in the original application did not meet the Controller's approval under one of the conditions set out in subsection (1). These conditions include designs that are contrary to public policy or accepted principles of morality, designs that infringe copyright and designs that involve improper use of the national emblems, flags or badges of states or certain international organisations. Regulation 21 of the Industrial Designs Regulations 2002 provides that where the Controller proposes to refuse an application, he or she shall notify the applicant accordingly and indicate a time limit within which the applicant may withdraw or amend the application or submit his or her observations.

(viii) DEFERMENT OF PUBLICATION

Section 32(2) of the Industrial Designs Act 2001 provides for deferment of publication of a registered design at the request of the proprietor of the design. The proprietor of the design should request deferment at the time of filing his or her application but at the latest within 12 months of the filing date i.e. the deadline set out in Regulation 14(1) of the Industrial Designs Regulations for completion of an application for registration. Regulation 25 of the Industrial Designs Regulations 2002 provides for a deferment 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. Upon the expiry of the period of deferment or at any earlier date requested by the registered proprietor of the design, the Controller shall open the Register to public inspection in respect of that design and shall publish a notice of the registration of the design in the Patents Office Journal.

The option to defer publication of a registered design addresses the need of several sectors of industry who feel they cannot afford to publish their design before the products incorporating the design reach the market. Particularly in the field of fashion, although the problem is not uncommon in the domain of cars, letting competitors know in advance the general line of the design of a future collection could jeopardise the success of a commercial operation based on the exclusive character of such a line. The deferment period of 30 month is consistent with the deferment period in Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community design and the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs. The fees for deferment of publication are set out in Schedule 1 of the Industrial Designs Regulations 2002 and vary according to the period for which deferment is requested i.e. from €50 for a period of up to 12 months up to €250 for a period from 24 to 30 months.

(ix) GENEVA ACT OF THE HAGUE AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

Section 79 of the Industrial Designs Act 2001 allows the Minister to make provision by regulations to give effect in Ireland to the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs. The Geneva Act of the Hague Agreement was adopted at a World Intellectual Property Organisation (WIPO) Diplomatic Conference in Geneva on 2 July 1999.

The Hague Agreement concerning the International Deposit of Industrial Designs was conceived in order to simplify the overseas protection of industrial designs. It dates back to 1925 and has been revised at various times, in particular at London (1934 Act) and at the Hague (1960 Act). The Complementary Act of 1968 is also important in that it establishes the Assembly of the Hague Union and the processes for funding, budgets and other administrative matters. The system under the Hague Agreement is administered by the International Bureau of the World Intellectual Property Organisation (WIPO). The objectives of the Hague Agreement are two fold. Firstly, it offers owners of an industrial design a simplified means of applying for protection of a design in several countries by submitting a single international application. Without the system an owner would have to file separate applications in each of the countries in which protection is sought. Secondly, by having a single deposit with effect in several countries, the subsequent management of the protection obtained is made much easier. At the present time, an international deposit may be governed by the provisions of the 1934 Act or the 1960 Act or both.

The Geneva Act of the Hague Agreement enhances the existing system for the international registration of industrial designs by making it more compatible with national registration systems and it will reduce the cost to business of obtaining

protection of their property rights in countries which ratify the new Geneva Act. The cost savings will principally arise from the designation of a number of countries in a single application as opposed to proprietors of designs having to make individual applications for each country separately, as currently is the case. The Geneva Act of the Hague Agreement is not yet in force. It will enter into force three months after six States have deposited their instruments of ratification or accession, as specified in the Treaty, subject to the qualifier that three of those states must be substantial users of industrial designs.

Ireland is not party to the 1934 Act nor the 1960 Act. The new Geneva Act however provides an opportunity to enable Irish design proprietors to benefit from an international system of registration which will reduce the cost to business of obtaining protection of their property rights in all countries which ratify the new Geneva Act. To date, twenty-nine States including Ireland have signed the Geneva Act of the Hague Agreement and six States (none of which are substantial users of industrial design registration systems) have acceded to/ratified the Agreement. Ireland has not yet ratified this Treaty.

(x) COPYRIGHT IN DESIGNS

DESIGN DOCUMENTS AND DESIGN MODELS

Design Documents:

Design documents are the original drawings, sketches or plans that are made of the design before it is applied to any product. They may be generic patterns or they may actually show the design as applied to a product at this stage of the process but they have not yet been applied to products when these documents are drawn up.

Design Models:

Typical examples of design models would be sculptures or casts that are produced before the design is actually applied to products. As with design documents, they may be generic or they may demonstrate the design as applied to a product (either on scale basis or life size).

Design documents and models are generally considered to be literary or artistic works as defined in the Copyright and Related Rights Act, 2000 and, as such, would qualify for copyright protection under that law. The exceptions to copyright protection for designs set out at sections 78, 79, 84 and 85 should particularly be noted in relation to designs. Subject to the preceding paragraph, design documents and models qualify for full copyright protection for a term of life plus 70 years from the date they are created.

DESIGN DOCUMENTS AND MODELS THAT REMAIN UNREGISTERED

Design documents and models that remain unregistered continue to qualify for copyright protection. However, the Industrial Designs Act, 2001 contains provisions that qualify copyright protection for designs that are exploited as products. Section 89(e) of that Act inserts new sections 78A and 78B into the Copyright and Related Rights Act, 2000 in this regard.

Section 78a, Copyright And Related Rights Act, 2000

This section follows the UK approach by restricting the copyright protection in the shape and contours of designs other than artistic works, to allow others to make products using the shape and contours or copying such products when made. This means that the owner of an unregistered design cannot invoke copyright law to prevent the making of products to the shape or contours of the design. This is intended to encourage designers to use the registered design system or to licence the use of their designs on products to industrial concerns. Should they decide not to do so, then their control over use of their non-artistic copyright works will be limited.

Section 78b, Copyright And Related Rights Act, 2000

The UK principle is followed here again in respect of artistic works that constitute design documents or models. Where the work is not exploited on products by the owner or with his or her authorisation, full copyright protection will prevail. This is intended to protect artistic works that are not intended to be used as designs for products. This section contains an exclusion permitting the Minister to specify products of a primarily literary or artistic character that, where they contain designs, shall not be subject to the restriction on the term of protection for use on products applied by virtue of this section. The type of products envisaged here have already been set out in detail in UK law and would include such products as sculptures, wall plaques, medals, printed matter such as book

jackets, playing cards, postcards, stamps and trade advertisements. The preparation of an Order under section 78B(4) is in train in the Department.

As mentioned, this section operates to restrict the term of copyright protection in respect of exploitation on products of designs. This applies where products that contain a design have been made by an industrial process and marketed by or with the authorisation of the copyright owner. In such circumstances, after 25 years, others may make products of any description without infringing the copyright in the design document or model.

It is anticipated that the vast majority of design documents or models will be in the form of artistic works and this restriction will therefore capture the vast majority of original design.

COPYRIGHT IN REGISTERED DESIGNS

Section 89(a) of the Industrial Designs Act, 2001 amends the Copyright and Related Rights Act, 2000 by inserting a new section 31A. The purpose of this new section is to provide copyright protection in registered designs for 25 years from date of filing of the registered design application. Where the design document or model had been exploited on products before this filing date, then the provisions of section 78A will apply and the copyright will expire less than 25 years from the filing date. However, where no exploitation on products of the designs document or model has occurred before the filing date, then the registration of the design under the Industrial Designs Act, 2001 will cause the copyright protection to be restricted to 25 years from that date. The policy reason for this restriction is again based on the premise that product designs should be protected for a limited period only to promote innovation and competition in product markets.