



Authors

Gregor Vos and **Sophie van de Graaff**

In this chapter, the existence and scope of protection of designs are considered from the Benelux (Belgium, the Netherlands and Luxembourg) perspective only. The other topics discussed are also dealt with from an EU viewpoint.

Legal framework

Relevant legislation

The legal rules for design rights in Benelux are laid down in the Benelux Convention on Intellectual Property, together with its Implementing Regulations. Both acts entered into force in 2006. The EU Designs Directive (98/71/EC) is implemented through the convention. The EU Community Designs Regulation (6/2002) has direct effect in Benelux. The EU IP Enforcement Directive (2004/48/EC), which provides specific remedies for IP rights infringement, has been implemented through the national procedural laws of the Benelux member states.

System

An attributive system is applicable in Benelux. The protection of a design is wholly dependent on registration.

Unregistered designs

The convention provides no protection for unregistered designs; however, the Community Designs Regulation provides a three-year protection period for unregistered designs. This protection can be invoked in Benelux.

Registered designs

In principle, the exclusive rights to a design rest with the applicant, regardless of whether it is the actual designer. If a design was made in the course of employment or on commission, either the employer or the party which commissioned it is entitled to the design rights, unless the parties have agreed otherwise.

The convention aims to consolidate designs and copyrights. Therefore, in a departure from the prevailing copyright law, if a design is made in the course of employment or on commission, and that design is eligible for copyright protection, the copyright in such design also

rests with the employer or the party which commissioned it, unless agreed otherwise.

In addition, if a copyright owner authorises a third party to file a design in which the copyrighted work is incorporated, this implies the assignment of the copyrighted work insofar as the work is incorporated in the design.

If the applicant is not the (fictitious) designer, the convention enables the designer to claim the design rights within five years of publication or to invoke the nullity of the design registration.

Eligible designs

A 'design' is defined as the appearance of the whole or a part of a product resulting from the characteristics of, in particular, the lines, contours, colours, shapes, textures or materials of the product itself or its ornamentation.

Eligible for protection are:

- designs that are novel (ie, no identical design has been made available to the public); and
- designs that have individual character (ie, the 'informed user' would find the design different from other designs which are available to the public).

The novelty and individual character of the design are assessed on the basis of the part of the design that is visible during normal use.

The design right need not cover the entire product: design protection can also be obtained in respect of a part or element of a design. Parts or elements of the product that are not visible during normal use are not protected.

Products whose appearance is wholly determined by their technical function or by the need to interconnect with other products in order to perform a technical function ('must-fit' products) are excluded from design protection. However, modular systems such as stackable and linkable chairs may be protected.

Before the introduction of the convention, an applicant had to list the designated use of the product for which protection was sought in order to obtain design protection. Therefore, if a product was used for something other than the designated use listed in the registration, the product would also be eligible for design protection for the other designated use. At present, it is unclear whether the 'designated use' doctrine is still applicable.

Duration of protection

The term of protection for design rights is five years. Such rights can be renewed up to four times, resulting in a maximum protection period of 25 years.

Procedures

Application process

The exclusive rights in a design are obtained by the applicant or its agent filing an application with the Benelux Office for Intellectual Property (BOIP). The application is followed by registration of the design, which is then published. The design right comes into existence as of the moment of registration.

The application must contain:

- the name and address of the applicant;
- a photographic or graphic representation of the design;
- a precise statement regarding the product in which the design is embodied;
- a description of the colour(s) of the design; and
- the signature of the applicant or its agent.

In addition, the application may contain:

- a description of the characteristic features of the novel appearance of the product (maximum 150 words);
- a declaration regarding the name of the actual designer of the design (if the design was made in the course of employment or on commission); and/or
- a request for deferred publication of registration.

If the applicant wishes to invoke the priority of its design, it must do so at the time of filing (with a grace period of one month); otherwise the right of priority lapses.

Filing fees range from €108 per design for a single filing to €22 per design for the 21st to the 50th designs. Additional fees are applicable if the application is filed by the applicant's agent and if the application contains a description of the characteristic features of the novel appearance of the design as mentioned above. Renewal fees range from €20 to €95 (the more designs that are registered, the lower the fee). Amendments to a registration cost up to €24.

An applicant may request deferred publication for up to one year from the time of registration.

An application may contain up to 50 different designs. The advantages of including more designs in one application include a degressive fee structure. Renewal and cancellation can be limited to a specified number of the designs included in the application.

Electronic filing is not possible.

Assessment of validity; opposition proceedings

Apart from the condition that the design may not contravene public policy or morality, the BOIP does not assess whether the design meets the conditions for design protection. Although no opposition proceedings are available, interested parties may invoke the nullity of a design in court.

Removal from the register

The rights holder may request removal of the registration from the register any time. If the registration contains multiple designs, the rights holder may request partial removal. If a licence has been granted or the design rights have been pledged or attached, the registration may be removed from the register only if a joint request for removal is filed by the rights holder and the licensee, the pledgee or the attaching party.

The exclusive rights to a design lapse after the design's voluntary removal from the register or the expiration of the registration.

Any interested party (eg, a competitor of the rights holder) may invoke the nullity of a design registration on the grounds that:

- the design does not meet the statutory conditions to qualify as a design;
- the design is not novel or lacks individual character;
- the product's appearance is determined wholly by its technical function or the product is a must-fit product; or
- the design contravenes public policy or morality.

Only the applicant or the owner of an exclusive right in a design valid in Benelux may invoke the nullity of the registration of a later filing of a design which conflicts with its rights. The same applies, *mutatis mutandis*, for trademark or copyright owners. Any interested party may invoke the nullity of the registration of a design that constitutes improper use of one of the elements listed in Article 6ter of the

Paris Convention (eg, state emblems). Only the creator of a design may invoke the nullity of the registration of a design made by a third party without its consent. The registration of a design may be declared null and void even after the right has lapsed or been renounced.

Removal from the register always applies to the whole Benelux territory.

Enforcement

In general, design rights are enforced under civil law. Although enforcement under criminal law is possible, this route is seldom taken. Under civil law, the owner of a design right can enforce its rights against infringing parties by initiating either preliminary relief proceedings or proceedings on the merits. It is unclear whether design rights-related disputes can be the subject of arbitration.

The Benelux Convention on Intellectual Property provides that a rights holder can oppose the use of its design by third parties in Benelux. The most important remedies are an injunction combined with a penalty and a damages claim. In principle, an injunction will apply to the whole of the Benelux territory. It is unclear whether an injunction can be obtained for the whole of the European Union.

The rights holder may request an injunction in case of the use of a product in which the design is incorporated or to which the design is applied, which has an identical appearance to the design as filed or which does not produce a different overall impression on an informed user, having regard to the creator's degree of freedom in preparing the design. The rights holder may also ask the court to impose a penalty for breach of the injunction.

The rights holder can claim compensation for infringement, but only insofar as the infringement took place after publication of the design. In addition, the owner may bring an action for transfer of the profits made as a result of the infringement, as well as provision of the accounts of the infringing party in relation to the infringement. The rights holder may also bring this action in the name of a licensee.

Furthermore, the rights holder may request that the infringing goods and the objects used to produce them be surrendered or destroyed, and may ask the courts to order the infringing party to provide the owner with all available

information and data concerning the origin of the infringing goods. The rights holder may also ask the courts to order the recall of infringing products from the market. Other ancillary claims are possible.

On the basis of the IP Enforcement Directive, the rights holder can file a request with the court for an *ex parte* order with a view to the precautionary seizure of goods that are suspected of infringing its design rights so as to prevent their (further) entry onto, or movement within, the market.

The timeframe for preliminary relief proceedings varies depending on the urgency of the matter. Usually, preliminary relief proceedings take between two weeks and two months, except in cases of extreme urgency. In such cases the matter may be resolved in a couple of days. Proceedings on the merits usually take between one and two years.

For both preliminary relief proceedings and proceedings on the merits, appeal and final cassation appeal are possible.

Ownership changes and rights transfers

Transfer of ownership

The exclusive rights in a design can be transferred. In order for a transfer to be valid, the transfer must be laid down in writing and must concern the whole of the Benelux area. A transfer of the design right automatically brings about the transfer of the copyrights that may apply to the product and vice versa, so that those rights remain with the same person.

Licensing

The exclusive rights in a design may be the subject of a licence. A licence for design rights automatically includes a licence for the corresponding copyrights. The granting of a licence has no prescribed form. As a result, a licence can be granted orally or even implied. Moreover, a licence may be exclusive or non-exclusive. The existence of a licence may be entered in the register. Such registration may be cancelled only at the joint request of the rights holder and the licensee.

The rights holder will usually limit the possibilities for exploiting the design rights commercially by imposing restrictions regarding the territory or the term of the licence. If the licensee does not comply with the licensing conditions, it both breaches the

licence agreement and infringes the licensor's design rights; the licensor can then take action against the breach and the infringement.

The licensee is entitled to intervene in an action of the rights holder regarding compensation for damages and surrender of profits against infringing parties. If permitted under the licence agreement, the licensee may also bring an action for those claims independently. Furthermore, the licensee is entitled to intervene in an action regarding ancillary claims or to bring an independent action for those claims if the rights holder's permission is obtained.

Pledge and attachment

The exclusive rights in a design can be pledged or attached.

Third-party effect

A transfer or licence has third-party effect only once it has been entered in the register; however, entry in the register is not a condition for a valid transfer or licence. The same applies for pledges and attachments.

Related rights

Copyright

A design can be protected by copyright if the design is a work of applied art or an industrial design, has individual original character and bears the personal stamp of the maker. While the threshold for copyright protection is quite low, case law on what should be regarded as a work of applied art or industrial design provides no clear guidance.

Copyright protection can be an important fall-back option if the design has not been registered or the design protection has lapsed. The scope of protection under copyright also appears to be somewhat broader.

Trademarks

A shape mark can be registered as a trademark insofar as the shape:

- is not imposed by the nature of a product;
- gives the product substantial value; or
- is necessary to obtain a technical result.

As a trademark need not be novel, a successful design could be registered as a shape mark insofar as it is in line with trademark law. [WTR](#)

Contributor profiles

Klos Morel Vos & Schaap



Klos Morel Vos & Schaap

Weteringschans 24, 1017 SG Amsterdam
Netherlands

Tel +31 20 577 3573

Fax +31 20 577 3578

Web www.kmvs.nl



Gregor Vos

Managing partner
gregor.vos@kmvs.nl

Gregor Vos is a highly regarded IP litigator who has been described as “skilful and effective” and “eager and hardworking with tremendous energy”. Mr Vos has been practising as an IP litigator since 1994 after earning his degrees in Amsterdam and London. His practice has an emphasis on trademarks, designs and advertising. Mr Vos has successfully litigated many high-profile multinational cases both in the Netherlands and before European institutions. He represents a number of well-known companies in various industries. Mr Vos is a panellist for ‘.nl’ domain names with the World Intellectual Property Organisation in Geneva, and an active member of various trademark and design organisations.



Sophie van de Graaff

Associate
sophie.vandegraaff@kmvs.nl

Sophie van de Graaff started her career at an international law firm in 2009 and joined Klos Morel Vos & Schaap in 2012. She handles a broad range of IP law issues, as well as closely related matters of civil law. Ms van de Graaff was educated at the University of Amsterdam and the University of Leiden, where she earned a degree in IP law and criminal law. During her studies, she worked as a paralegal for the IP department of an international law firm in Amsterdam. She is a regular contributor to the journal of the Benelux Association of Trademark and Design Law and publishes on various subjects related to her practice.