



EU trade marks vs EU registered designs

What is a trade mark?

A trade mark is something which a consumer can look to, to make sure that they are purchasing your goods/services as opposed to the same goods/services provided by your competitors.

What is a Registered Design?

A registered design protects the appearance of the whole or part of a product resulting from the configuration of features such as the shape, contour, colour and texture

Businesses are increasingly focusing on protecting the “get up” of a product. The “get up” can include the overall packaging of the product, the shape of the product itself or a particular branding style. “Get up” can be considered to be any aspect of the product which adds value to the product itself, i.e. a reason as to why the consumer may purchase your products over the same product produced by a competitor and it is because of this value that competitors look to copy the “get up”. Trade mark and/or design protection may be relevant.

Why do you need to protect your work?

- Your brand underlines everything you have worked hard to achieve and are looking to exploit commercially
- Protecting your work ensures you have the exclusive right to the brand in your industry and enables you to control who and how your brand is used
- It makes it much easier to effectively police and stop others taking advantage of your hard work and potentially damaging your goodwill and reputation
- It should be easier and less costly to enforce your rights on the basis of a registered rights than it would be on the basis of rights accrued through use

Which type of protection do you need?

Increasingly there is an overlap between what can be protected as a registered trade mark and a registered design. Logos and 3D shapes for example are, in principle, protectable via both routes, although there is no substantive examination of designs so getting designs registered will be easier.

Consideration	EU trade mark	EU registered design
Will it protect the "get up" of the product?	Yes	Yes
Will it protect logos?	Yes	Yes
Will it protect words?	Yes	Not single words/ not unstylised words
Will it protect shapes?	Yes – but only if the shape is distinctive or you can show your mark has acquired distinctiveness by filing evidence of use. Need to prove a significant proportion of the consumers of the goods for which registration is sought, recognise the trade mark.	Yes
Restricted to certain goods	Yes – classes to be selected	No
Examination scrutiny	Rigorous	Minimal
Objections from the office	Often – especially if you are trying to protect the shape of a product or its packaging.	Rare
Opposition from third parties	Possibly as your application will be published for 3 months for the purposes of third parties having the opportunity to oppose the same.	No
Duration	Indefinite	25 years maximum
Renewal period	10 years	5 years
Cost if no objections and filings straightforward	£1,600	£800 (plus £400 for each subsequent design)
Speed to grant	4-6 months	2-4 months
Vulnerability to an invalidation claim because similar get up around	Unusual but possible	Possible
Need to acquire right from originator for trade mark/design	Not normally done but would be best practice	Yes
Does your own use of the get up before filing your application, destroy the right?	No	No – provided the application is filed in the first 12 months of using the design
Can you split up into a few countries if a problem in one	Yes	No

So, which is best?

Obtaining EU design rights and trade mark rights should not be considered mutually exclusive. Just because you obtain one form of protection, it does not mean that you should not also look to obtain the other form of protection. EU trade marks and EU registered designs are complementary forms of protection and obtaining both types of rights can add to your arsenal of protection.

Registered trade marks might offer more robust protection in terms of enforcing your rights against third parties because it will have been thoroughly examined by the CTM Office prior to the registration being issued, and it can last forever subject to the renewal fees being paid and the mark being used. However, a registered design is inexpensive and easy to obtain, multiple applications can be filed in a single application which is cost-effective, and most designs do not remain in their original form for more than a few years meaning the 25 year maximum is normally more than adequate. You'll have an official registration number to wave around, and it will be up to third parties to prove it is not valid/they do not infringe.

At Barker Brettell, we have a large group dedicated to designs and copyright, made up of a mix of patent and trade mark attorneys. Please contact designs@barkerbrettell.co.uk if we can be of any assistance.