

# EU trade marks vs community registered designs

## What is a registered trade mark?

A registered trade mark is a symbol or sign created in order to distinguish the products/services of one company from those of another.

## What is a registered design?

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

Increasingly there is an overlap between what can be protected as a registered trade mark and a registered design. Logos, 3D shapes for example are protectable via both routes. Businesses are increasingly focusing on protecting the “get up” of a product. “Get up” can be considered to be any aspect of the product which adds value to the offering itself which can include the overall packaging of the product and the branding style and thus which could be copied or used by competitors seeking to gain an unfair advantage.

## Why do you need to protect your work?

- Your brand or product underlies everything you have worked hard to achieve and are looking to exploit commercially
- Protecting your work ensures that you have the exclusive right to the brand/product in your industry and enables you to control who and how your brand or product 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 right than it would be on the basis of rights accrued through use

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## Which type of protection do you need?

Consideration	EU Trade Mark	Community Registered Design
Will it protect the "get up" of the product	Yes	Yes
Protect logos	Yes	Yes
Protect plain or simple words	Yes	No
Protect shape	Yes – but only if very distinctive or can file evidence of use	Yes
Restricted to certain goods	Yes – classes to be selected	No (although a search classification must be indicated)
Examination scrutiny	Rigorous	Formalities only
Objections from Office	Often – especially if shape	Mostly formalities
Opposition from 3 <sup>rd</sup> parties	Possibly – application published for 3 months	No
Duration	Indefinite	25 years maximum
Renewal period	10 years	5 years
Cost if no objections and filings straightforward (1 class)	£1,430	£830 and £350 for each subsequent design in the same application
Speed to grant	9-12 months	Same day - 4 months
Vulnerability to an invalidation claim because similar get up around	Unusual but possible	Possible
Need to acquire right from originator of Trade Mark/Design	Not normally done but would be best practice	Yes
Own use before registering destroys right	No	No for 1 <sup>st</sup> 12 months, yes after that
Can you split up into a few countries if a problem in one	Yes	No

## So, what is best for you?

A registered trade mark may offer the most robust protection in terms of enforcing your rights against third parties. This is because it will have been thoroughly examined by the EU IPO prior to the registration being issued. Simple words can be protected as well as logos and shapes and the protection is perpetual subject to the renewal fees being paid and the mark being used. There is no time limit to file a registered trade mark and thus it can protect established brands.

A registered design is quicker and easier to obtain as it is more akin to a deposit system (i.e. minimal examination). It is also very cost effective both in terms of protection across the EU and because multiple designs with the same Locarno class can be included in the same application. Since many products have a limited shelf life, at least in their original/current form, the shorter duration is often sufficient. 2D and 3D products are also equally registrable.

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