European
IPR Helpdesk

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# Fact Sheet
## *Design searching*

### December 2015

## Introduction

Design protection confers on the design holder an exclusive right to use a design - making, offering, putting on the market, importing, exporting or using the product in which the design is incorporated or to which it is applied - and to prevent third parties from using it commercially without its prior consent. In principle, design rights are acquired through registration within national or regional intellectual property offices. The European Union and some national legislations provide for unregistered design protection. Furthermore, in most European countries, original designs are subject to copyright protection, which arises automatically from the moment of the work's creation without registration.

For all the aforementioned forms of design protection the first-come, first-served principle applies[1]. Risks of investing in non-original design or filing an application for identical or confusingly similar design can be avoided or at least limited by performing design searching.

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[1] Unregistered design rights come into force when the design is made available to the public. Registered design protection begins when a filing date is granted.

This fact sheet focusses on the main characteristics of design searching as a best practice allowing companies and designers to keep up with the latest market trends and look at designs that may impede the possibility to acquire protection or infringe the rights on their design creations.

The rationale of searching design information and practical hints on how and where searching unregistered designs are outlined in the first part of the fact sheet.

This document also presents a short overview of the functionalities of some of the most commonly used design search databases, being the access point to registered design data.

## 1.    Design searching

### 1.1.  Why performing design searching

Design searching can be defined as a process of searching design databases or other sources of design information to determine the availability of a particular design in the context of registration procedures or in invalidity and/or enforcement proceedings, or to study designs' market development.

Indeed, in increasingly competitive markets, design searching is a way to carry out market monitoring on the last trend tendencies. Design innovative companies are often using design databases to look at the market perspectives in a specific commercial area.

More often, design searching is performed to discover whether a prior design forms an obstacle to the protection of a subsequent design. Furthermore, challenging the validity requires proof of the existence of an earlier identical or similar design that has been made available to the public as a result of publication following registration or otherwise (e.g. use in trade, exhibition). Therefore, design searching could be very useful in finding convincing evidences in case of litigation.

Design searching can be performed in order to _find out_:

> ➢ registered and unregistered designs[2];
> ➢ registered trademarks or other distinctive signs that by law confer on the holder the right to prohibit their use without prior authorisation;
> ➢ works, protected under copyright law if intended to be used in subsequent designs;
> ➢ whether a design is new and original (possesses individual character);
> ➢ whether the term of protection of a design expired;
> ➢ design protection strategy;

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[2] The owner of a registered or unregistered design can take legal action against anyone using an identical or similar design.

> ➢ existing competing design products.

It is important that the design searching is not limited to registered designs only. All previously disclosed designs, whether unregistered or registered, are considered prior art[3] and thus could threaten the protection of identical or similar subsequent designs.

If as a result of comparison, every element of the appearance of a subsequent design can be found in an earlier design, the two designs will be considered identical and the subsequent will consequently lack novelty[4].

If two designs are not identical but look very similar, the overall impression which the subsequent design produces to the informed user must be different from that produced by earlier designs taken individually. The comparison should focuses on features which are distinctive, arbitrary and visible during normal use. As regards the notion "informed user", it refers to a person (imaginary user) with knowledge of designs in a particular field of activity, but not necessarily a designer, technical expert, manufacturer or seller.

The design searching should also cover trademarks or other distinctive signs, as well as copyrighted works, if they are to be used in subsequent designs. Indeed, a design can be contested and declared invalid if it is in conflict with prior design or if it makes unauthorised use of an earlier distinctive sign or a work protected by copyright.

Bear in mind that a prior art search can never be exhaustive.

The prior art is limited neither in time nor in geographical territory.

Do not limit your search to a particular territory: any design that has been made available to the public anywhere in the world and at any time must be taken into account if it is reasonable to believe that it has become known in the normal course of business to the circles specialised and operating in the specific sector concerned.

Some creations are not subject to registration or the registration is not made publicly available once protection is granted.

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[3] It is generally acknowledged that a design which has been made available to the public anywhere in the world become part of the state of the art. Publications in official registers and bulletins, websites, exhibitions, use in trade constitute public disclosure of a design.
[4] Although, the definition of novelty vary in the different jurisdictions, a design will be considered new if no identical design has been made available to the public before the date of filing of the application for registration or the date of priority if claimed. This means that the new design needs to vary in more than just "immaterial details" from other existing designs.

## 2.    Searching unregistered designs

Throughout the European Union a new design with an individual character is automatically protected as an unregistered Community design. This form of design protection also exists in some national jurisdictions – e.g. the United Kingdom.

Unregistered designs are not subject to official publication and thus cannot be found by searching design databases. However, information on unregistered designs can be obtained by consulting existing literature, design catalogues, websites, by visiting trade fairs and exhibitions or by conducting a search within the circles specialising in a specific business sector.

Furthermore, companies and designers are in principle aware about the current design trends and could use this knowledge to assess the novelty and originality of a particular design.

## 3.    Design search databases

Designs can be registered with national, regional or international intellectual property offices and thus design registrations are published in different registers[5]. They are the primary official source of registered designs data when performing design searches. Businesses can consult IP information - designs and other related data, by accessing the registers of the relevant offices. However, searching registers individually could be a complicated and time consuming exercise since the data are accessed separately, in different languages, under different layout etc.

For this reason design databases present a helpful searching tool offering the possibility to search simultaneously in large collections of design data.

The following paragraphs outline the characteristics of the European Union Intellectual Property Office (EUIPO) and the World Intellectual Property Organization (WIPO) design search databases[6].

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[5] New international registrations, renewals, and modifications affecting existing international registrations are published in the International Designs Bulletin, which is the official publication of the records of the International Register of the Hague System.
The Community designs Bulletin contains data regarding registrations, amendments, renewals, transfers, licences of Community designs.
National registrations are published in the official registers of the relevant national offices. Their characteristics are not subject of this fact sheet. Information can be found on the website of each office, on the Innovaccess website or by contacting the relevant IP office directly.
[6] Given the variety of the multitude existing national design search databases, their functionalities cannot be examined in details within a fact sheet.

### 3.1. Designview (EUIPO)

Designview is a free of charge, multilingual database which gives access to design applications and registrations through a single online platform. The information is available in 32 languages, including all 23 official EU languages plus others like Arabic and Russian). Designview is a centralised database and search engine for both Registered Community Designs and national applications and registrations from 39 participating IP offices (including most EU member states, plus Korea, Japan, US, Tunisia, Turkey, Russia, Morocco, Mexico and Canada). The design information included is held and provided by participating national IP offices, EUIPO and WIPO[7].

For searching through the design registries of ASEAN countries, there is also ASEAN Designview, which hosts data from 10 participating countries based on the same interface structure in order to facilitate searching in the same way[8].

The Designview interface offers two search options: basic search and advanced search.

### 3.1.1. Basic search

The basic search is based on single criterion that is *the identification of the product* in which the design is incorporated or to which it is applied. In Designview a product can be identified either by *keywords* or by their corresponding classes and subclasses in the Locarno classification, which is the international classification system for industrial designs[9].

EUIPO has developed a search tool called EuroLocarno, which automatically classifies products into the correct classes and subclasses and searches for the indication of products and their corresponding classification in the EuroLocarno database. It is based on and has the same structure as the Locarno Classification and is available in all the official EU languages (no need to translate the terms searched).

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[7] Although the data is accessible via a centralised system each office remains the owner of the data and is responsible for its accuracy. Thus, Designview reflects with certainty the design registers of the participating offices or organisations at the moment of consultation.

[8] Countries participating to ASEAN Designview are: Brunei Darussalam, Indonesia, Cambodia, Lao PDR, Myanmar, Malaysia, Philippines, Singapore, Thailand and Vietnam.

[9] The Locarno classification is administered by the WIPO and it serves administrative purposes. Indeed, it allows both classifying products indicated in design applications and searching registered designs. Neither the indication of products nor the classification affects the scope of protection of a design as such.

The current (tenth) edition is in force since January 2014 and incorporates all the revisions made in and before October 2012. It contains 32 classes, 219 subclasses and an alphabetical list of more than 7,000 products. The alphabetical list is presented in two parts: the first part lists all the goods in a single alphabetical list, with indication of the class and subclass to which each good belongs; the second part lists the goods in alphabetical order within each subclass. The explanatory notes are incorporated in the list of classes and subclasses.

Once you digit a given term a results list appears; the gallery mode lets you visualise images in a gallery; you can also further define your search by selecting specific filters.

Enter the term you want to search for in the search field and click on the "Search" button. The search field has an auto-complete function when a key word is typed.
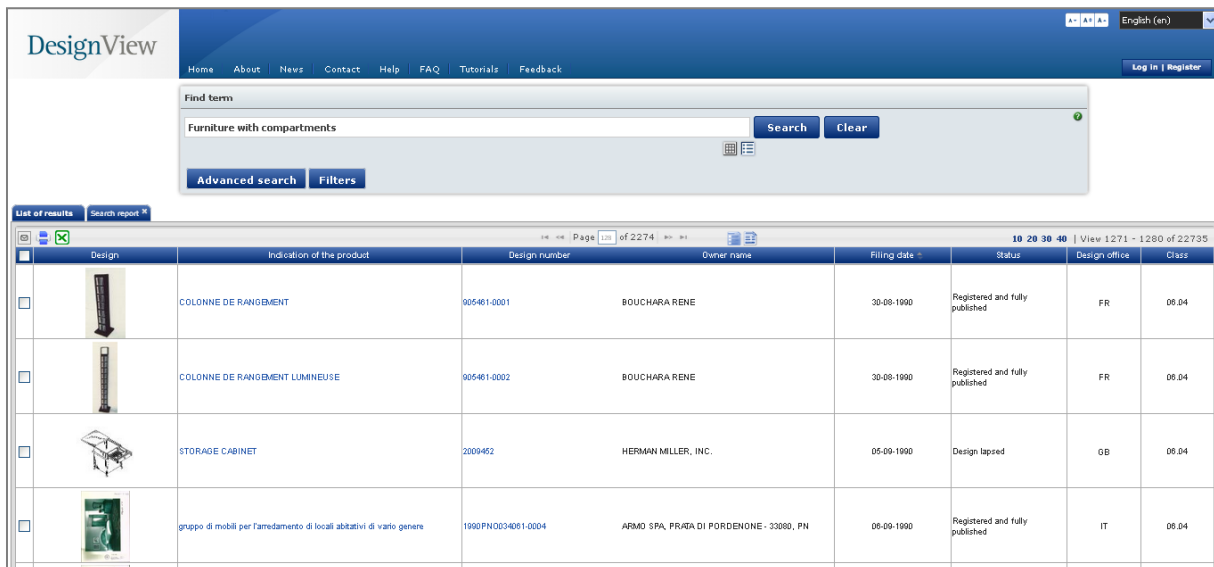


The list of research results is then displayed.



To refine your search, choose the class you want to search in via the drop-down menus above the search field: "Advanced search" and "Filters"; For example, select class 25.03 (Houses, garages and other buildings), and then click on "Filter":

### 3.1.2. Advanced search

Advanced searches use multiple search criteria such as the product type, the Locarno class, the application number, the design status, the owner/designer name separately or in combination[10].

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[10] The asterisk (*), question mark (?) and double quotation marks (" ") are special wild-card characters with specific functions that can be used in this mode. For further information, please consult the Help section of the DesignView webpage.

You can either:

- use directly the advanced search mode and add words in the "Indication of the product" (title) field to narrow down the hits, or;

- perform a search in the basic mode and then refine your search by using additional searching parameters.

In the advanced search mode, no automatic suggestions in the "Indication of the product" field are provided by the database.

If you chose the "Strict mode", the system will look for exactly the same words as entered into the field. If you choose the "Contains mode", your results list will be extended to all designs including the searched terms.

You can request the system to sort results by various criteria.

## 3.2. The Global Design Database (WIPO)

The Global Design Database is a world-wide data collection of industrial designs registered under the WIPO-administered Hague System and/or in participating national collections. This database enables free access to design data by multiple criterion searching. Users can choose searching designs by type of product, identification of the owner (creator) of the design, application and/or registration number and date, countries, where protection is sought/granted[11].

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[11] Detailed explanation of the Global Design database searching criteria are available on the WIPO website.

## 3.3. The Hague Express Database (WIPO)

The [Hague Express Database](#) includes bibliographical data and international design registrations (reproductions of industrial designs) that have been recorded in the International Register and published in the International Designs Bulletin[12].

The database is structured in searchable areas and fields[13]. The "Search by field" is divided into five separate tabs with specific search capabilities – i.e. Design, Names, Numbers, Dates and Country. Each field supports the same set of operators and wildcards, and provides automatic suggestions for terms.

In the Hague Express Database, search queries are performed by using terms and operators. Terms can either be single words (e.g. dress) or a multiple words surrounded by quotes (e.g. "camera carrier"). The database provides with suggestions as to potential matching terms. Terms can then be modified or combined together in a more complex query using different types of operators (e.g. simple logical operations to combine terms – "AND, OR, NOT <term>, "grouping operators - (<term> OR <term>) AND <term> etc.).

### 3.3.1. Search by design

The "search by design" tab allows searching for terms directly related to the design. Three fields are contained in this tab: indication of products, Locarno class and description that lets you search for any text related to the description of the products included in the design registration.

"Locarno Class" lets you search designs according to their Locarno classes.

"Description" lets you search for terms in the description provided in the registration.

For example, a search for "office furniture" in the Locarno 06-05 (composite furniture, dressing table, school desks with attached seats) provides the following results:

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[12] Note that the only official publication remains the International Designs Bulletin.
[13] A complete description of the functionalities of the Hague Express Database is available [here](#).

Please note that the current search is reminded just before the results listing. To remove a search criterion just delete it from your "Current search" and reintroduce new ones.

Four additional search options are available:

➢ Names search (Holder, Creator or Representative);
➢ Numbers search (Publication Number, Application Number);
   Note that for collections that don't have separate application and publication numbers (Hague, for example), searching in either field will produce the same results.
➢ Dates search (filing, registration, publication, priority);
➢ Country Search.



The search results can be filtered and the search narrowed to only particular categories without entering additional search terms. Different types of filters are divided into separate tabs and specific information and hints are available for

each individual tab: Designation, Locarno Class Registration Date or Applicant's Contracting Party.



## 4.    Analyses of the design searching results

The results of design searching can show that there is no risk of applying for registration or start using a particular design in business.

On the contrary, if a design produces the same overall impression as registered or unregistered one, the following options exists:

> ➢ negotiating with the owner of the earlier design an agreement regulating the coexistence of the designs;
> ➢ filing an application and risking an invalidity action. Indeed, the existence of an earlier design does not prevent from applying, but it does include the risk of invalidity or infringing actions;
> ➢ challenging the validity of the earlier design on account of its lack of novelty or individual character;
> ➢ no further actions when the risk of conflict is significant.

However, assessing which option will be suitable depends very much on the particular search results. Therefore, when interpreting the research results and deciding on the actions to be taken, it is recommended to seek a professional advice.

## Useful documents

Designview tutorial

https://www.tmdn.org/network/

The Locarno classification

http://www.wipo.int/classifications/nivilo/locarno10/index.htm?lang=EN

Global Design Database

http://www.wipo.int/designdb/en/designdb-help.jsp

The Hague Express

http://www.wipo.int/designdb/hague/en/designdb-help.jsp

List of databases for design search

http://www.ip-centre.org/industrial_design_search_databases.html

## GET IN TOUCH

**For comments, suggestions or further information, please contact**

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