

# Communication No 12/02 of the President of the Office of 5 December 2002

## concerning professional representatives in design matters

### I. Professional representation in design matters

Article 78 (1) of the Community Design Regulation (CDR) provides that representation of natural or legal persons in proceedings before the Office under the Community Design Regulation may only be undertaken by legal practitioners subject to certain conditions, professional representatives entered on the list pursuant to Article 89 of the Community Trade Mark Regulation (CTMR), or persons whose names are entered on the special list of professional representatives for design matters.

#### 1. Representation by legal practitioners

Pursuant to Article 78 (1)(a) CDR, legal practitioners are entitled to act as professional representatives in design matters before the Office

- if they are qualified in one of the Member States,
- if they have their place of business within the European Community, and
- if they are entitled in the Member State where they are qualified to act as representatives in industrial property matters.

The Office has previously established (cf. Communication No 2/99 of the President of the Office of 7.5.1999, OJ 1999, 1003) that legal practitioners may act as representatives before the national offices of all Member States in trade mark matters. Since Article 78 (1) (a) CDR refers to the entitlement to act as a representative "in industrial property matters", and trade mark matters are included among them, legal practitioners from all the Member States may therefore also act as representatives before the Office in design matters.

#### 1. Professional representatives

Professional representatives fall into the category of representatives entered on the list of representatives for trade mark matters pursuant to Article 89 CTMR and representatives entered on the special list for representation in design matters pursuant to Article 78 (4) CDR.

##### a) Professionals on the list for trade mark matters

Pursuant to Article 78 (1)(b) CDR, the entry on the list of professional representatives pursuant to Article 89 CTMR automatically confers the right to represent also in design matters before the Office, regardless of whether the requisite qualification or experience of the representative comprises design matters.

##### b) Representatives on the special list

Representatives in order to be entitled to represent in design matters must be

- nationals of one of the Member States, and
- have their place of business or employment in the Community.

Furthermore, they must be entitled to represent in design matters before the respective national office or

the Benelux Design Office. The same as in Article 89 CTMR, in order to be entitled to represent before the Office in design matters, the representative must fulfil one of the following additional criteria, namely

- have obtained special professional qualifications in a Member State,
- have at least five years habitual exercise of the profession in a Member State, or
- where in the Member State the right to represent is not conditional upon having special professional qualifications, but there is nevertheless an official recognition of professional qualification, have obtained such qualification, in which case the five years exercise is dispensed with.

Pursuant to Article 78 (6) CDR, the President of the Office may grant exemptions from the requirement of nationality in special circumstances and from the requirement of five years experience or recognition of professional qualification if the requisite qualification has been acquired in another way.

As compared to representatives on the trade marks list, the place of business need not necessarily be in the Member State of their entitlement.

#### a) The nature of the special list

In view of the link with the right to represent in trade mark matters, the special list of representatives in design matters referred to in Article 78 (1) (c) and (4) CDR is of a subsidiary nature. The Office will refuse all applications for entry on the special list coming from persons who are already on the list provided for in Article 89 CTMR. Similarly, applications will be refused where they come from persons who are obviously entitled to entry on the trade mark list. Finally, entries on the design list will be cancelled once the same person is entered on the trade mark list. As regards legal practitioners, they will also not be accepted for the design list. The details are explained in Communication No 10/02 of the President of the Office of 28 June 2002 (OJ 2002, 1636).

#### d) Situation in the Member States

##### (1) Countries with special professional qualifications

Professional representatives from Member States where there are special professional qualifications required for the exercise of the profession may not be entered on the special design list because in all the Member States involved their entitlement is general and also entitles to represent in trade mark matters. These professionals thus have the right to be entered on the trade mark list.

This is the case for professional representatives qualified in Austria ("Patentanwälte"), Germany ("Patentanwälte" and "Patentassessoren"), Portugal ("agentes da propriedade industrial") and Spain ("agentes de propiedad industrial").

##### (2) Countries with officially recognised professional qualification in designs matters

A special professional qualification in the sense of the third alternative mentioned above to represent in design matters, which is different from the qualification required to represent in trade mark matters, exists in Ireland ("patent agents") and Italy ("consulente in brevetti", who are in their country on the "patents" list).

Similarly, registered patent attorneys (or patent agents) from the United Kingdom, who need professional qualifications in order to be entitled to use that title, may be entered on the special list in design matters without the requirement of having exercised the representation for at least five years.

### (3) Countries with officially recognised professional qualification in trade mark matters

In the following countries, a special professional qualification (in industrial property matters or trade mark matters) exists that entitles to be entered on the list provided for in Article 89 CTMR: Luxembourg ("conseils en propriété industrielle"), Netherlands ("octrooigemachtigden"), France ("conseils en propriété industrielle") and United Kingdom ("trade mark agents"). These persons will not be entered on the special list of representatives in design matters referred to in Article 78 (1) (c) and (4) CDR.

All other representatives from these countries may be entered on the special list if before the national office (or in the case of the Benelux countries, before the Benelux Designs Office) they have habitually acted in design matters for five years.

### (4) Countries without officially recognised professional qualification in industrial property matters

Representatives from Belgium, Denmark, Finland, and Sweden may be entered on the special list if they have habitually acted in design matters for five years before the national office or in the case of the Benelux countries, before the Benelux Design Office.

### (5) Other countries

As regards Greece, the special list in design matters is also not available to persons from that country because there only legal practitioners are entitled to act as professional representatives.

## II. Application for entry on the special design list

From now on, applications for entry on the special list of professional representatives in design matters may be filed with the Office. To this end, the application form which is reproduced in the annex to this Communication must be used. The applicant must fill in the form and must present it to the competent national office of the Member State in which his entitlement to represent in design matters exists. As regards Belgium, Luxembourg, and the Netherlands, the competent office is the Benelux Design Office. The competent office will have to issue the required certificate. The applicant or the office will then have to send the application form together with the certificate to the OHIM. Further information about the conditions for being entered on the special list of professional representatives in design matters and the procedure to be followed are contained in the note on the application form.

The application forms may be copied from the Official Journal of the Office, printed from the website of the Office, or obtained from the national offices.

Applicants must always obtain an individual certificate from the competent office since the offices will not issue block certificates for the special list of professional representatives in design matters.

## III. Authorizations

### 1. General and individual authorizations

General Authorizations which have been registered by the Office cover the right to represent in all proceedings before the Office, and this includes proceedings concerning registered Community designs. A General Authorization cannot be restricted to proceedings in design matters or trade mark matters. Any authorization which contains such a restriction will be treated as an individual authorization which is valid for the proceedings in which it has been filed. General Authorizations may also be filed by

representatives who are on the special list of professional representatives for design matters, notwithstanding the fact that their right to represent is limited to proceedings concerning registered Community designs.

## 2. Use of authorizations not mandatory

In proceedings concerning registered Community designs, it is not mandatory to file a written authorization. Representatives are therefore advised not to file authorizations. Also, references to existing General Authorization are not required. In design proceedings, as a general rule, there will be no examination whether or not an authorization has been granted.

## IV. Correspondence

All correspondence in matters of professional representation should be addressed to the

Office for Harmonization in the Internal Market (Trade Marks and Designs)

Administration of Trade Marks and Designs Department

Professional Representation Service

Avenida Europa, 4

E-03080 Alicante

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