



AdamsonJones

Taking care of your IP

Design Protection A Brief Guide

Design protection in the UK and overseas

A summary of the issues and procedures involved in protecting designs

What is a design?

The design of a product refers to the outward physical appearance of the product, and is what makes it attractive and therefore appealing to customers. Hence, the design contributes to the commercial value of the product, and increases its marketability.

The design of a product may be simultaneously protected by an Unregistered Design Right (UDR) and/or by a Registered Design. Such forms of Intellectual Property Right (IPR) are independent of other forms of IPR, such as patents, trade marks and copyright.

What is a registered design?

In many cases, it is possible, and advisable, to register the design of a product. Registration provides much greater protection than relying on unregistered design rights.

A design, which may be registerable, refers to the outward physical appearance of the whole or part of a product. The physical appearance is determined by the lines, contours, colours, shape, texture, or materials of the product, or its ornamentation.

Hence, the definition of a registerable design includes both the 2-dimensional pattern, decoration and ornamentation on the surface of the product, and also the 3-dimensional shape and configuration of the product. The 2D and 3D design of a single product may be simultaneously protected. For example, a chair having an unusual shape, and also having an unusual surface decoration, may be protected by both a 3D and a 2D registered design simultaneously.

What is meant by a "product"?

A "product", which may bear a registerable design, refers to any industrial or handicraft item. Examples include medical devices, office tools, household appliances, furniture, vehicles, leisure goods, and luxury items, such as jewellery, and so on.

A product may also include packaging, get-up, graphic symbols, typographic type-faces, and component parts intended to be assembled into a complex product.

What protection does a registered design provide?

The owner of the registered design has the legal right to prevent a third party from making, using, stocking, distributing, selling or importing any product in which the registered design is incorporated, or to which the design has been applied. Any of these actions is called registered design infringement.

Registered designs are usually enforced in a Court, which has the authority to stop design infringement. The benefit of protecting your design with a registered design is that you can prevent third parties from reproducing your design directly, even if they arrive at your design completely independently, ie by accident. Hence, design registration is a true monopoly right, providing much stronger protection than unregistered design right (discussed below), and being much easier to enforce as there is no need to prove that copying has taken place.

Importantly, a registered design is not restricted to any specific product; it is the design (2D or 3D) which is protected, and not the product. Furthermore, the registration protects the design when it is applied to any product, whether or not it is related to the product that you have applied the design to. For example, if you design a new 3D shape for a telephone, then infringement would be found if someone used the same design for some unrelated product (eg a kettle) without your permission.

What are the requirements for a design to be registered?

In order to be validly registered, the design must: (i) be new; and (ii) have “individual character”.

A design is considered to be new if it has not been disclosed anywhere in the world before the filing date of a registered design application, except when the disclosure could not have become known within the European Economic Area (EEA). However, a grace period is available, which in some cases may enable a valid registration to be obtained provided that a registered design application is filed within 12 months of the earliest disclosure of the design. However, this grace period should not be relied upon because pre-filing disclosure is likely to prejudice valid design registration in many foreign countries. Therefore, if the design has been disclosed, please contact us immediately so that we can advise you.

A design is considered to have “individual character” if the overall impression it makes on an informed user is sufficiently different from any pre-existing design already in the public domain.

Component parts of a “complex” product may be independently registerable. For example, a tea pot and its corresponding lid may be protected with two different registered designs provided that they are new and have individual character. Hence, a number of designs may be registered for any single product.

One requirement for a valid design registration for a component part of a complex product is that the component must be visible during its normal use. Maintenance or repair of a product, for example changing a car engine valve or piston, is unlikely to constitute normal use, and so the valve or piston would not be registerable. However, a car gear shift lever, which would be visible during normal use, should be registerable, provided that it is new and has individual character.

What types of product cannot be registered?

The Registered Designs Act precludes certain types of design from registration. For example, a purely functional design, ie one where the design of a product is dictated solely by its function, may not be registered.

Also, any feature of a design, the shape of which is dictated by the shape of another product to which it is either attached or is in some way related, is not protectable by registration. For example, while it may be possible to register the individual designs of a tea pot and its lid per se, those aspects of their shape that enable them to fit together would not be registerable.

How do I register my design?

It is possible to protect the design of a product with either a registered UK design or a registered Community design. A UK registered design provides protection in the UK only, and costs from about £410 plus VAT. It is possible to include an unlimited number of designs in the same application, provided that each design is for the same or broadly similar products. The cost of the additional designs in a single application is substantially reduced. Applications are made to the UK Designs Registry.

A Community registered design provides simultaneous protection in all member states of the European Union.

The cost of a Community design application is from about £995 plus VAT, and applications are made at the European Union Intellectual Property Office (EUIPO) in Alicante, Spain. Furthermore, as for GB design applications, it is possible to include an unlimited number of designs in the same Community design application, provided that each design is for the

same or broadly similar products. The cost of the additional designs in a single application is substantially reduced. We believe that a Community design registration provides excellent value for money, particularly when multiple designs are included in the same application.

In order to file an application for a registered design, we will need to prepare a set of representations for each design included in the application. You can either provide us with a set of drawings, or we can take digital photographs of the product bearing the design. It is important to note that no official examination is carried out on any application to register a design. Therefore, a design application will quickly and automatically proceed to registration, irrespective of whether or not the design satisfies the requirements of registerability (ie it is new and has individual character). Once the design has been registered, a registration certificate quickly issues.

The initial period of protection for a registered UK or Community design is five years. However, provided that renewal fees are paid every five years, it is possible to extend protection up to a maximum of 25 years from filing.

How do I enforce my registered design?

Because no official examination is carried out on the registered design application, the validity of a registered design is decided in the national Courts. Therefore, if someone infringes your registered UK or Community design, you have to bring a legal action against the third party, in the course of which the corresponding national Court will assess the validity of the registration. The alleged infringer is likely to attack the validity of the registered design, for example, by claiming that the design was either not new or lacked individual character.

If the Court decides that the registration is valid, they will then assess whether or not the design has been infringed. The key test for design infringement is whether the alleged infringing design is identical to, or gives the same overall impression as, the registered design, in which case infringement will be found.

The Court has the power to: (i) grant an injunction to stop the infringer; (ii) award damages in respect of financial losses resulting from the infringing activity; and (iii) order the infringer to pay a proportion of the legal costs incurred.

How do I obtain registered design protection overseas?

Registered design protection across all of the member states of the European Union can be conveniently and cost-effectively obtained with a registered Community design. However, for countries that are not in the EU, separate national design applications must be filed in each country of interest. The term of registered design protection, and the various criteria for testing whether a design is registerable or not, vary from country to country. Also, in many countries there is no grace period permitting the design to be disclosed before an application for registration has been filed.

However, fortunately, most countries are party to the Paris Convention, an international treaty which enables design protection to be obtained overseas, provided that foreign design applications are filed within 6 months from the UK or Community filing date. The foreign design applications are effectively back-dated to the date of the initial UK or Community design application. Hence, filing a UK or Community design application effectively gives you the option of obtaining design protection in most countries of the world, so long as foreign design protection is sought within 6 months from the priority date.

In order to file a foreign design application, we use the services of a local attorney in each country of interest. We have a large network of foreign associates, who assist us by filing and prosecuting design applications in their home countries on behalf of our clients.

The cost of filing a national design application varies from country to country. For a typical case, the cost of filing a national design application is from £750 to £1,250 plus VAT, including official fees and foreign attorney charges.

Once the national design application has been filed at the local Designs Registry, it must be prosecuted through to registration, and this may take up to a year in some cases.

Prosecution costs can range from about £250 to £850 plus VAT for a typical case in most countries. In order to keep a registered design alive, it is necessary in most countries to pay renewal fees, commonly every five years, with the possibility of obtaining a maximum period of protection of 25 years from filing in some countries.

What is an unregistered design right?

In addition to a registered design, a product may also be protected by Unregistered Design Right (UDR). It is important to note that the design of a product may be simultaneously protected by UDR as well as by a registered design.

However, whereas 2D and 3D designs of a product may be protected in a design registration, only the 3D shape and configuration of a product can be protected by UDR, ie UDR does not protect the 2D surface decoration of a product.

There is no registration system for UDR because UDR arises automatically as soon as the design has been created. Accordingly, obtaining UDR is completely free.

The term of protection for UDR in a product is 15 years from the end of the year in which the design is created or 10 years from the end of the year in which the first sale of the product occurs, whichever term expires first.

However, licences are available as of right for the last 5 years of UDR protection. This means that anyone can then obtain a licence to reproduce the design protected by your UDR on mutually agreed terms, for example, upon payment of an annual licensing fee or a lump sum payment.

In order to assist in calculating the term of UDR protection for a design, we recommend designers safely store at least the first original copy of any design. Such copies should ideally be dated, signed by the designer and also witnessed by an independent witness (such as a Notary Public). This may make it easier to prove that UDR existed in the design on a particular date, and also assist in calculating the term of UDR protection. This could be important should infringement of the UDR occur, as you will need to establish, possibly in a Court of law, that UDR subsisted in the design at the time of the alleged infringement.

What is Unregistered Community Design Right?

In addition to the UDR that is available in the UK, Unregistered Community Design Right (UCDR) may also be available. UCDR arises automatically, is free to obtain, and protects the 3D shape and configuration of a design across all the member states of the European Union.

The term of protection of UCDR for any product is, however, only 3 years from the date on which the design was first made available to the public within the European Community. This includes any non-confidential publication, exhibition, or use in trade.

The period of three years may run in parallel with the registration process for the same design. In cases where the 12 month grace period has been relied upon to obtain a valid

registered design, the 3 year UCDR term may come into effect. However, when the grace period has not been used, the UCDR is of little or no additional value after registration.

How do I enforce my unregistered design rights?

UDR may be enforced in a Court, which has the authority to assess whether or not UDR subsists in your design, and, if so, whether a third party has infringed your UDR. Therefore, if someone infringes your UK or Community UDR, you have to bring a legal action against the third party, in the course of which the Court will decide whether UDR subsists in your design.

If the Court decides that a design is protected by UDR, they will then assess whether or not the design has been infringed. For infringement to be found, the UDR owner has to demonstrate that actual copying of the design has occurred, and this can be difficult in some cases. UDR cannot be enforced if a third party has produced the design completely independently. Hence, UDR protection in the UK and across the Community is of limited value, and for this reason, we believe that unregistered design rights should not be relied upon as the sole form of design protection for any product. We therefore recommend that the design is protected with a registered design, if at all possible.

How can AdamsonJones help?

We would be happy to discuss your designs, and advise you concerning registered and unregistered design protection in the UK and overseas. Please feel free to contact us to arrange a meeting.

NB: We have endeavoured to ensure that the information in this note is accurate and up-to-date. However, this note is for general guidance only, and is not a substitute for professional advice.

March 2017

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