

Marks&Clerk



A Short Guide

Designs

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What is a design?

A design is the physical appearance of a product, as opposed to the way it has been technically constructed or how it operates. Design law focuses on the appearance of a product and/or its components, both individually and taken as a whole.

Why protect the design of a product?

Often the physical appearance of a product, not its mere technical performance, is an important commercial factor. The design of a product can distinguish it from competitor products and a high premium can be charged for good design – this applies to a whole range of products from cars and watches to kitchen appliances.

How do I protect my design?

Design protection is additional to and independent of any other form of protection such as patents or trade marks. There are a number of forms of design protection in the UK, and a number of different rights may be available for a single design. The types of design protection are conveniently divided into registered rights and unregistered rights.

What are unregistered rights?

Unregistered rights exist automatically, and there are no registration formalities. The main unregistered rights are UK Design Right and the Unregistered Community Design Right. However, in certain cases copyright can also be relevant.

The drawback with all unregistered rights is that in order to prove infringement you have to show that the design has actually been copied. This can often be rather difficult. It can also be surprisingly difficult to show that you actually own the right in question and that it has

not expired. Therefore, we strongly recommend that you protect your designs using registered designs and unregistered rights should only be used as a last resort.

What are registered rights?

There are two registered rights available in the UK. A UK Registered Design has effect in the UK only, and is applied for at the UK Designs Registry, part of the UK Patent Office. The Community Registered Design applies in all 27 member countries of the European Union, and is applied for at the Office for the Harmonization of the Internal Market (OHIM) in Alicante.

Is the law the same for both the UK and the Community Registered Design?

The substantive law, such as the criteria for registrability, for both the UK Registered Design and the Community Registered Design, is identical. Furthermore, the procedures for obtaining both rights are now very similar.

Both the UK and the Community systems now permit the filing of an unlimited number of designs in the same application. In the case of a Community Registered Design, a multiple application is only allowed provided that the designs are in respect of the same or similar types of products, whereas in the case of a UK Registered Design, there are no restrictions on the types of products allowed in a multiple application. In both cases a multiple design is cheaper than applying for each design separately. The greater geographical coverage of the Community Registered Design means that most applicants tend to apply for the Community Registered Design rather than for a UK Registered Design.

What can I protect with a UK or Community Registered Design?

Registered Designs are intended to protect the appearance of the whole or part of a product, resulting from the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation. Both two and three dimensional features can be protected, and even primarily literary and artistic materials, such as posters, can now be registered.

As a design can be the appearance of the whole or a part of a product, you should give careful consideration before filing as to the new features you are looking to protect. Often, for a single new product, an applicant may apply to register a number of designs, in relation to the appearance of the product as a whole, and in relation to several individual new features. The availability of multiple designs in a single application in the Community Registered Design system makes this particularly attractive.

Features which are solely dictated by their technical function cannot be registered. Also, features which must be the shape they are so as to be mechanically connected to another product to enable either product to function cannot be protected. An example of this is a screw thread or bayonet fitting for a light bulb. There is a limited exception to this rule for modular designs such as modular furniture and children's toy brick systems.

The design may be intended for use on any product including any industrial or handicraft item, and even packaging, graphic symbols and typographical typefaces. Logo-type trade marks can also in principle be registered as designs. However, buildings are not considered products for the purpose of design registration.

It is important to note that Registered Designs can be obtained not only for “designer” products such as jewellery and fashion clothing, but also for more “ordinary” products such as street lamps, toothbrushes, tyre treads and electrical conduits.

What are the criteria for registrability of UK and Community Registered Designs?

Provided that the formal requirements are met, a UK or Community Design application will proceed to registration automatically, whether it in fact satisfies the criteria for registrability or not. However, in order to be validly registered, the design must be new, and must have what is called “individual character”.

A design is not new if it has already been published anywhere in the world, except where the disclosure could not reasonably have become known within the European Economic Area. However, a disclosure by the designer or his successor in title of the design within the 12 months preceding the filing date is ignored for these purposes. This is usually referred to as a grace period. It is inadvisable to rely on the grace period, because such a disclosure may prevent registration in other countries. Also, there may be difficulty in proving that a pre-filing disclosure was genuinely made by the designer or their successor in title.

A design is considered to possess individual character if it produces a different overall impression on the informed user from any prior design which has been made available to the public. The courts have indicated that the informed user is aware of the kinds of designs in a particular field as well as the constraints under which a designer in that field operates.

As a result, in general terms, a design must not be a mere commonplace variant on existing designs.

However, in design fields in which there has been a lot of similar activity, or when technical constraints limit the design freedom, small differences can provide the necessary individual character.

Am I entitled to register a design?

If you are the owner of the design then you are entitled to register it. The designer is the owner of the design, unless the design was made by an employee during the course of their employment, in which case the design belongs to the employer. The situation with commissioned designs is rather complicated. For the UK Registered Design, a commissioned design belongs to the commissioner. However, for the Community Registered Design, the right to a commissioned design remains with the designer, and if the commissioner wishes the right to apply for a Community Registered Design, then an assignment must be obtained. It is important to ensure that ownership issues are sorted out before a design is applied for.

How do I apply for a UK or Community Registered Design?

To apply for a UK or Community Registered Design, an application form with representations showing the design must be filed at the relevant Designs Registry. It is necessary to indicate what product the design is intended to be applied to, but this indication does not limit the scope of protection.

Because there is no examination in respect of novelty or individual character, UK and Community Registered Design applications proceed to registration relatively quickly, usually within a few months.

Where does a Registered Design extend?

A UK Registered Design gives protection only in the UK and a few overseas territories and commonwealth countries. A Community Registered Design covers all of the EU including the UK. If you want protection in other countries, you must file separate applications. However, under an International Convention of which most countries are members, a design in another country can be applied for within 6 months of the initial UK or Community application, and then benefit from the same filing date (called the priority date) as the first application.

There has been relatively little harmonisation of design law worldwide and the law can vary greatly from country to country – for example, in respect of the length of protection which can be obtained and the criteria for registrability. In particular, the grace period from disclosure by the designer does not apply in all countries.

How can Marks & Clerk help?

Marks & Clerk advises on all aspects of intellectual property. For more information and to find out how we can help you register and protect your designs and manage your design portfolio, contact your usual Marks & Clerk attorney or a member of our designs team at your nearest Marks & Clerk office. Full details are on our website www.marks-clerk.com.

The information within this guide is intended to provide a summary of the subject matter. Readers should not act or rely on information contained in this guide without first obtaining specialist professional advice.

