



an introduction to design

Rights in design can exist in many forms but primarily they will fall into two categories, registered designs and unregistered designs.

Registered designs

Registered design rights can exist over the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.

These rights will allow the user a monopoly over the use of the design and will provide enforceable rights for that user against an infringer for up to 25 years from the date of initial registration.

In the UK, designs can be registered by several different methods; as a UK registered design, as a European Registered Community Design (RCD), or as a UK or Community registered trade mark for shapes.

Before filing an application to register a design, it is possible to carry out a search of the Register to check that the same design is not already registered. A basic search will indicate whether any identical or similar designs have already been applied for.

Unregistered designs

Unregistered design rights (sometimes known as 'Design Rights') are the right to prevent copying of the design. It does not require registration and is valid for a maximum of 15 years.

To be protected, the design must comprise of an aspect of shape or configuration (internal or external) of the whole or part of an article, it must be original and not commonplace, and it must be recorded in a design document or be the subject of an article made to the design.

This guide provides an overview of the benefits of each type of design.

A European Registered Community Design will provide protection for your design in all of the countries in the European Union.

How do I register a design?

To be registrable your design must be:

1. New (or novel) this means that it must not be the same as any design which has already been made available to the public;
2. Have an individual character – this means that the overall impression of the design must be different from the impression given by any previous design; and
3. Not already available to the public, although the Designs Registry does allow a twelve month grace period on this.

Our fees for filing an application in the UK in one class are approximately £250 plus VAT which includes all official fees payable to the Registry. If objections are raised by the Registry or by third parties, further costs may be incurred.

Once the application is received by the Registry, it will be examined and a report issued to indicate whether the design is acceptable. If there are no objections to the design, it will be published in the Patents & Designs Journal and can then be registered about three months after initial application.

What type of designs will the Registry object to?

Certain designs are *excluded* from being registered, these include:

- designs which are simply a functional design. This means that where the design needs to be a specific shape to create a technical effect, the shape cannot be registered as a design. The main reason for this is that other competitors should not be prevented from creating similar products. A patent is the best way of protecting these types of rights;
- designs which form the internal parts of a complex product and are not visible in normal use including computer programs or vehicle spare parts;
- designs which are contrary to law or morality or are otherwise offensive;
- designs which include the use of certain protected flags or international emblems.

Can I register my design internationally?

At present there is no world-wide registry. There are several alternatives available for registration in foreign countries. You can apply to each individual country where you would like to register the design but this can be very costly and time-consuming. The UK is a member of the Paris Convention for the Protection of Industrial Property and as such, the owner of a Design registered in the UK can obtain equivalent protection in another Convention country taking priority from the date of the UK registration.

Another option is to register with the European Registry for EU-Wide protection of the design. A European Registered Community Design (RCD) is registered through the Office of Harmonization in the Internal Market (OHIM) and will provide protection for your design in all of the countries in the European Union. This procedure provides a more cost effective method of protecting your design abroad.

What are the advantages of the RCD?

- A single application results in one registration which covers the whole EU;
- The cost of filing an application (approx. £600 plus VAT) is much lower than the cost of seeking individual registrations in each member state;
- The registration of the design will need to be renewed every five years (up to a maximum of 25 years);

What are the disadvantages to RCD?

The main disadvantage is that OHIM have an 'all or nothing' approach to the registration of a design. That is to say that if the design cannot be registered in one EU country on the basis of a conflict with another design, it cannot be registered in any EU country. This process will also apply where your registered RCD is challenged and found to be invalid. If the challenge is successful, you will lose your RCD protection.

An RCD will only need to be registered in two languages. The first can be any language of the EU. However, the second must be registered in one of the five working languages of the EU, that is Spanish, French, German, English or Italian.

unregistered designs

Will my unregistered design be protected in the EU?

A Community unregistered design right protects the appearance of the whole or a part of a product resulting from the lines, contours, colours, shape, texture and/or materials of the product or its ornamentation. The product may be any industrial or handicraft item, as well as packing, get-up, graphic symbols and typefaces. This is different from a UK unregistered design right which does not recognise surface decoration of any sort.

What cannot be protected by an unregistered design right?

UK and Community unregistered design right will not subsist in a number of items, including:

- **Methods or principles of construction.** Particular features of shape or configuration as applied to an article are protected but the general theoretical or underlying principles will not be protected by unregistered design right;
- **Surface decoration.** This does not come within the category of functional design which the Copyright, Designs and Patents Act 1988 set out to protect. NB a community unregistered design right will protect surface decoration.
- **Features of shapes or configuration.**
 - **The “must fit” exception**
 Designs which enable the article to be connected to, placed in, or around or against another article so that either article may perform its function. This exception is confined to situations where two articles are linked and certain features of shape or configuration enable either article to perform its function
 - **The “must match” exception**
 Designs that are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part. This exception in particular was introduced so that manufacturers could not create a monopoly on spare parts for cars through the law of unregistered design right. NB. There is not a comparable right for this provision in Community unregistered design law

How long does unregistered design right last?

UK unregistered design rights last for the shorter of:

- 15 years from the end of the calendar year in which the design was first recorded or an article was first made to the design; or
- 10 years from the end of the calendar year in which an article made to the design was first available for sale or hire.

A Community design right will only last three years.

How are UK & Community unregistered design rights enforced?

UK unregistered design right is enforced by legal proceedings in a UK Court. Community unregistered design right is also enforced by legal proceedings, normally in a court in the European Community member state in which the infringement is occurring. If successful, such an action can result in an injunction to stop further infringement as well as an award of damages in respect of past infringements.

It is important to remember that an unregistered design right is only infringed by copying. A design created independently, however similar, cannot constitute an infringement.

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Exploitation of designs

Registered

The owner may assign or licence a registered design by a written agreement which must be registered at the Designs Registry.

Unregistered

For the last five years of the UK unregistered design right term, any person is entitled to a licence of the design as of right to make, sell or import the design in the UK. The form of any licence, which can be royalty earning, can be agreed between the design right owner and the applicant for a licence. Designs can also be licensed for use as advertising enticements by companies who are merely selling the design protected products in their shops.

The key differences between registered and unregistered designs

Registered Design Right	Unregistered Design Right
Protects the appearance of consumer items	Protects the appearance of a purely functional product (e.g. with no aesthetic appeal).
Prevents competitors from making, offering, putting on the market, importing, exporting or using products which incorporate the design and do not produce a different overall impression on the "informed user". The informed user might be a knowledgeable and sophisticated consumer or someone who works in the relevant industry in a non-expert capacity but has enough general knowledge of the field.	Prevents copying only of the design.
Gives greater certainty and solidity in infringement actions as well as deterring any potential infringements.	During the last five years of the protection of an unregistered design, the owner must grant a licence for the design to any person that applies for it.

Designs in the future

The Community designs system is considered to be more flexible and liberal than the UK regime. The UK Registry has issued a consultation paper proposing to modernise the UK regime. Such proposals include removing the requirement for individual character and allowing more than one design to be included in a single application for registration making the process cheaper and less time-consuming. Unlike Community designs, it is proposed that if one or more of the designs in a multiple application are refused, the remaining designs will not be affected. The proposals have been laid before Parliament and are currently being scrutinised by the Regulatory Reform Committee.

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