

Design Protection



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Introduction

For many years, the law has allowed businesses to protect certain types of design, but recent years have brought substantial changes to design law both in the UK and in Europe, with the harmonisation of national design law in the various EU member states and the introduction of the Community design. These changes are having significant impact not just on designers, but also on brand owners and advertising agencies alike.

The new designs regime has considerably widened the protection available under design law, both in terms of what can be registered and also the third party acts which the owner of a registered design can prevent. It is, therefore, more important than ever that advertisers and agencies are aware of the existence of design rights and the benefits that they can bring.

What is a design?

A design refers to the appearance of the whole or a part of a product (see definition below) resulting from various features, including the lines, contours, colours, shape, texture or materials of the product or its ornamentation.

This sweeping definition effectively means that a great range of designs can be registered e.g. the shape of a new funky telephone, a pattern on curtains, etc. Even designs with a functional element will, in general, be capable of registration except where the design is solely dictated by function.

Design registration gives the owner a monopoly on their product design, i.e. the right for a limited period to stop others from making, using or selling a product to which the design has been applied or incorporated, without their permission. Registered Design protection is additional to any Unregistered Design Right or copyright protection that may exist automatically in the design.

What is a “product”?

A product is “any industrial or handicraft item, other than a computer program”. Although computer programs are excluded from the definition of “product”, graphic symbols and typographic typefaces are specifically included.

Graphic symbols will include things such as character drawings used in character merchandising, computer icons and brand logos. Logos may now be capable of being protected as Registered Designs as well as Trade Marks.

The “get-up” of bottles and other types of packaging may now also be protected as Registered Designs. This is particularly useful, given that it has become increasingly difficult to obtain Trade Mark registration for such items,

because they may not be sufficiently distinctive to distinguish those of one manufacturer from another.

It is also important to remember that a design for the whole or part of a product can be registered. It is, therefore, important to consider each element of a product in assessing registrability. For example, part of a new logo may be capable of registration in its own right (if all other requirements are fulfilled).

What is the scope of protection offered by design registration?

The design itself is protected, not the article bearing the design. So the use of a registered design by a third party on any product constitutes infringement. This is particularly significant for character merchandising, where one design is often used in relation to many different types of product.

How does a design qualify for registration?

To qualify for registration, a design must:

- be new. This means that it must not be identical or practically identical to any design which has already been made available to the public.
- have individual character. This means that the overall impression it produces on an informed user of the design must differ from the overall impression produced on such a user by any design which has already been made available to the public. In assessing individual character, account will be taken of the degree of freedom of the designer in creating the design.

Are any designs not registrable?

Yes. The Designs Registry will not register any designs which:

- are concerned only with how a product works; or
- are for parts of complex products that are not visible in normal use. These are defined as products which are composed of at least



2 replaceable component parts permitting disassembly and reassembly of the product; or

- are contrary to law or morality; or
- involve the unauthorised use of certain emblems; e.g. certain royal emblems, certain national flags or the Olympic symbol.

Will “novelty” be lost if a design is marketed?

As one requirement for a Registered Design is that it is novel, is there a risk that market testing a design will jeopardise any subsequent attempt to register it?

No, because designers have a twelve month grace period in which they can exhibit and market their designs. If they then realise the designs are worth protecting, they can then make an application for registration, provided that the application is made within twelve months of the first disclosure.

However, there is no protection in this twelve month period from independently developed designs, which may mean that one can no longer claim novelty or individual character. In many cases, therefore, registration is still advisable before significant expenditure is incurred.

What can the owner of a registered design prevent third parties from doing?

In order to infringe a registered design right, a third party must carry out one of the following acts:

- make
- offer
- put onto market
- import
- export; or
- use a product in which the design is incorporated or stock such a product for those purposes.

There are certain exemptions, which relate to acts done for private, experimental or teaching purposes.

The right in a Registered Design of a component part is not infringed when that component is used for the repair of a complex product, so as to restore it to its original appearance.

As the definition of an infringing act includes mere “commercial use”, the protection granted to the owner of the registered design right is very wide indeed. This can be a particular problem when using objects as props in advertisements that incorporate a Registered Design without permission.

How long will a registered design right last?

A Registered Design can be renewed every 5 years up to a maximum of 25 years.

Who owns the design right in a design created by an employee?

If a design is created by an employee in the course of his employment, the design right will belong to his employer. This is similar to copyright law. However, registered designs differ from copyright, because if a work is commissioned from a designer who is not an employee, it is the client who will automatically be the first owner of the design and have the right to apply for registration, rather than the designer.

Where an advertising agency retains an external designer to carry out design work, the rights to the designs he creates will automatically vest in the agency. However, the ownership of the copyright in the design will automatically vest in the designer. The agency must therefore still ensure that the copyright in the design has been assigned to it by a written contract, signed by the designer.

How much does it cost to apply for a registered design?

The UK Designs Registry usually takes about three to four months to process an application and the application fee for one design for 5 years of protection is £60.

Will the Designs Registry conduct a search?

The Registry does not carry out a novelty search on new design applications, but if the Registry is

aware that a design is not novel, objections on novelty grounds will be raised.

Can a designer register modifications to a design?

A designer may apply to register a modified version of his own previously registered design, provided that the later design is new and the overall impression it gives to someone is different from the impression given by the previous design.

How can a design be protected abroad?

A designer can apply for a Registered Community Design which covers all the countries of the European Union. The substantive laws relating to registered Community designs, including the requirement for novelty and individual character, are practically identical to those relating to UK registered designs and the majority of the questions and answers above will also apply to registered Community designs. Applications for registered Community designs should be made to the Office for Harmonisation in the Internal Market (OHIM) in Alicante.

Apart from applying for design registration in individual countries, the only other alternative way to seek international protection is the international system of the Hague Agreement administered by the World Intellectual Property Organization (WIPO). This agreement confers national protection by filing a single application with WIPO, designating the states for which protection is sought. This system, however, is only applicable in eleven EU Member States (Belgium, France, Germany, Greece, Hungary, Italy, Latvia, Luxembourg, Netherlands, Slovenia and Spain) plus certain other non-EU countries.

Is there any protection for a design that is not registered?

A design may qualify for UK unregistered design right (“Design Right”). A Design Right is an intellectual property right which applies to original, non-commonplace designs of the shape or configuration of products. Two-dimensional

designs or surface decoration will not qualify for Design Right protection, although they may qualify for copyright and possibly Registered Design protection. As the design must not be commonplace, well-known, ordinary or routine designs will not acquire Design Right protection.

A Design Right is not a monopoly right but a right to prevent copying, and lasts until 10 years after the first marketing of products made to the design, subject to an overall limit of 15 years from creation of the design.

Design features enabling one product to be functionally fitted or aesthetically matched to another (the "must fit" and "must match" exceptions) get no Design Right protection. However, third parties will infringe Design Right if they copy features of a protected design where there is no need to do so.

Is it possible to get protection abroad for unregistered designs?

An unregistered Community Design Right has been available since 6 March 2002. Again, much of the substantive law relating to unregistered Community designs mirrors the provision relating to UK and Community registered designs. However, the unregistered Community Design Right lasts for only 3 years from the date on which the design is made available to the public.

Acts that infringe an unregistered Community design are the same as those in respect of registered Community designs (and UK registered designs), but with an additional requirement that the design is actually copied without consent. It is therefore not a monopoly right, so in order to obtain the greatest amount of protection; it is advisable to register a design where possible.

Can a design qualify for both design right and copyright at the same time?

In many instances, a new design will qualify for both copyright and design registration. The advantage of copyright is that it subsists automatically on creation of a work without the need for registration (although ownership will have to be proven). However, once registration has been obtained, a Registered Design can provide a stronger form of protection, as it is a monopoly right, which will be infringed by anyone who makes unauthorised use of the design, even if it has not been copied.

Can a design qualify for both trade mark and design registration at the same time?

Some designs will qualify for both trade mark and design registration. For example, where an agency creates a new corporate identity for a client, this could potentially be registered as both a trade mark and a design. If both forms of protection are required, it makes more sense to apply initially for registration of the logo as a design, followed by a trade mark application at a later stage. Once the design application has been made and the design is being used, evidence of use of the logo can be built up, which may help to overcome any potential objections to the trade mark application because it lacks distinctiveness. Evidence of use can show that the mark has acquired a distinctive character.

Further, a registered design will give the owner absolute protection against unauthorised use of such design on any product and not just in relation to those goods or services for which it is registered, as is the case with trade marks.

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