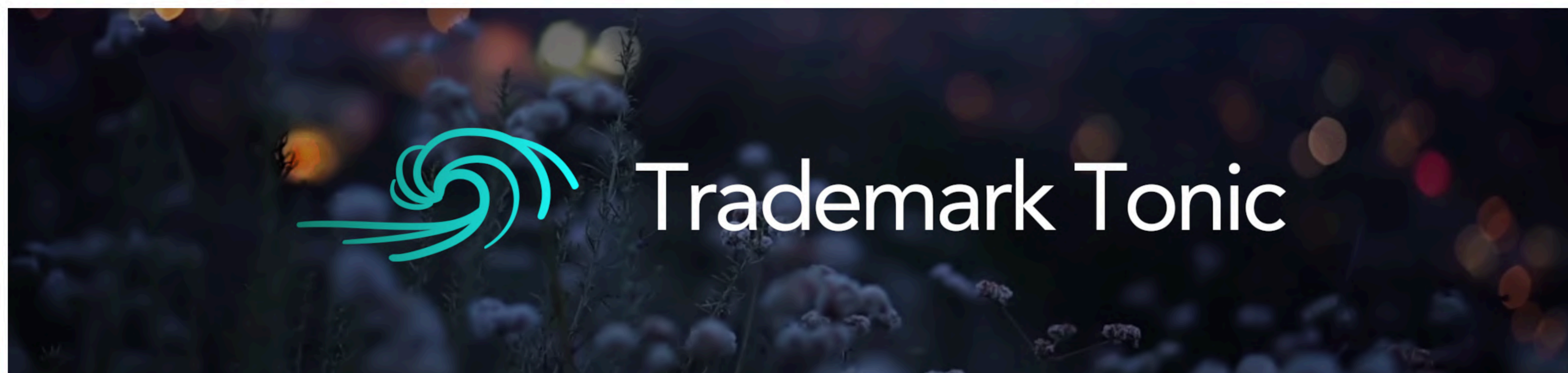


Introduction to Designs



What can I protect with a Registered Design?

UK Registered Designs and EU Registered Community Designs protect the appearance of the whole or part of a product, resulting from the shape, lines, contours, ornamentation, patterns, colours, texture and materials of the product - so covering both 3D and 2D features. The definition of what constitutes a product is quite broad and covers any industrial or handicraft items (except computer programs) and can also include packaging, get-up (style/arrangement of e.g. packaging), labels, cartoon characters, graphic symbols, computer icons, stylised words, logos, and patterns (textile design).

Designs from various industries or sectors can be protected and range from everyday design products to a one-off designer product. Examples include fashion garments, footwear, jewellery, handbags, homewares, bottles, medical and technical instruments, vehicles, electrical appliances, engineering objects and architectural structures. A few examples of well-known designs that are registered are the COCA-COLA® contour bottle, VESPA® scooter, SMEG™ fridge, LOUIS VUITTON® bags and patterns.

Registrations can protect the appearance of a single design product as whole, any new individual features of that product and also a single design feature which may be present in different products.

How can I protect my design?

There are two categories of intellectual property rights protecting designs - registered design rights and unregistered design rights. Registered designs are obtained by filing an application with the relevant IP Office. Unregistered designs arise automatically once a design has been recorded. Registered designs provide stronger protection than unregistered designs (see the 'why register my design' in the next section).

Why register my design?

Designs can have a significant impact on the commercial success of a product and like trade marks are an important business asset. There are a number of benefits to registering your design:

- (1) Registration provides legal protection against the unauthorised use of your design, such as making articles of your design and similar designs (subject to overall impression and informed user tests).
- (2) Exclusive right to use your design for production, sale and marketing in the territory/country where registered.
- (3) The registration process in the UK and EU is relatively quick and cost-effective.
- (4) There is no need to prove copying for registered design infringement to have occurred (copying must be shown for unregistered design infringement).
- (5) Can help act as a deterrent to copying of your design by competitors and others.
- (6) Valuable tool when negotiating a licence agreement or entering a sale/merger agreement.
- (7) Can help attract investors when they are looking at whether to invest in your business.



What is the term of Registered Design Protection?

In the UK and EU, registered designs last for an initial period of 5 years from filing and can then be renewed at 5-yearly intervals, up to a maximum of 25 years (provided the renewal fees are paid). In other countries the term can vary – in USA, for example, registered designs last for 15 years from the date of grant.



Who owns a design?

The owner of a design is generally the designer and the designer should have the right to apply to register that design. Where a design is created by an employee as part of their job in the UK or EU, the employer will own the design (this is unless there is an agreement to the contrary or national law states otherwise).

Where design works have been commissioned in the UK or EU and for example your business has hired a designer to create a design, the designer will own the design rights, in the absence of a written agreement to the contrary. If the commissioning business wishes to retain ownership of the design, it is recommended to have in place a written agreement, prior to the creation of the design, setting out who will own it.

For commissioned designs created in the UK prior to 1st October 2014 (this was before UK design law was harmonised with EU design law and UK copyright law by the 2014 UK Intellectual Property Act), the owner will be the person who commissioned the design work.

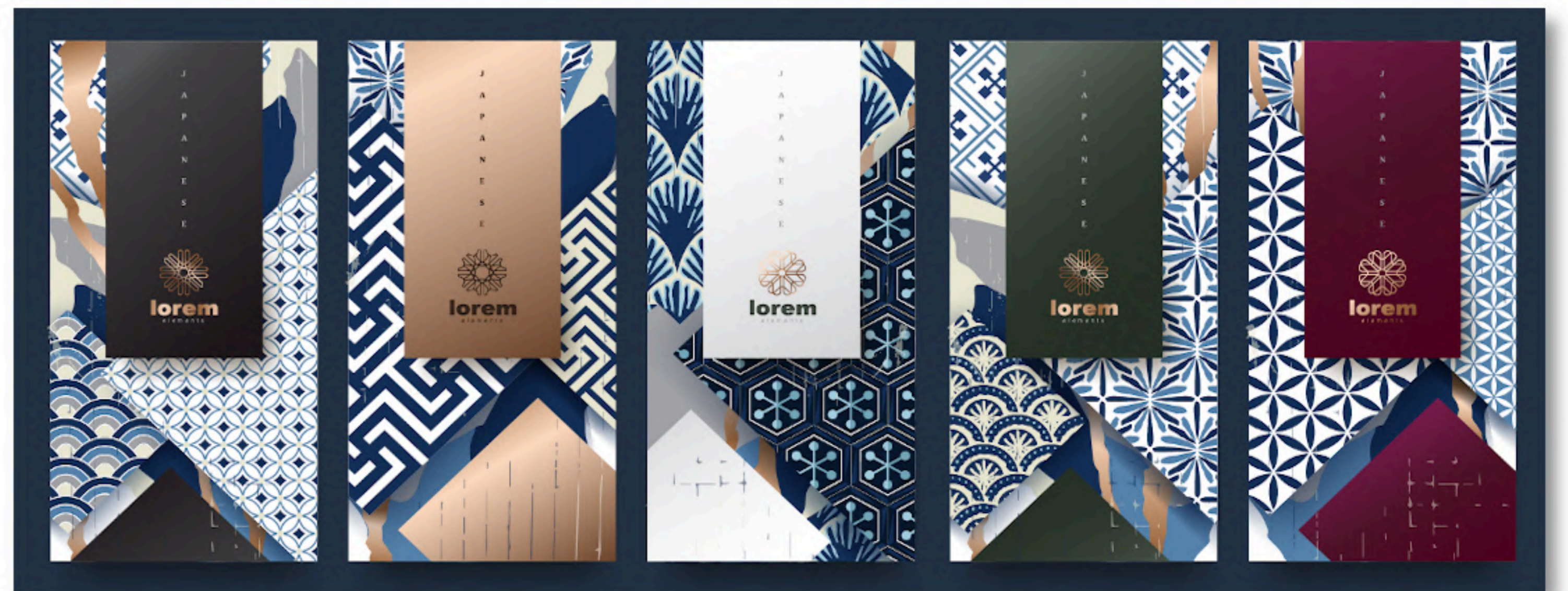


What are the requirements to register a design

In order to be registrable, a design must be novel (new) and have what is known as 'individual character.'

A design will be held to be new if no identical design or no design whose features differ only in immaterial details has been made available to the public (anywhere in the world) before the filing date of an application for registration. A design will be regarded to have 'individual character' if it produces a different overall impression to existing designs. In assessing individual character, the degree of design freedom that a designer has in developing a design will be taken into account. For example, the designer of a toothbrush may have less freedom to make a creative design variation than animation or fashion designers.

There are some limited exceptions to registration, even if a design meets the novelty and individual character criteria – see the 'what can't be registered' section below.



What can't be registered as a design in the UK/EU?

Design registration does not protect inventions or how a product works (a patent may be able to do that instead). The functionality of a product is not protected by design registration – the features of the appearance of a product which are 'solely dictated by technical function' will not be accepted for registration. However, if there are one or more features that are part of the design for aesthetic purposes only, then design registration may be possible.

Also, the components of a complex product will not be protected unless those component parts are visible during normal use. And design features enabling one product to functionally fit to another or aesthetically match to another are excluded from protection (this is to ensure spare parts providers are not prevented from competing in the spare parts market).

Designs which are contrary to public policy or accepted principles of morality cannot be registered. Offensive images or words and protected emblems and flags (e.g. Union Jack and Olympic symbols) will be refused registration in the UK.



When should an application for registered design protection be filed?

For a design to be acceptable for registration in the UK and EU, it must be novel (new) at the time of filing and must not have been disclosed to the public, anywhere in the world.

It is preferable to file design applications as early as possible and prior to the disclosure of your design to the public (anywhere in the world), to help avoid potential conflict with third parties and issues registering in overseas territories with different disclosure rules.

However, for the UK and EU (and some other countries), there is a 12-month grace period, if needed, after a design has been disclosed, in which design applications can be filed and will not count as having been made available to the public. This is helpful from a practical and commercial perspective, as some designers may wish to conduct consumer/market testing or need to disclose the design to third parties while developing a design product, before obtaining registered design protection.

Disclosure can be defined as any act in which your design has been made available to the public, which could include just a handful of people outside of your business as well as larger sections of the public. Publication of your design and also showing your design/design products at exhibitions or trade fairs is deemed to be disclosure to the public, even if your products are not for sale.

It should be noted that disclosures can also be made independently of a designer – if the same or similar design is created and disclosed by a third party then this will count as a novelty destroying design (which would prevent your design being registered). This is another reason for early filing of your design application, where possible.

Exceptions to disclosure, include acts where the disclosure could not reasonably have become known to persons specialising in the business sector concerned, or where the disclosure was made under conditions of confidentiality e.g. a non-disclosure agreement.

If you are looking to file design applications abroad once you have filed in the UK and/or EU, we recommend filing these overseas applications within 6 months of your initial application being filed, so that you can claim the priority (filing) date of the earlier application.



Can I transfer ownership of my design?

UK and EU registered and unregistered designs can be assigned or licensed to others. Generally, registered designs should be easier to exploit as they provide a form of evidence of the ownership and validity of your designs and will usually have a higher commercial value being a stronger right than unregistered rights. Any transfer of ownership or licence should be recorded in writing and signed by or on behalf of the assignor/licensor. The terms of any agreement should be carefully considered.

Where registered designs are being assigned or licensed, the relevant IP Office should be informed so they can record the details in the relevant design register.





Can I register my design in countries outside of the UK and EU?

It is possible to register designs in most countries in the world. Design applications can be filed in each country of interest as national design applications, or filed via the International Hague system at the World Intellectual Property Organisation (WIPO).

Both routes have their place, and the best option can depend on the type of design (and design drawings/representations) being filed and your countries of interest. In most countries, design registrations last for a period of between 10 years and 25 years (if renewal fees are paid at the relevant intervals where applicable).

The International system allows you to file a single application for territories/countries of interest if they are party to the Hague Agreement. This simplifies the filing process and streamlines the administration and maintenance of design registrations. There can also be overall cost savings, if no issues arise during the registration process or with maintenance. However, while WIPO examines applications for formalities, applications will still be examined later in terms of local requirements by local IP offices (in those countries where local examination is carried out). Rules on design representations and drawings can vary from country to country, which could mean possible objections could arise from local IP offices if they don't meet local rules. Also, the best scope of protection might not be achieved for each designated country.

We recommend careful planning for overseas filings in order to obtain the best scope of protection for your designs. For further information on the options and procedures involved, please contact us.

Can I rely on copyright to protect my design?

In the UK, the interaction and overlap between copyright and design law is somewhat complex. Sometimes it is possible for both copyright and design right to subsist in e.g. an artistic or literary work. An example of an overlap is a 2D drawing of a travel bag (which has originality), which may be protected as an artistic work under copyright law, while the visual appearance of the drawing may be protected under design law. However, once the travel bag in the drawing is commercially manufactured as an article in 3D form, copyright protection can be lost (copyright will no longer be infringed). This is to limit the role of copyright in the industrial design field.

There are limited exceptions, however, for sculptures and 'works of artistic craftsmanship' which will still attract copyright protection.

If you manufacture and sell your design and then it is copied, it could be difficult to take action where deliberate copying cannot be shown (Unregistered Design Right) and copyright protection has been lost (due to the commercial manufacture). To prevent any uncertainty in relation to the protection of your design in both 2D and 3D form - and particularly where you are thinking of manufacturing your design product, it is better to obtain registered design protection.



What should I do if I think someone is infringing my design?

If you believe someone is infringing your design, Trademark Tonic can help you to identify whether you have design rights and whether there is an infringement of these rights. We always recommend seeking the advice of an attorney in infringement matters.



How can I help protect my design?

In order to have clarity on the ownership of your design, we recommend recording the designer name and creation date details during the design development process. Marking relevant design documents, drawings, sketches etc with your name and date can be helpful (to prove evidence of ownership if needed). Any information and documents relating to your design should be stored and kept safely. Also, setting out the position on ownership in contracts with e.g. employees and external service providers such as freelancers and consultants, is good practice.

Given the complexity of design law, we suggest seeking professional advice as early as possible. Trademark Tonic can advise you on strategy and all the relevant steps to help protect your design.

Ideally it would be better to file application/s for design protection, before there is any disclosure of your design. However, if disclosure is necessary during the design development process (e.g. to working partners/investors) then it is good practice to have in place a written Non-Disclosure Agreement with confidentiality clauses with these third parties, before showing them your design.

If you require market testing of your design product and intend to rely on the 12 month grace period, then we suggest you record the date of first public disclosure and let your attorney know this date so that any applications can be filed before the end of the grace period. Or if you would prefer to defer the publication of your design once an application has been filed, so that it is kept confidential until just before launch, then let your attorney know, so the relevant paperwork can be put in place.



Designs and Brexit

The UK withdrew from the EU on 31st January 2020 and the transition period ended on the 31st December 2020.

UK national design registrations and applications are not affected by Brexit and the UK national design system will continue to function as normal. From 1st January 2021 Registered and Unregistered EU Community Designs and International Design Registrations designating the EU will no longer be valid in the UK and will provide protection in the other 27 EU member states only.

The UK legislation [The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019] has been approved by the UK government. These Regulations include amendments and provisions to ensure any UK design rights (which were previously part of the EU Community Design system or International Design system where the EU has been designated), continue to be protected and preserved under UK law.

If you have any queries relating to Brexit and/or would like to discuss strategy with us in relation to your current design portfolio, please get in touch.

How can Trademark Tonic help you?

Trademark Tonic advises on the establishment, protection and enforcement of trade mark and design rights in the UK, Europe and across the world. We help a range of businesses and individuals, including entrepreneurial start-ups, SMEs, creatives/independents, spin-outs and emerging growth companies. Our strategic approach, commercial mindset and our experience of managing global trade mark and design portfolios, means that we are well placed to help guide and advise you on optimising your trade marks and designs.

For more information on how Trademark Tonic can help you, please see our website trademarktonic.com or contact us at email@trademarktonic.com

The content of this guide is provided for informational purposes only, does not constitute legal advice and should not be relied on or treated as a substitute for specific advice relevant to particular circumstances. We recommend that you always seek the advice of a qualified attorney or legal professional, on any specific matter, before you make any decisions or take any action.