



**The small print for BIG IDEAS**

*Disclaimer: This online publication describes the law in general terms. It is not intended to provide legal advice on specific situations and should not be relied upon as a source of legal advice.*

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## **qLegal Online Publication**

# **INDUSTRIAL DESIGNS EXPLAINED**

### **What is covered by design rights?**

In the UK, there are five possible forms of protection for designs which are:

- UK unregistered design rights;
- UK registered design rights;
- Unregistered Community design rights;
- Registered Community design rights; and
- UK Copyright Law.

The primary legislation governing designs in the UK includes:

- the Copyright, Designs and Patents Act 1988 (“**CDPA**”) (UK unregistered design rights);
- the Registered Designs Act 1949 (UK registered designs);
- the Intellectual Property Act 2014 (amending the CDPA in relation to UK unregistered design rights)
- the EU Designs Directive (98/71/EC); and
- the EU Community Designs Regulation (6/2002).

This toolkit deals with the UK based rights for both registered and unregistered designs.

Design right protects the appearance of a purely functional product. Design right does not protect:

- a method or principle of construction;
- surface decoration; or
- features of shape or configuration of an article which: (a) enable the article to fit with another article so that either article can perform its intended function (the “*must fit*” exception); or (b) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part (the “*must match*” exception).<sup>2</sup>

# qLegal

The small print for BIG IDEAS

Registered design may consist of three-dimensional features such as the shape or surface of the article, or two dimensional features such as patterns, lines or colour. Parts of the product are protectable as long as it meets the requirements and different parts of the same article may or may not be protected (i.e. the particular shape of the nozzle on an article may be protected, but a printed pattern which is a decoration on the article wouldn't be).

Certain specific designs are excluded from the scope of registered designs, most importantly computer programs, features which are solely dictated by the product's technical function, and "must fit" features.<sup>2</sup>

## What are the requirements to obtain protection?

### *UK unregistered designs*

For unregistered designs, the design must be **original** and **not commonplace** in the design field in a qualifying country. First, a design must not have been copied from an earlier design within the same design field (i.e. a type of design with which a notional designer of the article concerned would be familiar). Secondly, one must then determine whether it is commonplace by ascertaining the degree<sup>2</sup>of similarity to the design of similar, independent articles in the same design field. Once a design is created by producing a design drawing or making a first prototype, the designer will be given unregistered design rights automatically.

Design right protection can extend to the **shape or configuration** whether internal or external. Part only of a design may be protected provided that the relevant part is not commonplace at the time of creation or excluded by any other provision of the CDPA. Unlike with registered designs, there is no exclusion for designs which serve a purely functional purpose.

Design right cannot subsist until the design has been **recorded** in a design document and an article has been made to the design. A design document covers any record of a design whether in the form of drawing, or data stored in a computer etc. Registration of this type of design right is not required, and the term for the right will run from the creation of the record.<sup>2</sup>

For a design to qualify for UK design right, the designer (or the employer of the designer) must be a *qualifying person*. A qualifying person means: (a) an individual habitually resident in a qualifying country; or (b) a body corporate or other body that is formed in the UK or in a qualifying country, and carries out substantial business activity in any qualifying country. If these are not satisfied, a

# qLegal

The small print for BIG IDEAS

design may still be protected if the first marketing of articles made to the design has been undertaken by a qualifying person in a qualifying country. The *qualifying countries* for UK design right are the UK, all other EU member states, and a number of other countries who have reciprocal arrangements with the UK.

## ***UK registered designs***

In order to gain protection for an article as a registered design an **application** should be made by the owner together with a descriptive statement of the product and pictures of identifying features of the design to the UK Intellectual Property Office (“UKIPO”).

To qualify as a registered design, the design must be **new**. A design shall be considered new if no identical design has been made available to the public before the date of filing of the application for registration, or if priority is claimed<sup>1</sup>, the date of priority. However, the designer has a 12-month grace period after disclosure in which to file his application for a design.<sup>2</sup>

A design shall be deemed to have an **individual character** if the overall impression it produces on the end user differs from prior designs that have been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority. In assessing individual character, first, the degree of freedom in creating the design will be taken into account (i.e. a functional item will present less potential for creative endeavor than a decorative item which means fewer differences are likely to be required for a functional item). Secondly, features of a product that are dictated by its function will be disregarded.

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<sup>1</sup> The right of priority allows a person to file an application for industrial design in one EU country, and subsequently file an application in all the other EU countries for the same design, but backdate the filing date to that of the first application (the priority date). The applicant must claim the priority of the first application in order to make use of the right.

<sup>2</sup> A designer who discloses his design has a 12 month period in which to apply for registration of the design. This grace period gives the designer time to exhibit and market his design before deciding whether it is sufficiently commercial to justify the expense of registration, etc. However, if during the 12-month period a third party makes a same or a similar unconnected disclosure before the designer has applied for registration of his design, the designer's application may be refused. This risk may be avoided by making an application for registration as soon as possible after disclosure of the design.

# qLegal

The small print for BIG IDEAS

## Who is the owner of the industrial design?

The “**designer**” (for unregistered designs) and the “**author**” (for registered designs) means the person who creates it. In the case of a computer-generated design, the designer refers to be the person who made the arrangements necessary for the creation of the design.

Generally, the designer/author is the **first owner/original proprietor** of any design right in a work. However, where a design is created by an employee **in the course of his employment**, the employer is the first owner/original proprietor of any design right in the design.

Where a designer is **commissioned** to produce something, the *unregistered/registered design* right belongs to the designer. This can be altered if the parties agree to the contrary and this is reflected in the initial agreement between the parties before the work is performed. Alternatively, an assignment can be agreed to transfer the design right to the commissioning party.

If the design qualifies for protection on the basis of having been **first marketed in the UK**, the first owner of the *unregistered design* will be the person by whom the articles are first marketed. <sup>2</sup>

## What is the minimum duration of protection?

*Unregistered design rights* expire:

- 15 years from the end of the year in which the design was first recorded or (if earlier) from when an article was first made, or
- if articles made to the design are made available for sale or hire within 5 years from the end of that calendar year, 10 years from the end of the calendar year in which that first occurred.

A UK *registered design right* lasts for 5 years from the date of registration and the design is renewable for four further periods of 5 years, by applying to the registrar for an extension and paying the prescribed renewal fee.

## What constitutes infringement of design rights?

### **UK registered designs**

A registered design is a monopoly right and the registered proprietor has the exclusive right to use the design and prevent third parties from using a design that does not produce a different overall impression on the informed user. “Use” in this context means making, offering, putting on the market, importing, exporting, or using of a product without the consent of, or licence from, the owner. There are certain exceptions to this general rule which provide that use of the design will

# qLegal

The small print for BIG IDEAS

not be infringement when, for example, the use was for non-commercial purposes, for experimental purposes, or for teaching purposes.

Infringement occurs when a person does anything which infringes the registered owner's exclusive right to use the design. Registered design owners do not need to prove that their design has been copied to establish infringement, only that there is a high level of similarity between the registered design and the infringing design.

The rights granted by a UK registered design are national rights and therefore, although there is no express reference to the UK in the Registered Design Act, infringing acts must take place within the UK.

## ***UK unregistered designs***

The owner of an unregistered design right has the exclusive right to reproduce the design for commercial purposes by making either (a) articles to that design, or (b) a design document recording the design for the purpose of enabling such articles to be made (i.e. an engineering drawing).

"Making articles to design" means copying the design so as to produce articles exactly or substantially to that design. There will be no infringement if an alleged infringer has independently made articles to the same or substantially similar design. The test of infringement depends on whether the overall design has been copied, and not merely a part or even a substantial part of it.<sup>3</sup> The test is a visual one and determined by the eye of the customer.<sup>4</sup>

The maker of the "design document" will still be committing an infringing act if they do not go on to manufacture the articles, provided that they made the drawing for the purpose of reproducing the design for commercial purposes. <sup>5</sup>

**Primary infringement** occurs when a person reproduces, or authorises another to reproduce, a design without the consent of, or licence from, the owner. **Secondary infringement** occurs when a person (without the consent of, or a licence from, the owner):

- imports into the UK for commercial purposes, or
- has in his possession for commercial purposes, or
- sells, lets for hire, or offers or exposes for sale or hire, in the course of a business,

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<sup>3</sup> [2002]All ER (D) 489.

<sup>4</sup> [1992] FSR 421.

# qLegal

The small print for BIG IDEAS

an article which is an infringing article, which the infringer knows or has reason to believe is an infringing article.

The infringing acts are subject to non-commercial, experimental or teaching exceptions, and exceptions for overseas ships and aircraft. The burden of proof is on the claimant to show subsistence and duration of the right and that the defendant has copied or had the opportunity to copy.

## What are the remedies for design right infringement?

An infringement of design right is actionable by the design right owner.

As with any other property right, the courts can (among other remedies): (a) stop that person making further infringing use of the material by granting an injunction; (b) award the owner damages or account of profits which compensate for loss resulting from the infringement; and/or (c) make the infringing party give up the goods to the design right owner or destruction of the infringing articles.

The court has **power to award additional damages** for infringement of design right in circumstances where, for example, the infringement is flagrant or the defendant has benefited from his infringement. However, damages will not be awarded in all situations, such as where there was **innocent infringement** (i.e. where the third party proves that, as at the date of the infringement, they were not aware that the infringed design was registered, and had no reasonable ground for supposing it was registered). Other remedies can still be granted though.

In the UK, litigation is expensive and can take a long time, which is why the parties to a design right dispute should try to resolve their issues between themselves without resorting to the court system if possible.

If this is not possible, the parties may choose to go to court, or to try to settle their dispute via a means of "alternative dispute resolution" ("**ADR**"). One way of resolving an intellectual property dispute via ADR is mediation, where a mediator will not make a decision on the dispute, but will help both parties reach an amicable solution. The UKIPO offers a mediation service to parties involved in an IP related dispute. The other way of resolving a dispute through ADR is arbitration.



**The small print for BIG IDEAS**

Solicitors can advise on which procedure may be more appropriate for the dispute and parties if/when the situation arises.

### **Overlap Between Designs and Copyright**

There can be considerable overlap between the laws of copyright, registered designs and unregistered design rights.

Where copyright and registered design right exist in the same article, infringement actions may be taken in respect of either or both rights. In practice, copyright and design right will be pleaded in the alternative.

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