

DESIGN PROTECTION

Unregistered Design Rights

Design rights protect the design, the shape and configurations of articles. Certain design rights arise automatically without registration. Certain other design rights require registration.

Unregistered design rights protect functional items. The rights protect three dimensional shapes from copying. The rights arise automatically without registration and the protection is for 10 years. An unregistered design right relates to any aspect to the shape or configuration of any article but the right doesn't exist until it is recorded and an article has been made from the design.

The right comes into effect when the article is first fixed in a design document. A design may only be protected by design right if it is original and not commonplace. It is important to keep all records relating to the design and concept including drawings, schemes and prototypes etc. The design right does not apply to the surface ornamentation of an article.

If copyright exists in a work then the unregistered design right is suppressed. Only copyright infringement applies.

In the last five years of the term of an unregistered design, anyone can apply for licence to use the registered design. If the terms cannot be agreed between the parties then the issue is settled by the Designs Registry.

As with other intellectual property rights, design right belongs to the person who commissioned and paid for the design in question. An employee would not generally own the unregistered design right produced in the course of employment.

There is also an EU wide unregistered design right which protects the shape and configuration pattern for a maximum of three years.

Registered Design Rights

Registered design rights protect the appearance of consumer items. The rights protect new designs and grant a monopoly right to use the design. The rights last for 25 years from registration. Design rights have been obtained for products such as food stuffs, jewellery, clothing, travel goods, textiles and furniture. Registration affords additional protection to any design right or copyright protection that may automatically exist.

A registered design right is a monopoly right for the appearance of the whole or part of a product resulting from features of lines, contours, shapes, textures and materials. This could cover anything from patterns on textiles to the shape of a car or part of a product.

Registering a design with the UK Intellectual Property Office gives additional protection. The registration of a design gives its owner the right to use the design. It protects the using, making, offering, putting on the market, importing or exporting of the product on which the design is incorporated.

The proprietor of a registered design has exclusive right to use the design and any other design which does not produce an different overall impression on the informed user. It is possible to take legal action against individuals who infringe, whether they do so intentionally or not.

In order to register a design it must be new and must have individual character. This means that it must have the appearance of originality. A design must be new at the date of application. A registered design can cover two dimensional as well as three dimensional articles and ornamentations. The registered design right gives an exclusive right to use and make any item incorporating the design and to take action against anyone infringing this right.

It is not possible to register designs in relation to how a product works. There are limitations in relation to the protections of the interior of a product. Features dedicated by

technical function cannot be registered. This may be capable of being protected by a patent.

Registration of a design is made to the UK Intellectual Property Office. The application is examined within two months and providing there are no objections, registration will normally be granted within two to three months.

A registered EU design facilitates obtaining registration rights that are valid within the European Union. Since 1st January 2008 it is possible by a single application to obtain protection for a design through the EU and also through countries that are members of the Geneva Act of the Hague Agreement concerning international registration of industrial design. This replaces a series of national design applications which would otherwise have to be made in individual national offices.

Infringement

Infringement is defined as being anything done without the consent of the design owners. Using the design for non commercial, experimental or teaching purposes would not constitute infringement. This is provided through the production as compatible fair trade practice and is not fairly prejudice to normal exploitation of the design and mention is made of the source.

Damages may not be awarded against an innocent infringer. However If a product is marked with the word registered and the design number this should protect against this defence.

It is possible for the owner of a design to obtain a number of remedies including securing an injunction or damages and a counter product and together with an order for delivery and or destruction of the defending item.

As with copyright there is primary and secondary infringement. Primary infringement is when articles are made to design for commercial purposes. Secondary infringement



includes importing, possessing, selling, hiring. However, this only applies where the person has knowledge or reason to believe that they were infringing items.

The available court remedies include an injunction, accounts of profits earned or an order for delivery up and disposal of the offending articles, where damages are not available against a primary infringer.

This Guide is intended as an overview and broad outline of the matters covered in it. Its purpose is to inform and raise awareness. We are happy to offer specific legal advice on particular circumstances.

This Guide should not be relied on as a substitute for comprehensive legal advice with reference to the particular circumstances.

While we have taken due care in the preparation of this publication, we do not accept legal liability as a result of any reliance placed on anything in this Guide. The reader should rely only on specific legal or taxation advice.

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