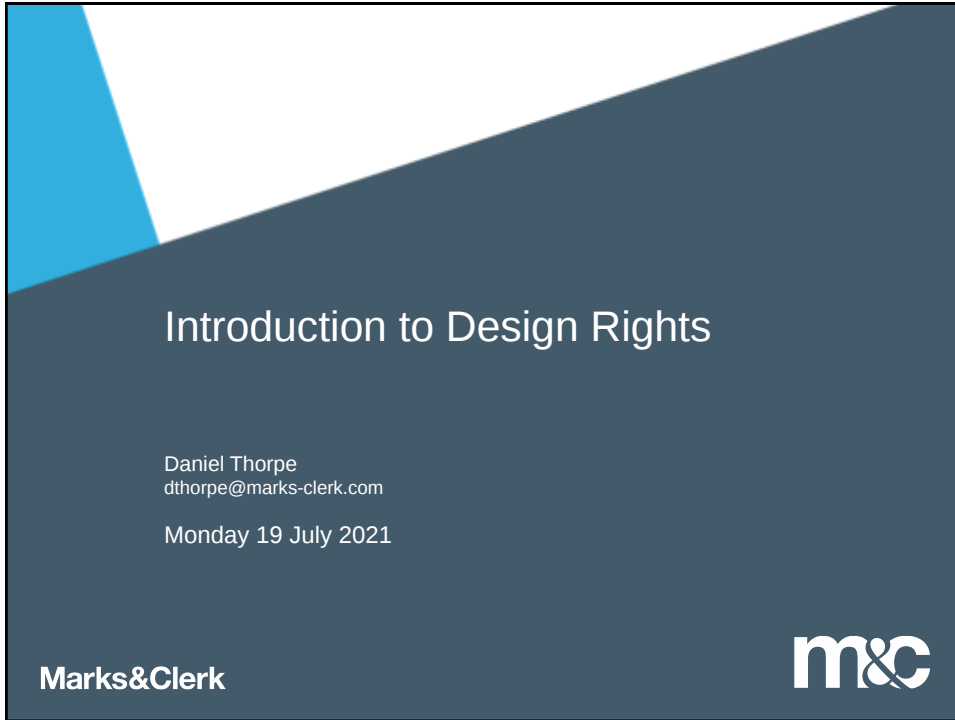




Introduction to Design Rights

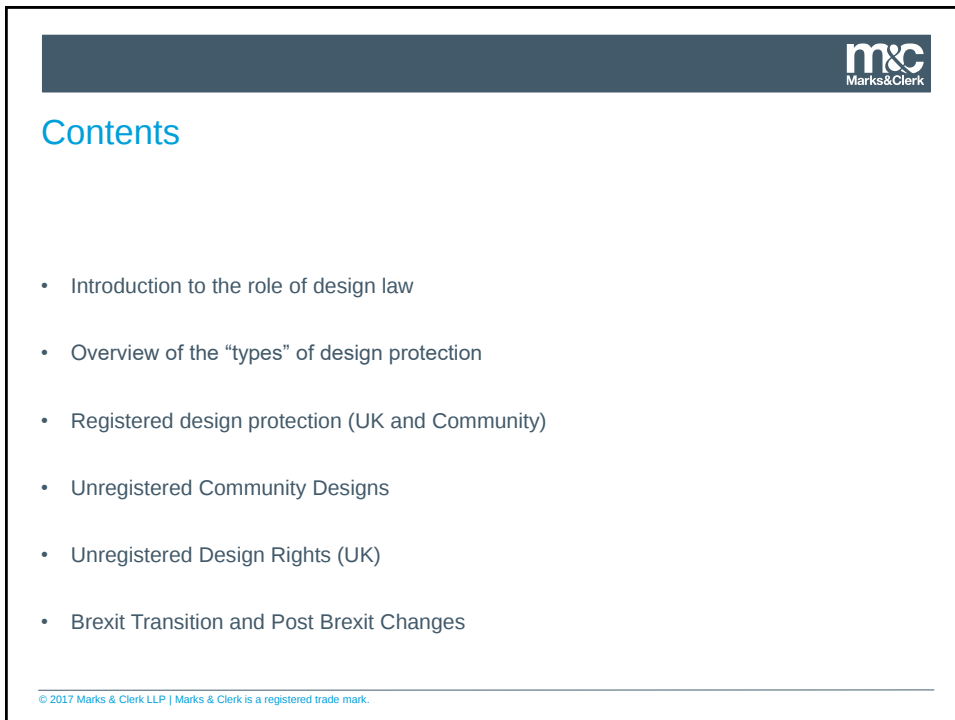
Daniel Thorpe
dthorpe@marks-clerk.com

Monday 19 July 2021

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Contents

- Introduction to the role of design law
- Overview of the “types” of design protection
- Registered design protection (UK and Community)
- Unregistered Community Designs
- Unregistered Design Rights (UK)
- Brexit Transition and Post Brexit Changes

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Introduction to design law

- Aimed at protecting the appearance of products



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The role of design law

- Copyright protection
 - Artistic works (2D images, sculptures...)
- Patent protection
 - May protect the appearance of the product if it is functional
- Design protection
 - Appearance of the whole or part of a product
- Trade Marks
 - Shape marks

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Types of design protection

- Design legislation has evolved over many decades
- The combination of national protection and the desire for consistent Europe-wide protection has resulted in a number of overlapping systems for protecting designs

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Types of design protection

United Kingdom

- Registered Designs
 - **Registered Designs Act**
- Unregistered Design Right
 - **Copyright, Designs and Patents Act**

Europe

- Registered Community Designs
 - **Council Regulation (EC) No 6/2002 & Commission Regulation(EC) No 2245/2002**
- Unregistered Community Design Right
 - **Council Regulation (EC) No 6/2002 & Commission Regulation(EC) No 2245/2002**

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Types of design protection – similarities and differences

- UK Registered Designs (UKRD or RDR) and Registered Community Designs (RCD)
- Unregistered Community Designs (UCD)
- UK Unregistered Design Rights (UDR)

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Registered Designs

UK Registered Designs
Registered Community Designs

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Registered Designs

What can they protect?

- *“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”*

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Registered Designs

What can they protect?

- A valid design **cannot** be filed to:
 - design dictated by technical function
 - Interfaces (RCD) or “must-fit” features (UKRD)
 - designs contrary to morality
 - a part of a “complex product” which is not visible during normal use

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Registered Designs

Ownership

- The initial owner of a UK registered design is generally the designer
- Where the design is made during the course of employment, the employer is generally the owner;
- Where the design is made under commission:
 - The terms of the contract will normally dictate; however...
 - ...in the absence of explicit or implied terms in the contract – the designer (commissionee) will own the rights to the design

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Registered Designs

How to file

- Application must be filed at the official office
 - UKRD – UK Intellectual Property Office
 - CRD – EUIPO or the IPO of a Member State (or the Benelux Design Office if in the Benelux countries)
- Application must be in a specific form

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Registered Designs

Filing requirements

- The application must:
 - identify the applicant
 - include a representation or a specimen of the product
 - specify the product to which the design is applied
 - Locarno classification
- The relevant fees must be paid

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Registered Designs

Filing requirements

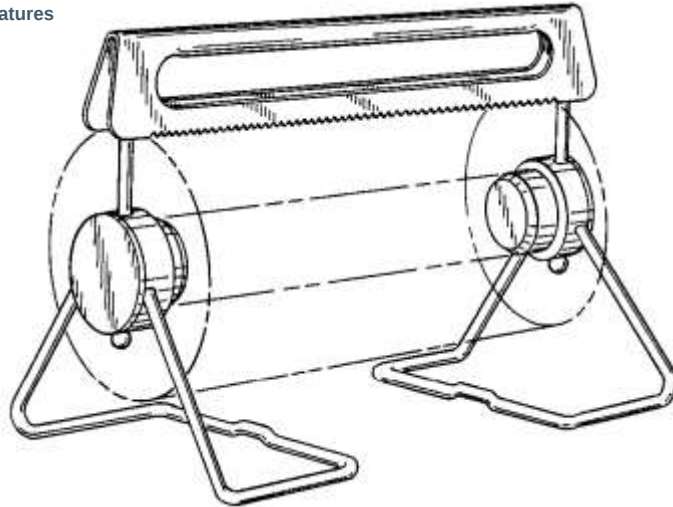
- Optionally, the application may include (among other things):
 - a disclaimer
 - a description
 - a request for deferred publication

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Registered Designs

Disclaimed features



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Registered Designs

Multiple designs

- Several designs may be included in a single application
 - EU only - Provided they are all to related products (i.e. belong to the same Locarno class)

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Registered Designs

Priority

- Priority can be claimed from a first filing in a qualifying country
- The priority period is 6 months
- Must be for the same design
- The applicant of the subsequent application must be the same as the first application
- The filing date, the country and a representation of the priority application must be provided to validly claim priority

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Registered Designs

Grace period

- A grace period exists whereby disclosures made by the designer during the 12 months preceding the filing of the registered design application do not count as prior art

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Registered Designs

Examination

- Registered design applications are **not** substantively examined
- Formal requirements are checked
 - The office may contact the applicant to request corrections
 - A time limit will be set for corrections
 - Rights may be lost if the corrections are not made
- Designs can be registered very quickly. However, UKIPO has been slower since Brexit.

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Filing requirements

- Seven views (EUIPO; 12 views in the UK)
- Consistent – same visual format
- Relate to same Locarno class for a multiple design (EUIPO)
- Can show alternative positions (but not add or remove parts), exploded views, partial views, sectional views, kits
- Can use disclaimers
- Cannot use text (other than “TOP”) (EUIPO)
- *PMS International v Magmatic*, (“Trunki”)
- *Samsung Electronics (UK) Ltd v Apple Inc*, [2012] EWHC 1882 (Pat), [2012] EWCA Civ 1339

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Registered Designs

Validity

- In order for a design to be valid it must be:
 - new
 - no identical design or one differing only in immaterial details
 - have individual character
 - different overall impression compared to any other design
 - must be visible if part of a complex product
 - the applicant must be entitled to the design

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Registered Designs

Validity

- What is the state of the art?
 - Everything published before the relevant date, EXCEPT:
 - designs that could not reasonably have become known in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;
 - confidential disclosures
 - disclosures made by the designer within the grace period
 - disclosures in breach of confidentiality in the 12 months preceding the relevant date

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Registered Designs

Validity

- Does a design have “individual character”?
 - i. what is the design?
 - ii. who is the informed user?
 - iii. does the design have individual character?

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Registered Designs

Duration

- A registered design can last for up to 25 years
- Renewals are payable every 5 years

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Registered Designs

Infringement

- The designer can prevent third parties from using the design without the proprietor's consent
- exclusive right to use the design and any design which does not produce on the informed user a different overall impression

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Registered Designs

The Hague Agreement

“The Hague Agreement allows applicants to register an industrial design by filing a single application with the International Bureau of WIPO, enabling design owners to protect their designs with minimum formalities in multiple countries or regions.”

(http://www.wipo.int/treaties/en/registration/hague/summary_hague.html)

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Unregistered Community Designs (UCD)

Similarities with Community Registered Designs

- The following aspects of Unregistered Community Designs are the same as for Community Registered Designs:
 - "What can they protect?"
 - "Ownership"
 - "Validity"
- Therefore the corresponding slides for registered designs (above) apply

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Unregistered Community Designs (UCD)

How to acquire

- First disclosure of the design within the EU Community will create the Unregistered Community Design right

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Unregistered Community Designs (UCD)

Duration

- Three years from the date on which the design was first made available to the public within the Community

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Unregistered Community Designs (UCD)

Infringement

- The scope of protection afforded is the same as for registered designs
- However, copying is required
- N.B. Since there are no representations defining the design, the exercise of 'defining' the protected design is more involved

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Unregistered Design Rights

UK Unregistered Design right (UDR)

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UK Unregistered Design right (UDR)

What can they protect?

- *“the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article”*

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UK Unregistered Design right (UDR)

What can they protect?

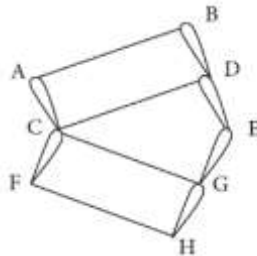
- Design right does not subsist in:
 - a method or principle of construction
 - “must-fit” features
 - “must-match” features
 - surface decoration

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UK Unregistered Design right (UDR)

Principle of construction



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UK Unregistered Design right (UDR)

How to acquire

- Unregistered Design Right arises automatically when a design is recorded in a design document or an article is made to the design...
 - provided the design is made by a qualifying individual or person

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UK Unregistered Design right (UDR)

Qualifying individual or person?

- In order to qualify for UK Unregistered Design Right, the designer, employer, or first marketer (depending on the situation) must be a “qualifying person or individual”
- Ownership of the Unregistered Design Right depends on who the relevant qualifying individual or person is.

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UK Unregistered Design right (UDR)

Duration

- Fifteen years from the end of the calendar year in which the design was first recorded in a design document or an article was first made to the design, whichever first occurred, or
- if articles made to the design are made available for sale or hire within five years from the end of that calendar year, ten years from the end of the calendar year in which that first occurred.
- In the last five years of protection, Licenses of Right must be granted.

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UK Unregistered Design right (UDR)

Infringement

- Owner of the design right has the exclusive right to:
 - reproduce the design for commercial purposes; and
 - make a design document recording the design to enable such articles to be made
- For there to be infringement, there needs to be copying

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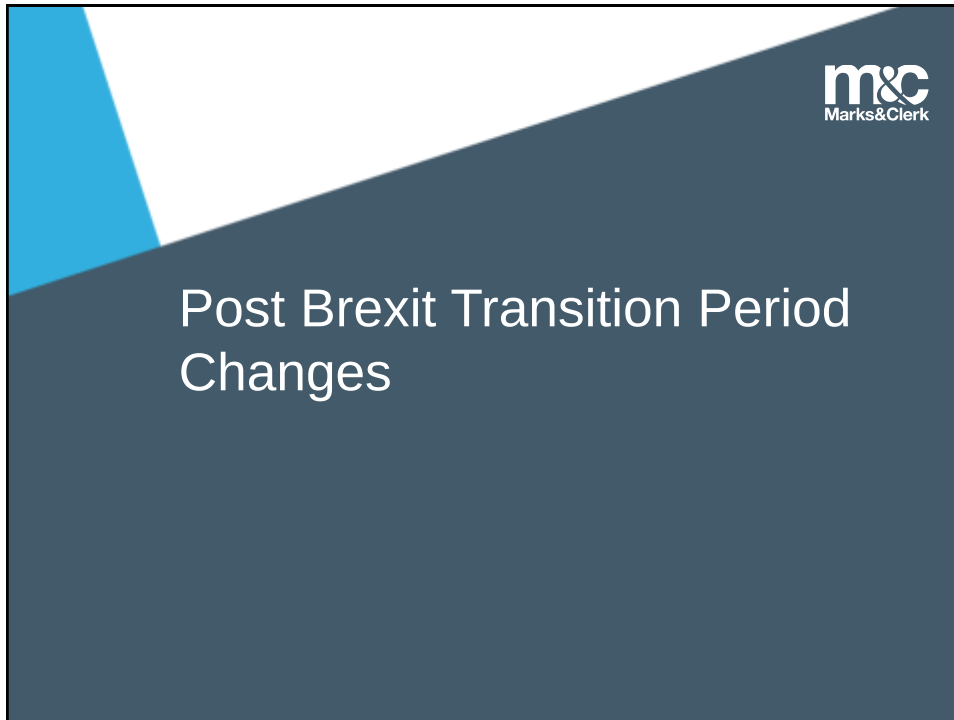
UK Unregistered Design right (UDR)

Validity

- Design right only subsists in "original" designs
 - i.e. those not commonplace in the design field in question

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Post Brexit Transition Period Changes

Existing Rights

- From 1 January 2021 Registered and Unregistered Community Designs no longer cover the UK
- All live and enforceable Community Designs automatically continue under a comparable UK right

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Post Brexit Transition Period Changes

Registered Community Design (RCDs)

- Re-registered Designs (cloned designs)
 - Registered Community Designs published before end of transition period
 - Automatic
 - Retains filing and priority date of corresponding Registered Community Design
 - Can opt out
- Same applies for Hague Designs designating the EU

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Post Brexit Transition Period Changes

Pending Registered Community Designs

- Grace Period
 - Registered Community Designs not published before end of transition period and applications still pending at end of transition period
 - 9 months to file a corresponding UK design application claiming the earlier filing and priority date of the corresponding EU right
 - Applicant must do of own volition and is subject to official fees
 - Will be examined

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Post Brexit Transition Period Changes

Unregistered Community Designs (UCDs)

- **Two New UK Rights**
- Continuing Unregistered Designs
 - Unregistered Community Designs in force at end of transition period
 - Automatic
 - Runs for remainder of the term of the corresponding EU right (up to 3 years)
- Supplementary Unregistered Designs
 - Provides same type of protection as an Unregistered Community Design but only covers the UK
 - Automatic
 - Applies only where first global publication of design occurred in a qualifying country

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Contacts

Daniel Thorpe
dthorpe@marks-clerk.com

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