



Introduction to Design Rights

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Marks&Clerk

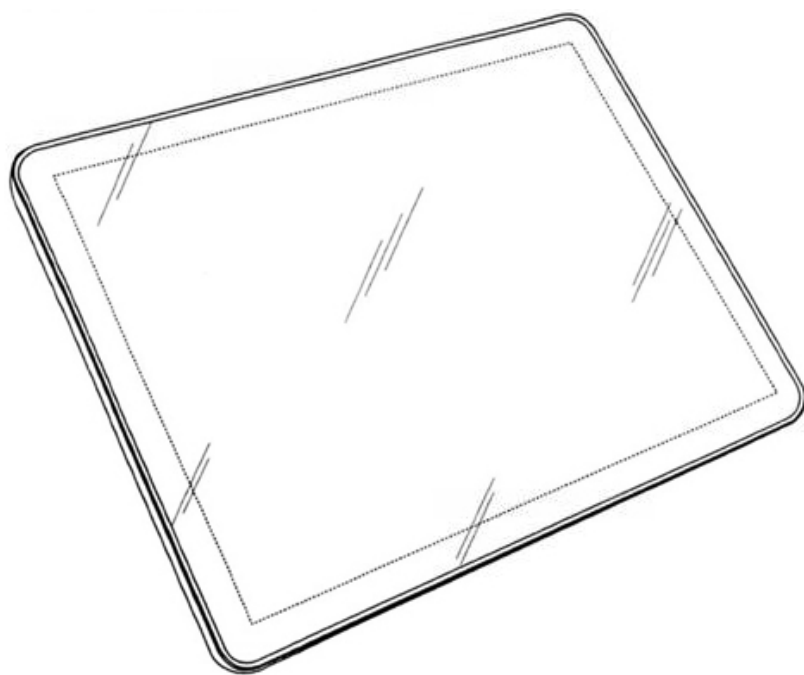


Contents

- 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

Introduction to design law

- Aimed at protecting the appearance of products



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



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

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 Implementing Regulation (EC) No 2245/2002**
- Unregistered Community Design Right (continuing and supplementary)
 - **Council Regulation (EC) No 6/2002 & Commission Implementing Regulation (EC) No 2245/2002**

Types of design protection – similarities and differences

- UK Registered Designs (UKRD or RDR) and Registered Community Designs (RCD)
- Unregistered Community Designs (UCD) – gives rise to supplementary and continuing designs post Brexit
- UK Unregistered Design Rights (UDR)

Registered Designs

UK Registered Designs

Registered Community Designs

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”*

Registered Designs

What can they protect?

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



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:
 - o The terms of the contract will normally dictate; however...
 - o ...in the absence of explicit or implied terms in the contract – the designer (commissionee) will own the rights to the design

Registered Designs

How to file

- Application must be filed at the relevant 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

Registered Designs

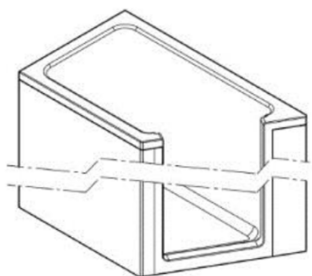
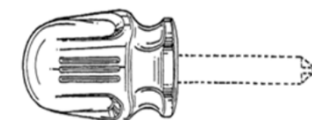
Filing requirements

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

Registered Designs

Filing requirements

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



Registered Designs

Multiple designs

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

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

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

Registered Designs

Examination

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

Filing requirements

- Seven views (EUIPO; 12 views in the UK (online))
 - 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

Registered Designs

Validity

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

Registered Designs

Validity

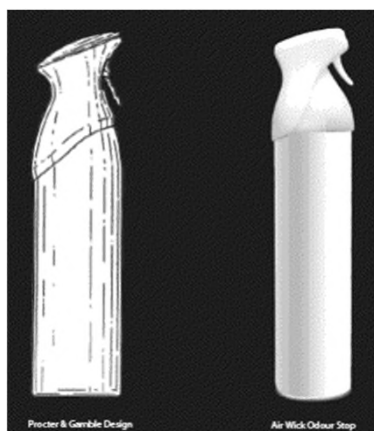
- What is the state of the art?
 - Everything published before the relevant date, EXCEPT:
 - designs that could not reasonably have become known in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;
 - confidential disclosures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

Registered Designs

Validity

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

Procter & Gamble Company v Reckitt Benckiser (UK) Ltd [2007]



If design is markedly different from anything that has gone before, is likely to have greater overall visual impact than if it is surrounded by kindred prior art; therefore, overall impression conveyed by such design will be more significant and the room for differences which do not create a substantially different overall impression will be greater - So protection for striking novel design will be greater than for design which is incrementally different from prior art.

Registered Designs

Duration

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

Registered Designs

Infringement

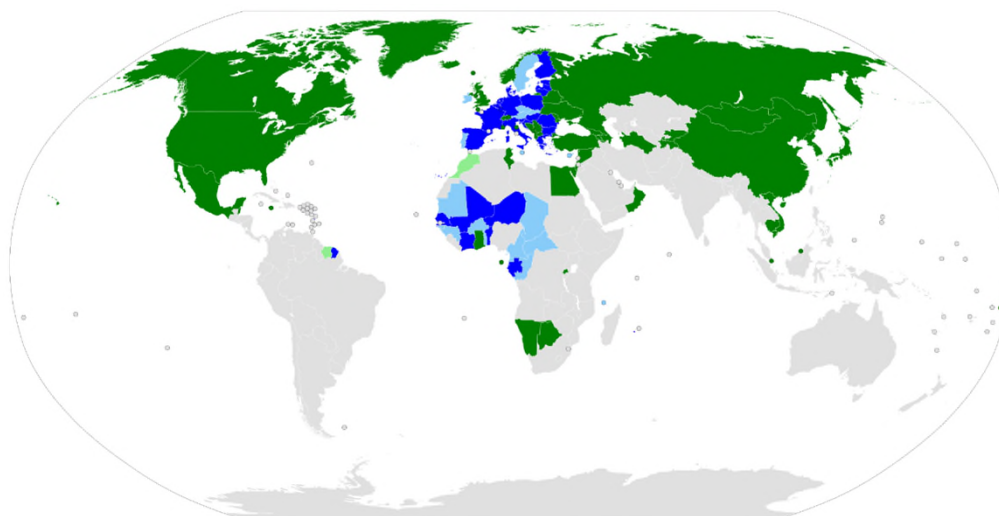
- The designer can prevent third parties from using the design without the proprietor's consent
- exclusive right to use the design and any design which does not produce on the informed user a different overall impression
- Use - making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied; or stocking such a product for those purposes.
- Exclusions – Innocent infringer (no damages), private non-commercial acts, experiments, planes and ships temporarily entering jurisdiction

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.”

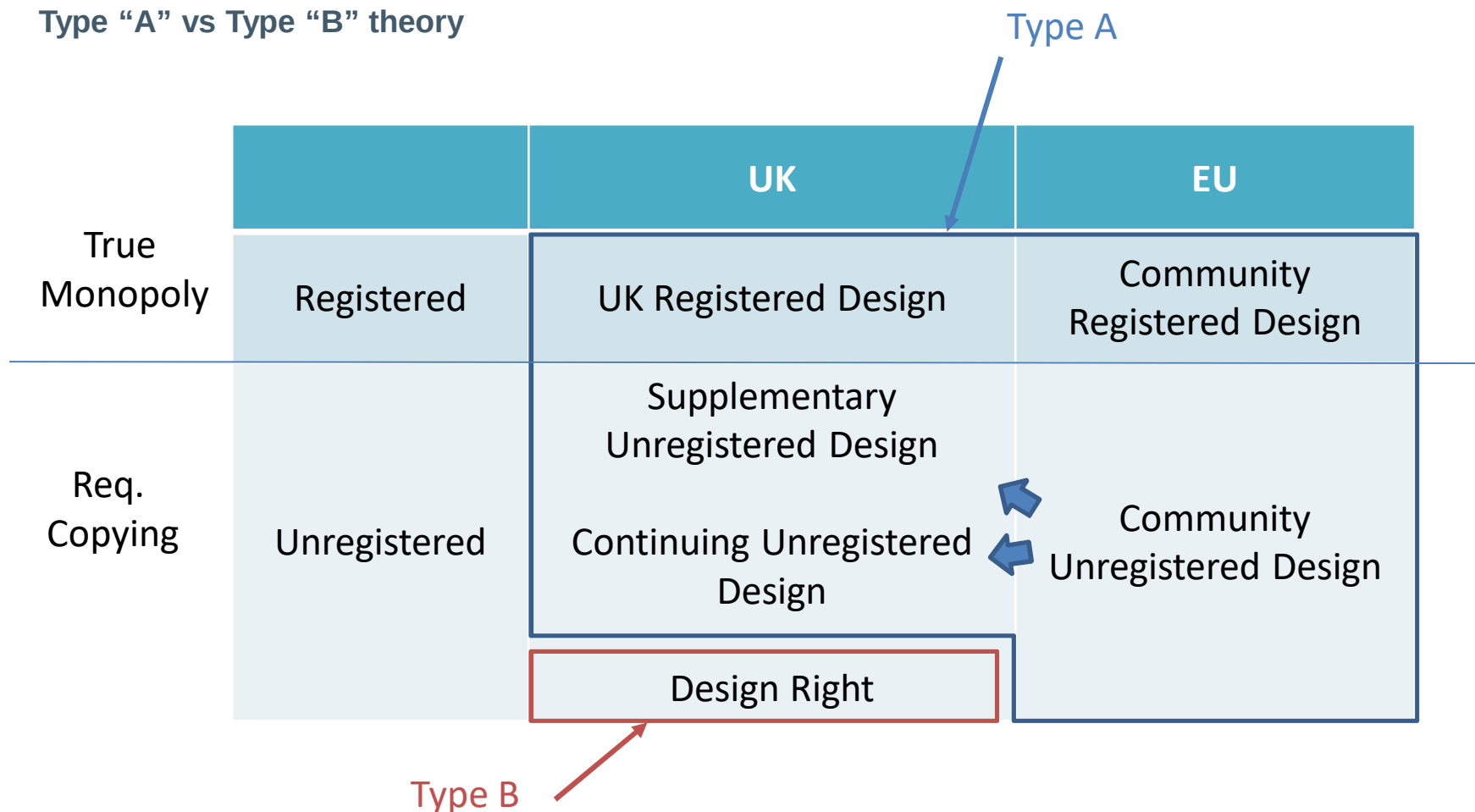
(http://www.wipo.int/treaties/en/registration/hague/summary_hague.html)



Unregistered Designs

Overview of Designs Regime in UK

Type “A” vs Type “B” theory



Type “A” Unregistered

Community Unregistered (EU)

Continuing Unregistered (UK)

Supplementary Unregistered (UK)

Type “A” Unregistered

Similarities with Registered Designs

- Same as registered designs (UK/EU) :
 - o Subject matter protected
 - Lines, colours, contour, shapes, texture, materials, ornamentation etc.
 - Products = objects, surface patterns, GUIs
 - Not technical function, not must fit, visible features only
 - o Ownership
 - Anyone (natural / legal person)
 - o Validity
 - Novelty
 - Individual character

Type “A” Unregistered

Key differences over Registered Designs

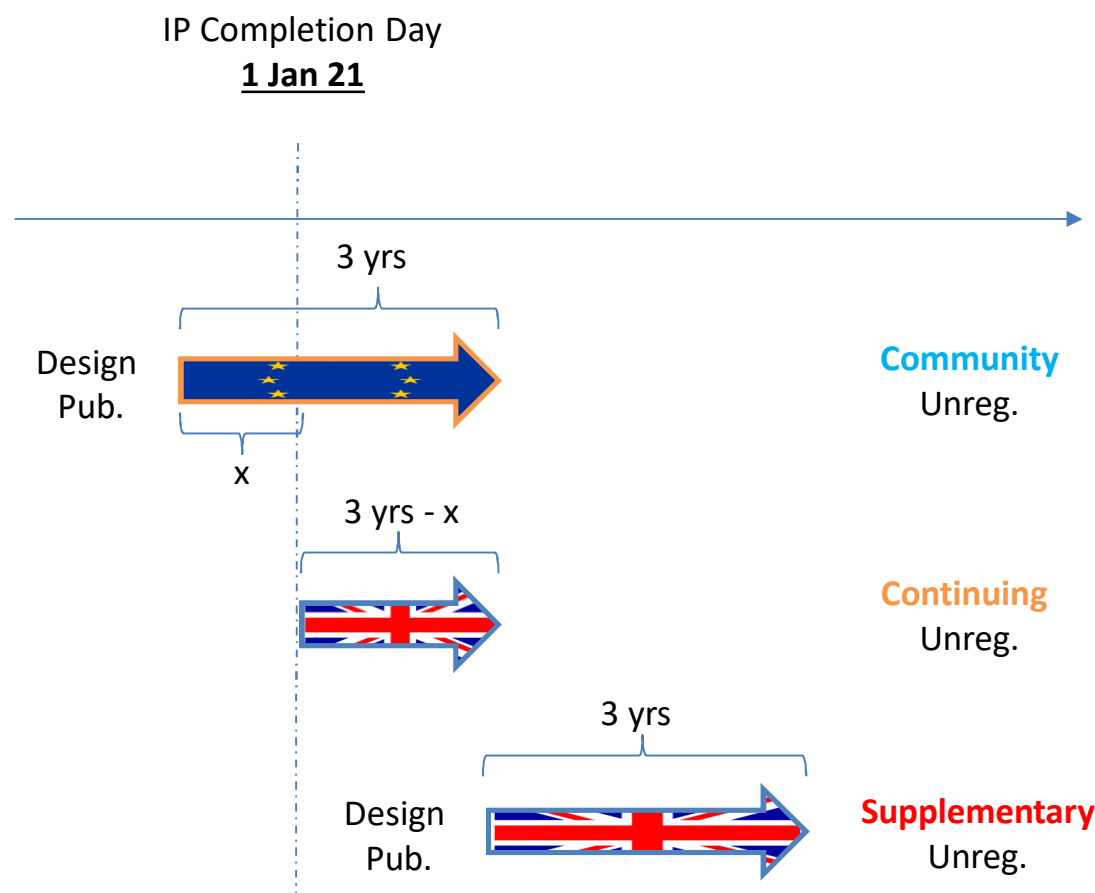
- Arises upon public disclosure of the design, BUT:
 - Only arises based upon the first (i.e. first ever) publication of the design anywhere in the world
- Location of first publication determines which right you get:
 - If first publication occurs in the **EU**
 - **Community** Unregistered Design subsists
 - If first publication in the **UK** or a “qualifying country”
 - **Supplementary** Unregistered Design subsists
 - Qualifying countries are UK, NZ, HK
- Term length
 - 3 years starting from the date of the first public disclosure



Type “A” Unregistered

Differences between Community, Continuing, and Supplementary

- Continuing and Supplementary designs fill the gap left by Community unreg. designs post-Brexit
- Community unreg. designs pre “IP completion day” are divided into EU and UK component
 - o “Continuing” i.e. the continuation of the Original Community Design
- Designs first published in UK post “IP completion day” are
 - o “Supplementary” i.e. an additional type of unreg design to that already available in the UK



Type “A” Unregistered

Infringement

- The scope of protection same as for registered designs, which means:
 - o Covers any design which does not produce a different overall impression
- **BUT**, in addition, **copying** is required
 - o This is the trade off for not taking steps to actively register the design
 - o Copying can sometimes be assumed where there is an extremely close relationship between the designs
 - Immaterial differences, slavish copying, such a close reproduction that it would be almost impossible to arrive at without prior knowledge of the infringed design
- In absence of a slavish reproduction, a causal link needs to be proved on the balance of probabilities
 - o Evidence?

Type “A” Unregistered

Infringement



Original



“Copy”



*Original Beauty & others v
G4K Fashion & others
[2021] EWHC 294 (Ch)*



Original



“Copy”

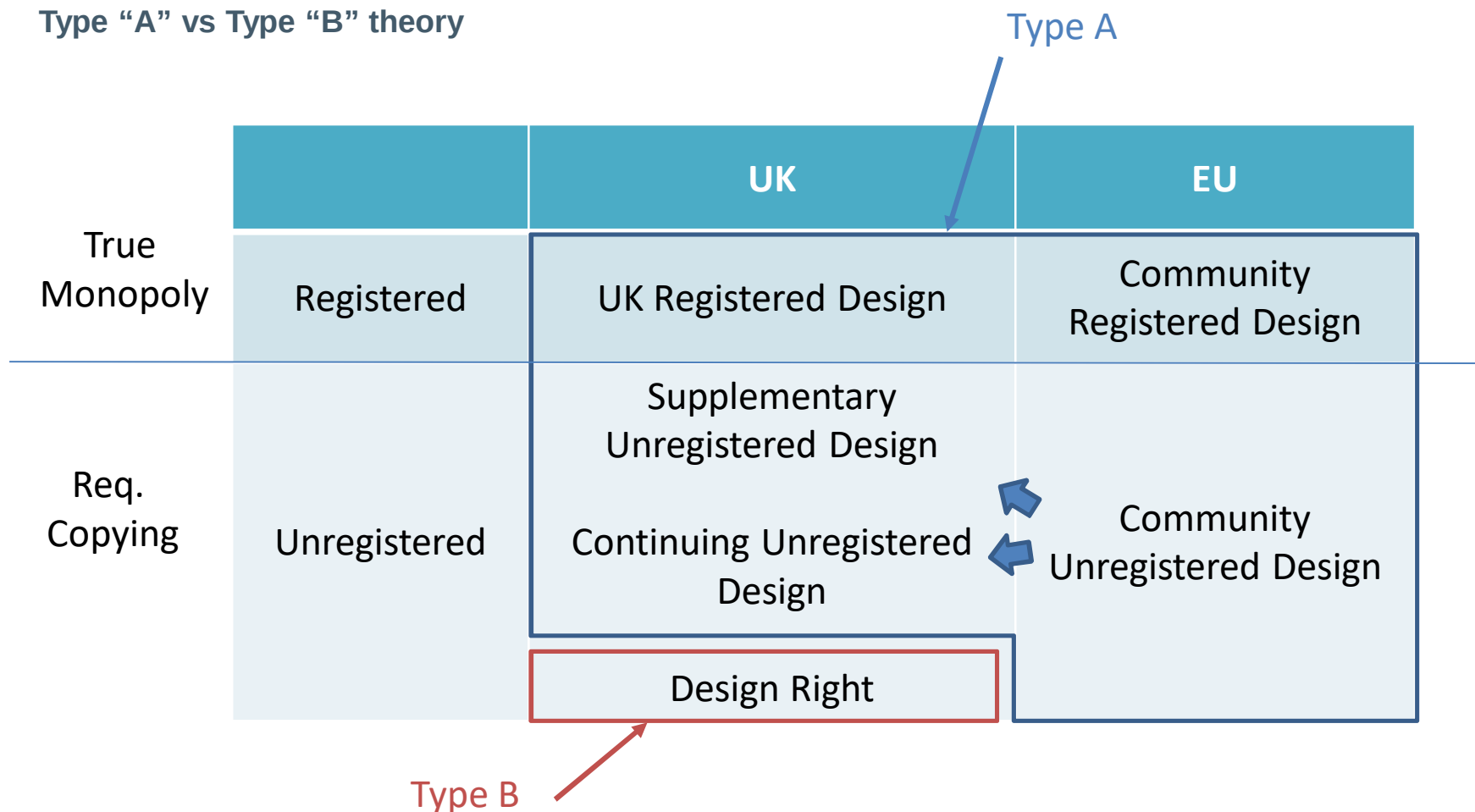
*Rothy’s Inc v.
Geisswein Walkwaren AG
[2020] EWHC 3391 (IPEC)*

Type “B” Unregistered

Design Right (UK)

Overview of Designs Regime in UK

Type “A” vs Type “B” theory



Type “B” Unregistered

Subject Matter Protected

- The **shape or configuration** (whether **internal or external**) of the **whole or part** of an article
 - o **Shape**
 - This means attributes based on three dimensional geometry
 - Does not include:
 - Colour
 - Materials
 - Translucency
 - o **Configuration**
 - Relative arrangement of features in abstract
 - Semiconductor topography
 - Design does not necessarily need to be contiguous

Type “B” Unregistered

Subject Matter Protected

- The **shape or configuration** (whether **internal or external**) of the **whole or part** of an article
 - o **Internal or external**
 - Enables protection for features that are hidden during normal use
 - Semiconductors
 - o **Whole or part**
 - Allows selection of sections of an article (similar to “disclaiming” features in reg. designs / type “A”)

Type “B” Unregistered

Exclusions

- Design right does not subsist in:
 - o Method or principle of construction
 - o “Must Fit” features
 - `Features which enable the article to be connected to another article (same as EU-style)
 - o “Must Match” features
 - Features which are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part
 - o Surface decoration
 - It is not shape or configuration
- Notable absence: dictation by technical function
 - o Possible to protect technical designs (semiconductors, printer cartridges)



Type “B” Qualification for Ownership

Who can own a type “B” design?

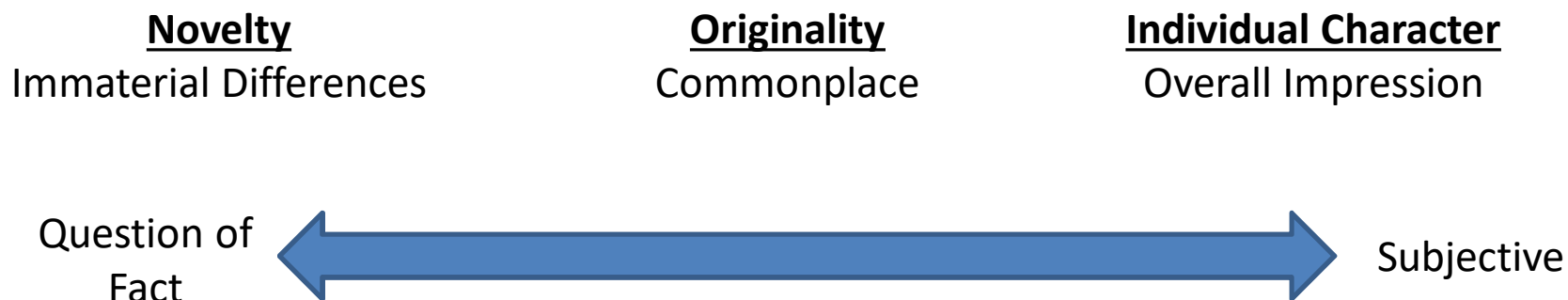
- Only subsists if the person who first owns it is a qualifying person
 - o Natural / legal person resident in qualifying country
 - UK
 - New Zealand
 - Hong Kong
 - o First owner:
 - Designer (not employed), or
 - Employer (if employed), or
 - Person who first markets the product in a qualifying country
(need to be a qualifying person and first market in a qualifying country)



Type “B” Validity

What prerequisites exist for valid protection?

- Design must be **“original”**
 - *Not commonplace* in the design field in question
 - Bar higher than novelty, lower than individual character



Type “B” Infringement

Who can type “B” designs be enforced against?

- **Primary infringement**

- o Owner has the exclusive right to **reproduce the design** for commercial purposes
- o Reproduction means **copying** to produce articles exactly or substantially to the design and includes specifically:
 - Making articles to the design
 - Making a design document recording the design for enabling articles to be made
- o Anyone who does the above without the permission of the owner is a primary infringer

- **Secondary infringement**

- o Importation, possession, selling, hiring, offering infringing articles
- o Infringing articles are articles under primary infringement (i.e. **copies**)

Type “B” Scope of Protection

Who can type “B” designs be enforced against?

- Not a true monopoly
 - o Only protects against **copying**
 - Does not protect against independent genesis
 - o Trade off for not registering
- Same considerations as type “A” unregistered apply
 - o Can assume copying if reproduction is slavish
 - o Otherwise must prove causal link

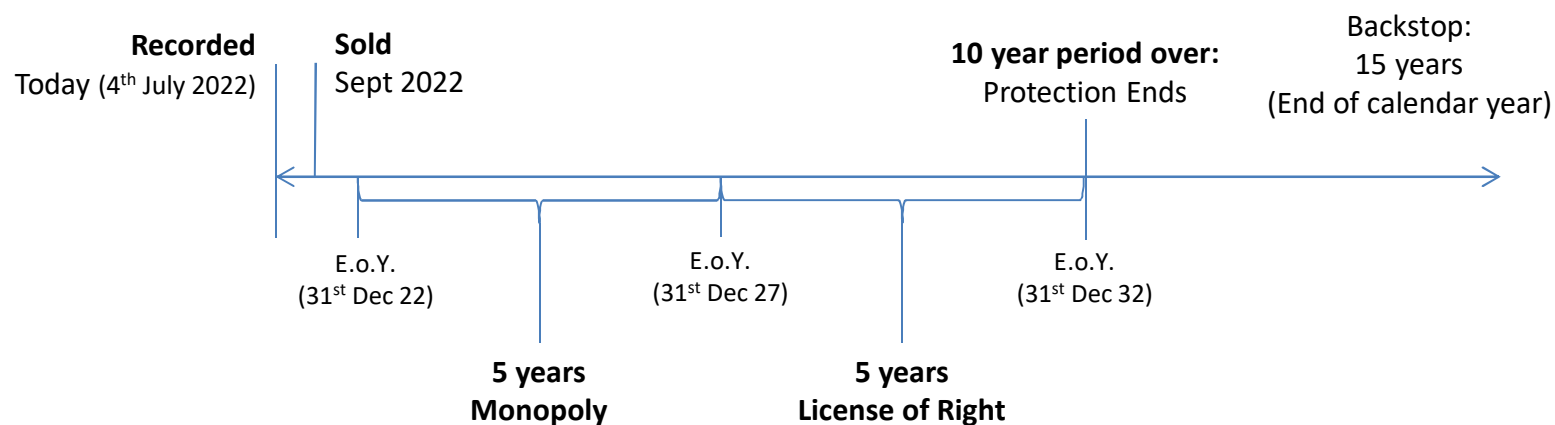
Type “B” Term Length

How long does a Type “B” design last for?

- Begins when design **first recorded** in a design document or an article to the design **first made**
- **Lasts 10 years** from the **end of the calendar year** when the design is **first put up for sale or hire**
 - If you can do first sale on Jan 1st you’ll effectively get 11 years!
- Up to a **maximum of 15 years** from the end of the calendar year in which the design was recorded
 - o You can delay commercialisation, but at expense of useful protection (compare with type “A”)
- **License of right** is available to anyone who wants to use the design in the last 5 years
 - o If you sue for infringement in last 5 years, infringer can obtain a license of right as a defence.
 - o Court will determine value if there’s a dispute

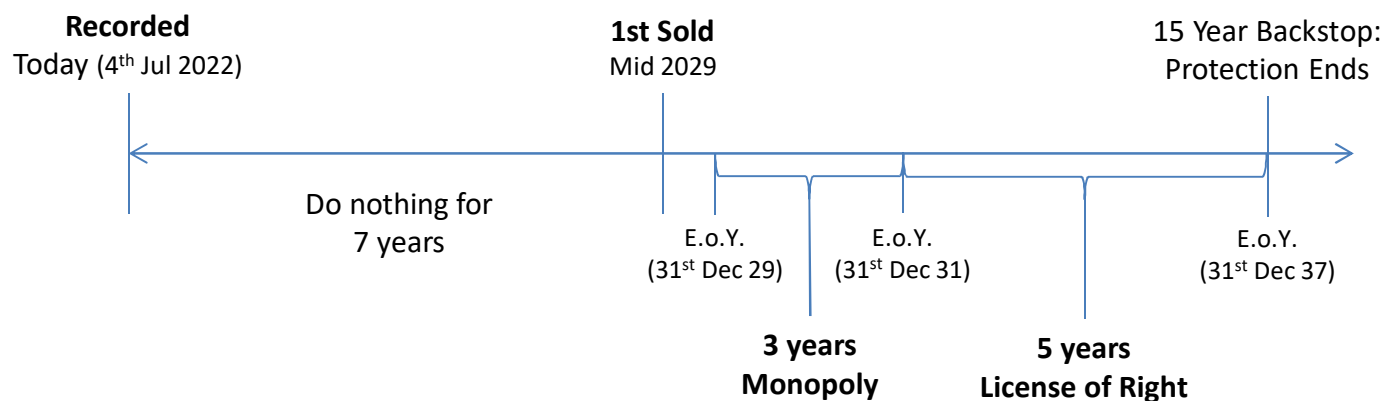
Type “B” Term Length

How long does a type “B” design last for?



Type “B” Term Length

How long does a type “B” design last for?



Comparison of Type “A” vs Type “B”

Protectable?	Type “A” (Everything Else)	Type “B” (UK Design Right)
Non-Visible Features	✗	✓
Technical Function	✗	✓
Surface Decoration	✓	✗
Must fit	✗	✗
Must match	✓	✗
Colours	✓	✗

Contacts

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