

# Design & Copyright Basics

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## 1. Purpose of this document

This document answers some very basic questions that are frequently asked about the protection that is available for designs.

## 2. What is design protection?

Design protection allows the owner to stop someone else using the design. It does not give the owner the right to use the design himself; for example, the design may be similar enough to fall within the scope of protection of a competitor's earlier design, which may mean that a licence is required under that earlier design.

## 3. What types of protection are available for a design?

The protection available for designs falls into two main categories – that which arises automatically subject to certain criteria (known as unregistered design protection) and that which must be applied for (known as registered design protection).

Both types of design protection are available within the UK and within the European Community as a whole, meaning that four main types of design protection are available. These are called UK Unregistered Design Right (UK UDR), UK Registered Design Right (UK RDR), Community Unregistered Design Right (CUDR) and Community Registered Design Right (CRDR).

A UK RDR is applied for at the UK Patent Office and a Community RDR is applied for at the Office for Harmonisation in the Internal Market (OHIM) (although it is also possible to cover the European Community under an International Application filed under the Hague Agreement).

As a general rule, the law governing UK RDR, CRDR and CUDR is similar for all three types of design protection, whereas the law governing UK UDR is slightly different. In some cases, designs can also be protected as trade marks or by copyright. The overlap between those rights is complex and we would need to look at the relevant design to

advise whether these forms of protection are relevant.

## 4. How long does it take to obtain design protection?

UK UDR automatically comes into existence (subject to certain criteria) when an article is made to the design or when a document recording the design is created.

CUDR arises (subject to certain criteria) when a design is made available to the public within the EU.

An application to register a design (whether in the UK or the EC) typically takes 6-8 weeks, provided that the design meets the necessary criteria.

## 5. Is professional assistance necessary?

No - but it is strongly advised. Making an application for a design registration is a relatively complex matter to which a patent or trade mark attorney can bring crucial experience. We are also able to advise on the rights that are available through unregistered design protection.

## 6. What kinds of things qualify for protection?

The kinds of things that qualify for protection depend on the type of design protection.

UK UDR can protect the shape or configuration of the whole or part of an article but it does not generally protect surface decoration. Thus UK UDR would be able to protect the shape of, for example, a vase, but protection would not extend to a pattern on the surface of the vase.

UK RDR, CRDR and CUDR can protect the appearance of the whole or a part of a product, which may be shape or surface decoration (including for example lines, contours, colours, material or ornamentation).

The terms ‘article’ and ‘product’ are applied very broadly and can encompass everything from baby clothing to farm machinery. A given article or product need not be visually striking or significantly different from what has gone before in order to attract design protection. The detailed criteria that must be met to gain protection are set out below.

## 7. Where is the protection for a design effective and how is such protection obtained abroad?

Design protection is generally national, although regional protection such as a European Community design is also available. UK design protection is only relevant to activities within the UK, whereas EC design protection is relevant to activities across the EC.

We are able to handle UK design applications at the UK Patent Office or EC design application at the OHIM, but generally where an application to another local foreign design office is required (e.g. the US) we will use the services of a local attorney there to make the application. In a small number of countries (including Switzerland, Turkey, Singapore, Iceland etc.) it would also be possible to seek protection by way of an International Application under the Hague Agreement. It is expected that more countries will join the International system over the coming years.

## 8. Is the protection available for designs in different countries the same?

No. The criteria for design protection and the protection available vary across different countries. In general, the substantive law governing designs across Europe is harmonised, but the law in the United States and elsewhere differs on several points.

## 9. What does a registered design application look like?

A registered design application sets out various details about the applicant and also contains representations of the design such as drawings or photographs. If the design is for a 2D object (e.g. a design for lace), an actual sample of the design can be submitted

with the application.

## 10. What are the main requirements for obtaining protection for a design?

For UK UDR, the criteria are that the design must be original and not commonplace. Further to qualify for UK UDR, the owner of the rights in the design (see point 24) must (with a small number of exceptions) be an EU citizen or an EU company or articles made to the design must be first-marketed in the EU.

For UK RDR, CRDR and CUDR, the design must be new and have individual character. Unlike UK UDR, any person or company of whatever nationality can qualify for these types of design protection.

## 11. What does ‘original and not commonplace’ mean?

For a design to be original it must originate from the author, i.e. the author must have input some skill and effort to create the design and must not have just copied it from somewhere else. However, even if a design has been independently created it must not be commonplace, i.e. the design must be in some respects different from other designs in the relevant design field. This would be a question of fact in any particular case.

## 12. What does ‘new’ mean?

A design is new if no identical design has been disclosed to the public before the application for the design registration was made. Anyone’s disclosures, including your own, count against a valid design registration. Disclosures made by the designer in confidence do not count. Disclosures that destroy the novelty of the design include publication, exhibition or sale of the design. Disclosures made by the designer or his successor in title, or by a third party as a result of information provided or action taken by the designer or his successor in title, may not count if they occurred in the 12 months before the filing of the design application.

### 13. What does ‘individual character’ mean?

A design has individual character if it would create a different overall impression on an informed user from those designs that have previously been made public. This is obviously a matter of opinion, but the creation of a different overall impression has been contrasted with an impression of ‘déjà vu’, i.e. a design will not have a different overall impression if it seems to the informed user that he/she has seen the design somewhere before. The first design cases under the new European Design Directive are going through the courts and a better understanding of the concept ‘individual character’ will emerge as the relevant case law builds up

### 14. What aspect of the design is considered when deciding if these requirements are met?

A part of a design or the design as a whole may be considered.

### 15. What aspects of a design are excluded from protection?

Certain aspects of designs are excluded from protection. However, the law governing exclusions is complex and differs depending on the type of design protection required. In general terms, the following may be excluded from protection:

- A part of a design where the shape is solely dictated by function.
- A part of a design that is a certain shape to allow it to connect with other objects.
- A part of a design that is a certain shape to allow it to fit in with the overall appearance of the article.
- A part of a complex article that is not visible in normal use.

We would strongly recommend that specific advice on potential exclusions is taken in any particular case.

## 16. What happens if there has already been a disclosure of the design and registered design protection is required?

Take advice to see if the disclosure was confidential. If the disclosure was in confidence then there should be no problem. If the disclosure was less than 12 months ago, then the disclosure should not affect the ability to obtain valid protection (see point 12 above).

## 17. What are the stages of applying to register a design?

The general sequence is as follows: preparing the design application, filing the application, official examination of the acceptability of the application, registration and publication of the design.

If an application is made correctly then it is usually accepted automatically as there is little or no substantive examination. A design is usually only rejected if it is obviously an old design.

## 18. How long does design protection last?

The maximum periods for each of the different types of design protection are as follows:

UK UDR – 15 years from the end of the year in which the design was created or 10 years from the end of the year in which the design is first put on the market (whichever is the shorter).

UK RDR – 25 years from registration (subject to the payment of renewal fees every 5 years).

CRDR – 25 years from registration (subject to the payment of renewal fees every 5 years).

CUDR – 3 years from the date the design is disclosed to the public.

## 19. What are renewal fees?

To keep registered designs in force it is necessary to pay fees to the relevant designs office. Following registration, renewal fees must be paid every 5 years for UK and EC registered designs.

## 20. How is the protection for a design enforced?

Infringement of a design, i.e. making, using, selling, importing etc. something that is identical or very similar to the design, is pursued by a civil action through the courts for damages and an injunction. It is not a criminal offence. Law enforcement agencies do not monitor whether your design is being infringed nor can they take action against infringers on your behalf.

## 21. What advantages are there in applying for a registered design rather than just relying on the automatic unregistered protection?

1. Registered designs offer longer periods of protection (up to 25 years subject to the payment of renewal fees) than is available with unregistered design rights. Moreover, an infringer may take a licence of right in the last five years of unregistered design right whereas this possibility does not exist where a registered design is infringed.
2. A registered design right is a monopoly right. This means that even if someone else comes up with your design independently, you have the right to stop them using it. Unregistered design rights are not monopoly rights and to enforce an unregistered right you must show that an infringer copied your idea, i.e. if they can show that they came up with their idea independently, they will escape infringement.

3. A UK or EC registered design can be used as a stepping stone for gaining protection in other jurisdictions.
4. The mere fact that a design is registered may be enough to deter potential infringers.
5. Registering a design provides a 'line in the sand', i.e. a recorded date from which priority over later designs can be established with certainty.
6. Not everyone qualifies for UK UDR, whereas any person or company, of whatever nationality can apply for a UK or Community registered design (see point 10).

## 22. Can a protection for a design be challenged?

Yes. It is open to anyone to make an application for a declaration of invalidity of a registered design whether it is a UK or an EC registered design.

It is also possible to question the validity of design protection (whether registered or unregistered) in a court action. In fact, the defendant in an action for design infringement will nearly always argue, by way of defence, that the claimed design is invalid.

## 23. Do design disputes always end in an expensive trial?

Most design disputes do not make it to trial because the merits of the case become apparent to the parties before that point and they are settled by negotiation.

Further the invalidation processes offered by the UK and European design offices provide a way for interested parties to challenge the validity of registered designs less expensively than in court proceedings.

## 24. Who owns the rights to the protection in a design?

Under UK and European law, the usual rule is that the designer is the first owner. Two

important exceptions are that if a design is created in the course of employment, the employer will generally be the first owner. Secondly, and in relation to UK designs but not EC designs, if the design is commissioned, the commissioner will be the first owner.

## 25. Why is protection for a design commercially useful?

There are basically three ways to make money out of a right in a design (whether unregistered or registered):

1. You can licence the right in the design. In effect, you promise not to sue the licensee for design infringement, and he promises something, usually money, in return.
2. A right in a design is a piece of property, so you can sell it.
3. You can use it to keep out competitors and therefore charge higher prices.

Because of the ways income can be derived from them, rights in designs can also be useful for attracting investment into a company.

## 26. What risks are involved in design protection?

Firstly, since a rigorous examination of the merits of a particular design registration application is not normally carried out, even once a design has been registered it may be susceptible to an invalidity attack on the basis of, for example, previously known designs.

Secondly, since there are no truly objective tests for design criteria such as 'commonplace', 'individual character' or 'different overall impression', it can never be said with certainty how any court case involving a design dispute will be decided.

Another risk not directly related to a right in the design is, of course, that the product (whether it is your own or a licensee's) will fail commercially. If that happens then all the expenditure related to it, including of course, the design registration, will probably have been wasted.

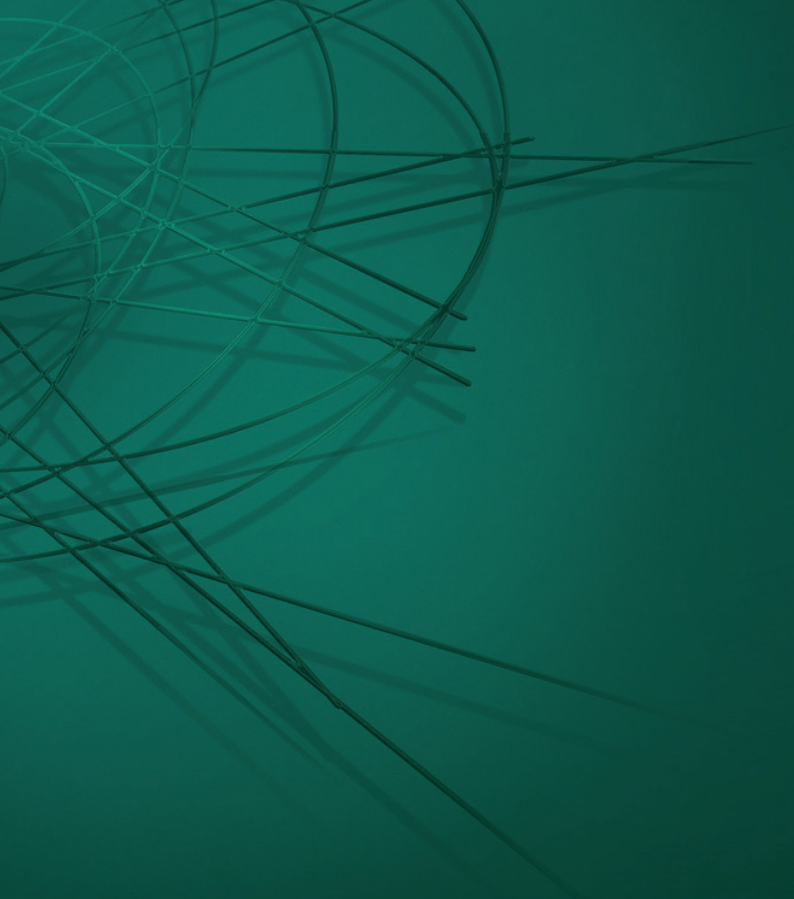
## 27. Which designs make money?

The ones for successful products. Picking a winner is, of course, difficult, but a right in the design often increases the return on the investment made.

### Important Note

Design law, procedure and strategy have many complexities and subtleties. Therefore this document cannot be taken as the basis for action; you should take advice in any particular case.

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