

Registered Design Rights

Changes in the Law

What are "design rights"?

For certain businesses the value of a new product lies in the originality of its design. The dyson range of suction cleaners and washing machines is a good example.

Design rights are those rights that exist in the appearance of products. These rights include the right to the exclusive right to use and exploit the design and to prevent copying of the design.

These designs can be protected in various ways but most commonly through a registration process or through the law of unregistered designs.

Are all design rights registrable?

No, but a design that does not qualify for protection through registration could still be protected by other rights, such as unregistered designs. It is important to decide which form of protection will apply to a product design in any given situation.

The law relating to registered designs is set out in the Registered Designs Regulations 2001, which came into force in December 2001.

Although registered designs existed before this date, the old law lagged behind the changes being made from the European legislators in relation to copyright and trade marks.

This Information Sheet focuses on the position relating to registered designs.

What are the requirements for registration?

There are two main requirements: the design must be novel and must have individual character.

Novelty is an established concept. A design will be novel if no identical or similar design is already known to the public before the date of an application for registration.

A design for which protection was sought in certain other countries in the six months preceding a UK application can claim priority in the UK, backdated to the date of the earlier application.

Regarding individual character, the Regulations say that the design will meet this requirement if the overall impression that it gives to an informed user is that the design is different to any other design which has already been made available to the public. In

assessing individual character, the registry will take account of the degree of freedom of the designer in creating the design..

How can I test the market for my design?

There is an exemption built into the Regulations in relation to the disclosure of designs prior to an application being submitted. If a designer reveals the design in the 12 months before submitting an application, this will not destroy the novelty.

Caution is needed, though. The exemption only extends to the designer, its successor in title or to a third party who has obtained the information from the designer. This means that if another designer comes up with a similar enough design that is disclosed before an application is submitted, the novelty requirement might not be met. In practice, this means that it is always better to submit an application as soon as possible.

Is it possible to copy a design developed outside the EEA?

The legislators in Europe are increasingly conscious of the shrinking world wide market-place. They have introduced a test to address this. When considering novelty and individual character, the comparison must be made with designs disclosed throughout the world.

Although this seems like a hard test, there is an exception for designs which could not reasonably have been known in the EEA in the sector concerned.

What designs are not protectable?

There are certain aspects of a product which cannot get the benefit of a registration.

An example of this is technical designs. These are designs which are dictated solely by the product's technical function, where no other shape would perform the same function. A similar exclusion existed under the old law and had the effect of preventing the registration of functional designs.

Another example is the exclusion for features which must exist in their exact form and dimensions in relation to the product concerned. Think of a plug, which must be of a certain design to fit into a socket. This appears to be no more than an extension to the technical designs exclusion, though.

The Regulations do specifically allow for the design of modular systems such as building bricks and shelving systems to be registered. In this sort of case, the fact

that the systems interconnect is a feature and not a requirement of the product.

Further, designs which are:

- concerned only with how a product works, or
 - for parts of complex products which are not visible in normal use, or
 - contrary to law or morality
- cannot be registered.

If I do not register my design am I left without any protection?

One of the most interesting aspects of the Regulations from the point of view of the lawyer is how it will co-exist with existing intellectual property law.

As well as registered designs, there is law relating to unregistered designs, copyright and both registered and unregistered trade marks. All these rights will need to be considered in relation to any new design or brand.

It is possible to envisage situations where multiple rights apply to a design. There is no doubt that larger organisations will seek every possible form of protection. There is nothing in the Regulations that precludes this.

So, consider a new flower pattern for a plate – there is no reason in theory why, subject to the provisions of the applicable Acts or regulations, the pattern could not be protected

- by the law of copyright, as an artistic work
- by the law of trade marks as a sign capable of graphical representation
- by the law of registered designs as an aspect of appearance of a product

This is a conundrum that will need to be resolved by the Courts. However, this should be distinguished from the case where rights already exist in the design. Where a trade mark has been registered by party A, party A could object to an application by party B to register the design.

A further implication is that in certain cases it may be prudent to carry our searches both at the Designs Registry and at the Trade Marks Registry, before an application is submitted.

Conclusion

Designs are prone to copying in the same way as music or software recordings. It is important therefore to protect those designs in an appropriate manner.

Although design rights exist as a form of protection, the other purpose behind them is to stimulate innovation in design. Although the question of how a given design may be protected is that bit more complicated, there is no doubt that the Regulations provide a much broader framework to protect designers and their work.

This information sheet has been prepared by the E-Commerce and Intellectual Property Unit to highlight some key issues relating to the Design Regulations and the law of designs generally. It is intended to be for general guidance only and is not a substitute for specific advice. It is based upon our understanding of the legal position as at August 2005 and may be affected by subsequent changes in the law.

Should you require any specific legal advice on the issues covered, please e-mail Nicky Androsov at nicky.androsov@ts-p.co.uk or call on 01892 510000.

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