

brief guide to design

From an Intellectual Property perspective a design consists of the appearance of a product or a part of a product. It can include the lines, contours, colours, shape, texture or materials of the product or its decoration.

It includes, for example, the shape of a product or packaging, the decoration applied to a product or the appearance of a graphic symbol.

Some Design Rights arise automatically while others must be registered to provide protection. The differences between these rights in the UK and the European Union (EU) are outlined below.

uk unregistered design

As the name suggests, this right comes about automatically when an item is made to a particular design or a document is created which consists of a record of the design, as long as the designer is a national of the EU or of a non-EU country offering reciprocal protection to nationals of the UK.

Only original designs which are not common place in their field qualify for UK Unregistered Design protection and there are specific exclusions to designs consisting of certain features, such as surface decoration; or elements which enable the article to match another item, such as a spare part.

UK Unregistered Design Right lasts for a maximum of 15 years but less if the designed item is put on sale within 5 years of the design right being created. The right is only infringed if it is proved that the design was **copied** without authorisation – a person who independently comes up with the same or a similar design will not infringe. Un-authorized dealing in an infringing design is also considered an infringement if there was knowledge that the item is an infringing product.

unregistered community design

This is also a right which comes about automatically. The right only comes into effect once the design has been made available to the public in the EU. It provides protection for the appearance of the whole or part of a product, i.e. any industrial or handicraft item, including typefaces and graphic symbols.

There is no restriction on the nationality of the designer in relation to Unregistered Community Design rights, so non-EU nationals are entitled to enforce such rights.

In order to qualify for protection the Design must be **novel** and possess **individual character** which means it must produce a different overall impression from any design which has already been made available to the public.

There are limitations to the protection given in respect of certain features of the product designed, for example features dictated by function or elements which enable the article to match another item, such as a spare part.

The right only provides protection for a period of 3 years from being made available to the public in the EU and, like the UK Unregistered Design Right, the Community Unregistered Design is only infringed if it is proved that the design was **copied** without authorisation. Un-authorized dealing in an infringing design, regardless of knowledge that the item is an infringing product, is also considered an infringement.

UK registered design

A UK Registered Design will protect the appearance of a product or part of a product. It can include the lines, contours, colours, shape, texture or materials of the product or its decoration. It could be the shape of the product, the decoration applied to the product or both. However, it is the design itself which is protected by the Registered Design and not the product to which the design is applied. Examples of designs which can be protected include packaging, containers and labels.

A new development in Registered Design law is that it is now possible to file applications in respect of two dimensional “graphic symbols”. A logo brand could qualify as a graphic symbol so Registered Designs can be an effective complement to your registered trade mark protection in respect of brand identities which incorporate a design element. We can advise you on how to use Design Law to best protect your trade marks.

In order to be registrable a design must be **novel** and have **individual character**. These standards are assessed in the context of designs that have been publicly disclosed before the filing date of the Registered Design in question. Before filing your design application we can carry out a search of the register on your behalf and advise on the extent to which your design has individual character.

An exception to the novelty requirement is that there is a twelve month grace period for filing design applications in respect of designs which have been disclosed by its designer in the UK. This will enable you to test the market for your design before making the application but may prevent you from obtaining valid Design Registrations in foreign countries, particularly outside the EU, as many **do not allow any disclosure** prior to filing.

Your design will only be protected from the date you applied for it and on registration you will have the exclusive right to make, import, export, use or stock any product to which the design has been applied. A valid Registered Design will entitle you to stop any unauthorised use of the same or similar design **regardless of whether or not the offending design was copied**.

applying for registration

It is necessary to file two identical sets of illustrations of the design with the application. The drawings must show the design from different angles in order to give a complete picture of the design and each one must be labeled. We can arrange for suitable drawings to be prepared for your application.

Once an application has been filed the registry will examine the application to see if it is acceptable for registration - this is a relatively simple process and serious objections are not common.

However, designs which are concerned only with how a product works are not accepted, neither are designs which form parts of complex products which are not visible in normal use. The registry will also refuse any design which is contrary to law or morality.

If the registry objects to your design we can file arguments to try and persuade the examiner to accept it. If necessary we can attend a hearing to discuss the matter with a senior examiner.

If your design is not objected to, or once any objections raised are overcome, it will proceed to registration and will be published in the Patents and Designs Journal.

The time frame for obtaining a registration if no objections are raised is about 3 months.

community registered design

The basics of a Community Registered Design are similar to the outline given above in relation to the UK Registered Design.

However, the protection given by a Community Registered Design extends to all 25 member states of the European Union. It is a cost effective way of obtaining protection if you are interested in multiple countries in Europe.

In addition, with a Community Registered Design, it is possible to include more than one design in a single application and costs are reduced progressively as the number of designs included is increased. This is another cost effective feature of the Community system.

how can we help you ?

We can advise you on all aspects of Design Law from clearance to registration and enforcement. Once you have made a decision on the best strategy for you we can implement appropriate design filings in all design jurisdictions around the world and take care of all registration and maintenance requirements.

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