



what you need to know to start and grow your business

design rights

What are design rights?

Design rights protect the 'look and feel' (appearance, surface decoration, shape) of commercial 2D or 3D articles, fabric and wallpaper patterns, fashion clothing, packaging and 'get-up', furniture, jewellery, graphic symbols including app icons, and website graphic user interfaces. There is a registered exclusive right available in many countries and also an unregistered right to stop others copying. There is another unregistered design right in the UK to protect functional 3D shapes.

REGISTERED DESIGN RIGHT (SURFACE DECORATION, 2D/3D LOOK AND FEEL)

- UK, EU, Other territories
- Protects visible, 2D or 3D lines, contours, colours, shapes, textures, materials, surface decoration, ornamentation IF
 - 'Novel' (materially different from prior designs)
 - 'Individual character' (creates different overall impression on 'informed user')
 - Features not dictated solely by technical function
 - Features not needed to connect/fit next to other product
 - Not offensive
 - Not a protected sign (flag, Olympic rings, etc.)
- File application at relevant territory IP Office (Hague system to streamline multiple country applications)
- 12 month 'grace period' to apply after first public disclosure by designer (still deemed 'novel')
- Lasts up to 25 years from filing date (renew every 5 years)
- Can stop others using design even if they produced it independently and did not copy
- Low cost (UK: from £50/EU: from €230) + attorney fees
- Time: up to 2 months for UK, can be weeks in EU
- Notice marking: "Registered design [insert registration number] OR 'web-marking' link to website giving registered design details"

UNREGISTERED EU (COMMUNITY) DESIGN RIGHT (SURFACE DECORATION, 2D/3D LOOK AND FEEL)

- Protects same designs as registered right
- Arises automatically on creation (no need to register) BUT
 - Need to show others copied your design
 - Only lasts 3 years from first publication, exhibition, use in trade or other disclosure
 - Covers whole EU area (BREXIT: UK to create equivalent UK right)
 - Often asserted for fast moving goods eg fashion clothing where long-term protection not needed
 - Notice marking: "All rights in this design are owned by [owner name] and infringement will be pursued."

UNREGISTERED UK DESIGN RIGHT (FUNCTIONAL SHAPE)

- Protects shape/configuration of 3D articles only: does not protect surface decoration/pattern IF
 - Original: not copied and not 'common' in relevant technical field
 - Not a spare part that must fit/match
 - Arises automatically on creation of article to design or design document (no need to register) BUT
 - Need to show others copied your design
 - Lasts 15 years or 10 years from date of first sale if you offer for sale article made to the design in the first 5 years
 - You must offer a licence to others if asked during the last 5 years
 - Notice marking: "All rights in this design are owned by [owner name] and infringement will be pursued."

How are design rights different from copyright or trade marks?

There is overlap, and more than one IP right may be relevant:

- Copyright could protect a logo or artwork that appears in an overall design right - protected design (eg pattern, clothing) or copyright could protect a 2D design document for a 3D design-right protected article.
- There may also be trade mark protection for logos or shapes of a design-right protected article.
- One-off pieces of sculpture or furniture may qualify for longer copyright protection as 'works of artistic craftsmanship' rather than design right-protected commercial articles.
- If you have copyright and unregistered design right in a work, you need to bring an infringement claim under copyright.

Who owns design rights?

- Registered design right: applicant owns.
- Unregistered design rights: creator of design/design document owns the rights but employer owns unregistered design right in employee's creation made in course of employment duties.

If you commission a design from a contractor, you won't own the design rights in it unless you agree this in the contract.

When are design rights infringed?

REGISTERED DESIGN RIGHT (UK OR EU)

- When someone makes, sells, hires out, offers for sale or hire, imports, exports or uses design, or product in which design is incorporated/applied, or stocks such a product for these purposes.
- Also covers designs which do not produce a different overall impression on user
- It is still infringement even if independently created (not copied)

UNREGISTERED EU DESIGN RIGHT

- Same as for registered design IF
 - Any of these acts result from copying the relevant design (it's not infringement if you independently created the same design)
 - Also covers designs which do not produce different overall impression on user

UNREGISTERED UK DESIGN RIGHT

- Same as for registered design IF
 - Any of those acts result from copying the relevant design OR
 - Knowingly deal in infringing copies for commercial purposes
- Also covers designs substantially the same 'as relevant design' (qualitative or quantitative copying: a small but key element could infringe)

What defences are there?

- Using the design for private or non-commercial purposes
- Experimental purposes
- Teaching or citation IF compatible with fair trade AND does not unduly prejudice normal exploitation of design AND mention source
- Product with relevant design has already been put on market in EEA by/with consent of owner ('exhaustion' of registered design right).
- Using component part to which design relates to repair complex product to restore original appearance
- Prior use/preparation to use before date of application of registered design: can continue to use for same purposes
- Using equipment on non-UK ships/aircraft whilst temporarily in UK territory or importing spare parts to repair such non-UK ships/aircraft
 - If you have a licence to use
 - Making copy in more easily accessible form for disabled users
- Unregistered design rights: no infringement if you did not copy the design

How to handle design right infringement claims

Where to bring a claim

- Opposing registered design application:
 - UK IP Office (appeal from IPO to Court)
- Infringement:
 - Online marketplace/social media internal take-down process
 - Court: Initial claim (cease and desist letter) then
 - Intellectual Property Enterprise Court (<£500k damages claim)
 - High Court (damages >£500k); appeal to
 - Court of Appeal (on point of law); appeal to Supreme Court (if of great public importance)
 - Be ready to consider mediation/try to settle before you get to Court
- Registered Design Counterfeiting (criminal offence):
 - Trading Standards
 - HMRC
 - Magistrates/criminal Court(need to show 'beyond reasonable doubt' intentional copying or knew/had reason to believe the design copy was registered)

What to think about

- Don't panic
- Instruct IP attorney at least for court claims.
- Can claimant show all aspects of claim:
 - Does relevant design right subsist/is it valid (all criteria met)?
 - Does claimant have right to bring claim (owns the right/has exclusive licence, not left it too late)?
 - One or more infringing acts carried out?
 - No defence available?
 - Sufficient evidence to show it?
- Any possible counterclaim(s) by defendant (including for groundless threats of court action)?
- What do you want to achieve? (Claimant: stop others selling relevant goods/services, or licence fee, or access to their IP/products in return? Defendant: right to continue selling - prepared to pay licence fee - or have a registered design right declared invalid/reduced in scope)
- Do you have time/energy/resources to fight all the way?

What Remedies are available?

- Online take-down: removal of infringing goods/content from relevant site/apps only
- Settlement agreement before court decision: maybe payment and/or licence grant
- Opposition: competitor's application for registered design right is refused/restricted
- Infringement: court order stopping infringing act; damages/account of profits; delivery up/destruction of infringing items; Registered design right - affirmation of validity/declaration of invalidity
- Counterfeiting: seizure of goods; fines; prison

Also think about

- Logos: registered and unregistered trade mark rights; copyright
 - Artwork, graphic designs: copyright
 - Shapes: registered and unregistered trade marks
- Technical Inventions (idea rather than appearance): patents, trade secrets/confidentiality
 - Join 'ACID' (Anti Copying in Design, non-profit trade organisation): record your unregistered design as proof you created it and when, and get help and guidance.
 - Licensing Your Creations, Technology & Brands
 - Online Copying

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