

United Kingdom

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Legal framework

Designs can be protected in the United Kingdom by unregistered design rights and UK registered designs. Statutes relevant to design rights in the United Kingdom include the Copyright, Designs and Patents Act 1988 and the Design Right Rules. Statutes relevant to UK registered designs include:

- the Registered Designs Act 1949 (as amended by the Copyright, Designs and Patents Act);
- the Registered Designs Rules;
- statutory instruments; and
- the EU Designs Directive (98/71/EC), which harmonises registered design law within the European Union.

A qualifying design is automatically protected by the design right in the United Kingdom. The design right provides a shorter period of protection than a UK registered design. Design rights protect against copying only, whereas a UK

registered design provides monopoly protection.

Provisions relating to the validity and scope of UK registered designs are harmonised with Community registered designs by implementation of the EU Designs Directive, which came into force in the United Kingdom on December 9 2001. Similarly to registered Community designs, UK registered designs are required to pass only formal, not substantive, examination before registration.

Unregistered designs

An original design, recorded in a design document, of the shape or configuration of a three-dimensional product can be protected in the United Kingdom by the design right. A design right subsists automatically for qualifying designs; however, it protects only against copying.

Section 213(2) of the Copyright, Designs and Patents Act provides that a design right is afforded to the “design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article”. The limitation of “shape or configuration” excludes surface decoration and ornament.

There is a two-stage test to determine

originality. First, a design must be the result of the designer's own skill and labour. Second, the design cannot be commonplace. In *Farmers Build Ltd v Carier Bulk Materials Handling Ltd*, [1999] RPC 461, a test was established to determine whether a design is commonplace. The test considers the previous designs in the field of the design and the design freedom available to the designer. The requirement is not the same as the novelty requirement for UK registered designs.

Exclusions to the scope of design rights, as defined by Section 213(3) of the Copyright, Designs and Patents Act, include methods or principles of construction. In addition, 'must-fit' and 'must-match' exclusions prevent the protection of designs that must be functionally fitted or aesthetically matched to another article. These provisions were intended to reduce the ability to use design rights to control spare-parts markets.

The designer is the person who first makes the design; he or she is also the first owner of a design which is not created due to a commission or in the course of employment. In order for a design to be protected by a design right, the designer or employer or commissioner, if relevant, must be a qualifying individual or person respectively. A design qualifies for design right protection if the designer is "a citizen or subject of, or an individual habitually resident in, a qualifying country". At the time of writing, 'qualifying countries' are the United Kingdom (including the Isle of Man and the Channel Islands), all EU member states, Anguilla, Bermuda, the British Indian Ocean Territory, the British Virgin Islands, the Cayman Islands, the Falkland Islands, Gibraltar, Hong Kong, Montserrat, New Zealand, Pitcairn, Henderson, the Ducie and Oeno Islands, St Helena and dependencies, South Georgia and the South Sandwich Islands and the Turks and Caicos Islands.

Alternatively, a "design qualifies for design right protection if it is created in pursuance of a commission from, or in the course of employment with, a qualifying person". A 'qualifying person' is a body having legal personality, which was formed in the United Kingdom or another qualifying country or "has in any qualifying country a place of business at which substantial business activity is carried on".

If a design does not qualify for protection by virtue of the designer, employer or commissioner, then it may qualify for protection if it is first marketed in a qualifying

country (as above) by a qualifying person with exclusive marketing rights.

A design right is established when the design is first recorded in a design document or when an article made to a design is first made available to the public. The owner has the exclusive right to reproduce the design for commercial reasons by making articles to the design or by making a design document recording the design for the purpose of making articles from the design. If a third party carries out these activities without permission, it may infringe the design right. However, it must be shown that the third party has copied the design (ie, it is insufficient to show that the designs are identical or similar).

A UK design right lasts until the earlier of 15 years from the end of the calendar year in which the design was first recorded or 10 years from the end of the calendar year in which the design was first made available to the public. During the last five years of protection provided by a design right, a third party is entitled to a licence as of right, if it wishes to use the design. Terms of the licence are settled by a court, if not agreed.

The UK semiconductor topography right is a specific form of unregistered design right that applies to designs for integrated circuits. In order to be afforded protection, the same requirements apply to a semiconductor topography design as those which apply to designs protected by a design right (ie, the design must be original and not commonplace). Unlike design rights, the semiconductor topography right does not require that licences of right be available during the last five years of the term of protection.

Registered designs

A registered design protects the appearance of the whole or part of a product. The appearance can be the shape, configuration, surface pattern, texture, material or any other feature of the appearance of a product. A 'product' means any industrial or handicraft item, including parts intended to be assembled into a complex product.

A registered design provides protection for a period of up to 25 years, subject to payment of renewal fees every five years. UK registered designs provide monopoly protection; therefore, it is not required to prove that

copying has occurred to show infringement of a registered design. As previously mentioned, the protection provided by UK registered designs has been harmonised with the protection provided by registered Community designs.

For a design to be registrable, it must be new and have individual character. A design is new if “no identical design” has been made available to the public before the filing date or the priority date, if applicable. A design is considered to be identical to another pre-existing design if the only differences are immaterial.

A prior art design is deemed to have been made available to the public if it has been made public in any way, unless the publication thereof is too obscure such that “it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned” (Section 1B(6(a)) of the Registered Designs Act). It was established in *Green Lane Products v PMS International Group Plc*, [2008] EWCA Civ 358 that the “sector concerned” is the sector of the prior art, which is not necessarily the same as the sector of the design.

There is a 12-month grace period before the filing date or priority date, if applicable. Disclosures in the grace period by the owner or its successor in title, as a result of either of its disclosures or an abuse, do not affect the validity of a registered design.

In order to have individual character, a design must produce a different overall impression on the user. The user is an informed user who is aware of the design corpus. The degree of freedom available to the designer is a determining factor of whether a design would make a different overall impression on a user. The more crowded the design corpus and the more limited the freedom available to the designer, the smaller the differences required to have individual character and the smaller the ambit of protection. On the other hand, a striking design in an unconstrained field can have a wide ambit.

Exceptions to the protection afforded by a registered design include “features of appearance of a product which are solely dictated by the product’s technical function” (Section 1C(1) of the Registered Designs Act). ‘Must-fit’ features are also excluded from protection by registered

designs, but the exclusion is defined differently from the design right. The ‘must-fit’ exclusion for registered designs does not apply to products in a modular system (eg, construction toys or modular furniture), so that interconnection features of such products can be protected by registered designs. There is a ‘not-visible’ exclusion, which means that any part of a complex product is protected only if it “remains visible during normal use” (Section 1B(8(a)) of the Registered Designs Act) when the part is incorporated into the product. ‘Normal use’ means use by the end user, and does not include maintenance, servicing or repair work. Design registration cannot be used to protect spare parts, for example, if the part “may be used for the purpose of repair of a complex product so as to restore its original appearance” (Section 7A(5) of the Registered Designs Act). This exclusion applies only when the part is dependent on the appearance of the whole product (*BMW AG v Round and Metal Ltd*, [2012] EWHC 2099 (Pat)).

Procedures

For UK registered designs, multiple designs can be filed in a single application. In a multiple design application, the official fees are reduced for the subsequent design(s) after the first one.

A number of illustrations can be used to represent each design. These can include drawings, photographs and, in some cases, samples. Partial disclaimers can be used to indicate more accurately which part of the design should be protected. Unlike registered Community designs, UK registered designs are not limited to seven figures per design. Additionally, UK registered designs can be filed with informal drawings, which can later be replaced with formal drawings.

Electronic filing is not available when registering a UK registered design. The required forms must be returned to the UK Intellectual Property Office (UKIPO), along with payment of the required fees.

Fees are payable on registration for filing a design and for publication of a design. Publication can be deferred for up to 12 months if a request is made on the application for a UK registered design, subject to payment of an increased publication fee. The proprietor has no registered rights until the design is published.

There is only formal, not substantive,

examination of UK registered design applications. No opposition procedure is available for UK registered designs.

A proprietor can apply to cancel (ie, surrender) its own registered design at the UKIPO. Once actioned by the UKIPO, the proprietor cannot reinstate the registration. The cancellation takes effect from the date of the registrar's decision or the date chosen by the registrar.

Third parties can apply to the UKIPO or a court to invalidate a registration on certain grounds, as set out in Section 11ZA of the Registered Designs Act. These include that the design does not fall within the definition of a 'design', or the design is not new or does not have individual character. If the UKIPO declares that a registration is invalid, the proprietor may make an application for modification of the registered design. Any allowable modification is considered to have taken effect from the grant of the registration. If a design is declared invalid, the registration is treated as invalid from the date of registration, or a date chosen by the registrar. If a design is found to be valid or partially valid, the court may certify the validity of the design which was being contested in invalidity proceedings. An application to invalidate the design can be made as a counterclaim to an infringement action.

Enforcement

The proprietor of a registered design has "the exclusive right to use the design and any design which does not produce on the informed user a different overall impression" (Section 7(1) of the Registered Designs Act). Remedies claimed in the event of infringement can include damages, injunctions and account of profits or delivery up of infringing goods.

Infringement proceedings in England and Wales must be brought before the courts (ie, either the Patents County Court or the Patents Court (a part of the High Court)). The Patents County Court has a cap on the damages available and tends to deal with lower-value, less complex cases than the Patents Court. Both courts aim to issue a judgment within one year; as a matter of practice, the Patents County Court tends to be quicker due to its streamlined procedure. Appeal from both courts is to the Court of Appeal, which takes approximately 18 months. There are separate courts in Northern Ireland and Scotland.

Disputes concerning the subsistence of a design right, the term of a design right or the correct ownership of a design can be brought to the UKIPO (Section 246(1) of the Copyright, Designs and Patents Act).

Ownership changes and right transfers

Licences of rights are available for UK registered designs in the last five years of protection.

The author of a design is the original proprietor of the design. However, if the author was commissioned or created the design in the course of his or her employment, then the commissioner or the employer is the original proprietor of the design respectively. Additionally, if a design qualifies for design right protection by reference to where it was first marketed, then the party which first marketed the articles is the original proprietor.

Registered designs and unregistered design rights can be assigned, licensed or mortgaged in the same manner as other IP rights. Assignments and mortgage charges of registered designs must be in writing, signed by the assignor and registered at the UKIPO. The assignment of a registered design also confers any design right in the design.

Related rights

A design (eg, for the shape of a product) can be protected by the design right, a UK registered design and also by a trademark. Design protection could also include a trademark within a registered design. Design registration and trademark registration are both allowable even if the other type of protection exists or previously existed.

Section 51 of the Copyright, Designs and Patents Act partly defines the boundary of copyright and design protection. As stated, "it is not an infringement of any copyright in a design document or model recording or embodying a design for anything other than an artistic work or a typeface to make an article to the design or to copy an article made to the design". Furthermore, as defined in Section 236 of the Copyright, Designs and Patents Act, "where copyright subsists in a work which consists of or includes a design in which Design Right subsists, it is not an infringement of Design Right in the design to do anything which is an infringement of the copyright in that work". **WTR**

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A London-based partner of J A Kemp, John Leeming has more than 24 years' professional experience. Mr Leeming is the head of J A Kemp's designs group. He prosecutes patent applications in the optical, electronic and software fields, with particular expertise in semiconductor device manufacturing equipment and processes. He is experienced in litigation and enforcement matters, often achieving resolution of disputes without recourse to litigation. He has specialist expertise in recovering lapsed patents and applications. His clients range from multinationals to start-ups.

Clients appreciate Mr Leeming's pragmatic and cost-conscious approach to prosecution, as well as his ability to capture effectively the essence of an invention in drafting applications.



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Based in London, Hermione Thompson is part-qualified as a patent attorney. She handles electrical, electronic and mechanical patent cases. These include work in fields relating to medical devices, renewable energy devices, packaging and manufacturing methods and lithographic apparatus.