

TOTAL RIGHT OF OWNERSHIP



An introduction to Designs

Designs are a form of intellectual property right that protect the appearance of a product. Under United Kingdom and European Community design law, there are two forms of protection: Registered Designs and unregistered design right.

THE OWNER OF A DESIGN IS USUALLY THE CREATOR OF THE DESIGN

- REGISTRABLE IP RIGHT
- PROTECTS SHAPE OR CONFIGURATION (3D)
- PROTECTS PATTERN OR ORNAMENTATION (2D)
- MUST BE NOVEL
- PROTECTION LASTS UP TO 25 YRS

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Registered Designs:

In order to obtain a Registered Design, it is necessary to file a Registered Design application at the United Kingdom Intellectual Property Office (for a UK Community Design) or at the Office of Harmonization in the Internal Market (for a European Community Registered Design)

A Registered Design can protect designs in the form of a shape and/or pattern applied to a product. Registered designs are not restricted to a particular product and consequently, they also cover application of the design to a variety of different products. For example, where the Registered Design protects a floral pattern, the protection provided by the Registered Design extends to different products bearing that floral pattern (e.g. curtains, furniture, ladies dresses etc.). A Registered Design may also be directed to the design of specific parts of products, as long as that part is ordinarily on view when in use. For example, a Registered Design may be directed to the

design of a handle of a teapot or a front cover of a mobile cellular telephone.

In order for a Registered Design to be valid, the design must be new and have 'individual character' in relation to previous designs. Designs which are wholly dictated by function are not registrable. Additionally, there is no protection for features of the shape of an article which are dependent on the appearance of another article of which the first article is intended to form a part.

The owner of a design is usually the creator of the design. Where a design is the result of a commission, the commissioner is the owner of the design. Where a design has been created by an employee in the usual course of employment, the employer is the owner of the design.

If you create a new design, we recommend that you obtain a Registered Design before the design is disclosed to third parties. This course of action is advantageous since if a third

party files a Registered Design application after your disclosure, your Registered Design would pre-date their Design application and would render their Registered Design invalid. However, in the European Union a valid application for registration can be filed up to a year after a design has first been publicly disclosed.

A Registered Design may be infringed by sale or commercial use of a product having a substantially identical design, whether knowingly copied or not. The term of protection is initially 5 years, but is extendible by payment of renewal fees for further 5 year periods, up to a maximum term of 25 years.

By virtue of International Agreements, applications for design registration abroad can in most cases be backdated to the date of an initial U.K. or Community application for registration of the same design. If this route is chosen, design applications abroad must be filed within 6 months of the initial application date.

IF THE DESIGN IS COMMERCIALLY IMPORTANT FOR YOUR BUSINESS WE RECOMMEND THAT YOU OBTAIN A REGISTERED DESIGN

Unregistered Design Right:

This form of design protection arises automatically in appropriate circumstances, without any requirement for registration. It provides protection against copying only. If the design is commercially important for your business, we recommend that you obtain a Registered Design.

Two types of protection are available, UK unregistered design right and European Community unregistered design right.

UK unregistered design right only protects features of shape or configuration of an article, or part of an article. There is, however, no protection for features which enable an article to be connected to another article. There is also no protection for features which are dependent upon the appearance of another product of which

the design is intended to form a part. Surface decoration is also excluded from protection.

U.K. unregistered design right has a duration of 10 years from the end of the year of first sale of the article, subject to an overall maximum of 15 years from the end of the year in which the article was designed (if no articles are sold within 5 years). In the last 5 years of protection any party is entitled to a license to make the design. The terms of such a license are settled by the UK Intellectual Property Office if not agreed between the parties.

European Community unregistered design right covers any two or three dimensional designs for which a valid Community design registration could be applied for. This right only lasts for 3 years from when the design is first made public in the European Economic Area.

REGISTERED DESIGN APPLICATION PROCESS

1 Preparation and filing of a UK Registered Design Application – Approximately £290 - £350, for first design in an application; and £164-£230 for each additional design in an application.

2 Within two months from (1). Receive Examination Report from UK Intellectual Property Office. Respond to objections in the Examination Report. Typically £150 to £400, depending upon complexity of objections. However, such objections are rare, and there is thus often no charge at this stage.

3 2 to 4 months from (1). Registration of the Design application. No charge.

4 The Registration remains in force for an initial period of five years, whereupon it may be renewed at five year intervals. Registered Design may be enforced for up to twenty five years from filing (1).