

UK & EU Unregistered Design Rights

In the context of intellectual property, the “design” of a product is generally its shape, or ornamentation applied to it, although the exact definition varies between different types of protection. Essentially, the design of a product relates to its appearance, rather than to technical principles of its construction or operation. There are a number of ways in which designs can be protected, and this information sheet deals with unregistered design right in both the UK and the EU. The issues of UK semiconductor topography right and UK copyright are also covered. There are three other information sheets on designs: one addresses how to register your design in the United Kingdom, another addresses EU-wide registration and the other addresses International registration..

WHAT IS A UK UNREGISTERED DESIGN RIGHT (UK UDR)?

UK UDR gives its owner the right to prevent unauthorised copying of the design in the UK. In contrast to registered design rights, it is not a monopoly right, in the sense that only if a third party produces an article by copying is design right infringed. The owner may also prevent unauthorised dealing, e.g. by importation, possession, sale, hire, offer to sell or

hire, in infringing articles provided the party who does so has knowledge or reason to believe they are dealing in an infringing article.

The rights extend to designs which are substantially the same as that which is protected.

How do I get UK unregistered design right?

No formal registration procedure is required (or possible) to obtain UK UDR: it comes into existence automatically upon creation of the relevant design.

Duration of protection

UK UDR protection lasts for a maximum of 15 years from the end of the calendar year in which the design was first recorded in a design document or an article was first made to the design, whichever occurred first. If articles made to the design are put on sale within the first five years of that term, then the design right lasts for only 10 years from the date of first sale.

During the last five years of the term of design right its effect is reduced. During that period, the proprietor must, if requested by a third party, grant a licence, the terms of which will be settled by the UK Intellectual Property Office if not agreed by the parties concerned. This means, effectively, that design right cannot be used to stop copying during this period, but it can be used to generate royalties.

What is protected by UK UDR?

Any original design of the whole or part of an article, providing it is not commonplace in the relevant technical field, is protectable by design right.

However there is no UK UDR in:

- a method or principle of construction;

- a feature which is configured for connection to or whose appearance is dependant on the appearance of another article. This excludes some spare parts, but not all, the exact scope of protection being dependant on the individual case. Registered design protection may also be available for such cases; and
- surface decoration.

How does protection arise?

A UK UDR automatically comes into being upon the making of an article to a particular design or by the creation of a “design document” by a “qualified person” (or as a result of employment by or a commission from such a person). A qualified person is a national or resident of the EU or of certain non-EU countries (i.e. those which offer reciprocal rights to UK nationals. The main territories giving reciprocal protection are New Zealand and Hong Kong). A company may count as a “qualified person”.

The “design document” must be a record of the design, but it may take any form, e.g. a drawing, photograph, model, prototype, written description, data stored in a computer or on a disc, or even a knitting pattern.

The owner of the design right is the designer (or his or her employer or commissioner, if applicable).

WHAT IS AN UNREGISTERED COMMUNITY DESIGN (UCD)?

A UCD gives its owner the right to prevent unauthorised copying of the design throughout the European Union. It is not a monopoly right, in the sense that only if a third party produces an article by copying is design right infringed. The owner may also prevent unauthorised dealing, e.g. by putting on the market, importation, exportation or possession, in infringing articles.

The rights extend to copies which do not produce on the informed user a different overall impression.

A UCD cannot be used to control the movement of goods put on the market in the EU by the proprietor of the design, or with their consent.

How do I get an unregistered community design (UCD)?

No formal registration procedure is required (or possible) to obtain a UCD: it comes into existence automatically when the design is first made available to the public within the Community (see below).

Duration of protection

A UCD lasts for three years from the commencement date (see below).

To whom are UCDs available?

They are available to any person, or company, irrespective of nationality.

What is protected by a UCD?

The protected design may be the appearance of the whole or part of a product (including its inside) and may arise from the lines, contours, colours, shape, texture, material or ornamentation of the product. The product may even be a graphic symbol, e.g. a computer icon, or a typographical typeface.

The design must meet two criteria.

It must:

- be novel; and
- possess individual character.

Both these criteria are judged with reference to designs which have been made available to the public before the commencement of the UCD (prior designs). Designs may be made available by publication, use or any other means.

When does the UCD commence?

The right commences when the design is deemed to have been made available to the public within the Community. This happens when the design is published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the Community.

This wording is based on that of the "Safeguard Clause" in Registered Design Law and is thought only to not include disclosures which are obscure, due to their extent, location or time of disclosure.

Our current understanding of the law is that this disclosure must occur inside the geographical boundaries of the Community.

Novelty

For a UCD to be Novel, it must differ from prior designs by more than immaterial details.

Individual character

For a UCD to possess Individual Character, it must produce a different overall impression on the informed user from prior designs. In many cases, the informed user is likely to be the end user of the product.

In fields where the designer has less design freedom, the difference between protectable designs and prior designs will not be as great as where the designer had complete design freedom. This is also reflected in the infringement rights arising from the UCD.

Complex products and spare parts

Complex products are defined as products which are composed of two or more replaceable component parts which permit disassembly and reassembly of the product.

The UCD in component parts of such products only extends to component parts which remain visible during normal use of the complex product.

Further, the repair of a complex product so as to restore it to its original appearance by the use of a component part does not infringe a UCD for the design of that component part. This is aimed at continuing to permit the manufacture and sale of "non-genuine" car parts, for example, even if such parts are protected.

Excluded features and designs

A UCD cannot protect features of a design which are solely dictated by the product's technical function, or features which are required to permit the product to be connected to or placed in, around or against another product so that either product may perform its function. However, a design which serves the purpose of allowing the assembly of modular products may be protected.

Designs may not incorporate protected emblems which include, for example, the Olympic symbols, Royal arms and national

flags. Also, they may not incorporate third parties' trade marks or copyright material.

Ownership

The owner of the UCD is the designer, or his or her employer if the design is developed by the employee in the execution of their duties or following the instructions of their employer.

OTHER RIGHTS

UK semiconductor topography right

Designs which relate to a semiconductor topography (i.e. the layout of a pattern in or on a semiconductor product) are also protected by UK UDR.

All of the above comments in relation to UK design right also apply to semiconductor topography design right, with the exception that as more overseas countries allow protection, qualifying individuals can come from states including Australia, Canada, Japan and the USA.

UK copyright

Copyright is more usually thought of as applying to books, music, films, etc. However in the area of industry and commerce there is some overlap between design right and copyright. Copyright is an unregistered right that applies to some industrial designs falling outside the scope of UK unregistered design right; these will usually be such creations as logos, patterns to be applied to an article and the design of the surface decoration of an article.

As with design right, copyright does not need to be registered and only gives protection against copying of the design.

Under present law, copyright lasts for the life of the author plus 70 years. If the design is an artistic work which has been industrially applied to articles which have been sold, then the copyright only lasts for 25 years from the end of the calendar year in which such articles are first marketed.

See overleaf for a comparison of the key features of UK Unregistered Design Right and Community Unregistered Designs

COMPARISON OF KEY FEATURES OF UK UNREGISTERED DESIGN RIGHT AND COMMUNITY UNREGISTERED DESIGNS

	UK UNREGISTERED DESIGN RIGHT	COMMUNITY UNREGISTERED DESIGNS
To whom is it available?	EU citizens & companies, as well as citizens & companies from New Zealand and Hong Kong.	Any person or company.
What does it protect?	Shape of whole or part of an article but not surface decoration.	Appearance of whole or part of product, which may be shape or decoration.
What is excluded from protection?	Method or principle of construction. Features configured for connection or whose appearance depends on that of another article.	Features solely dictated by function. Features required to allow connection. Repair of complex products.
Criteria for protection	Originality Not commonplace	Novelty Individual Character
When does protection start?	On making of article to design, or on creation of design document.	On making design available to public within the EU.
How long does protection last?	15 years from end of calendar year in which protection starts, or 10 years from date of first sale.	Three years from being made available to the public.
What do infringement rights extend to?	Copying the design. Unauthorised dealing, with knowledge that articles are infringing.	Copying of the design. Unauthorised dealing (no knowledge necessary).

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com. Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at 33 Gutter Lane, London EC2V 8AS

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