

Design Rights in the UK and EU

Designs are perhaps one of the more complex areas of IP due to the different design IP rights that can protect a product or article.

Below we highlight the legal principles of design IP in the UK and the EU.

UK registered designs (UKRDs)

UKRDs can be obtained by anyone who files an application for a design registration at the UK Intellectual Property Office (UKIPO). The application typically includes drawings displaying the design of the product or article from multiple different angles.

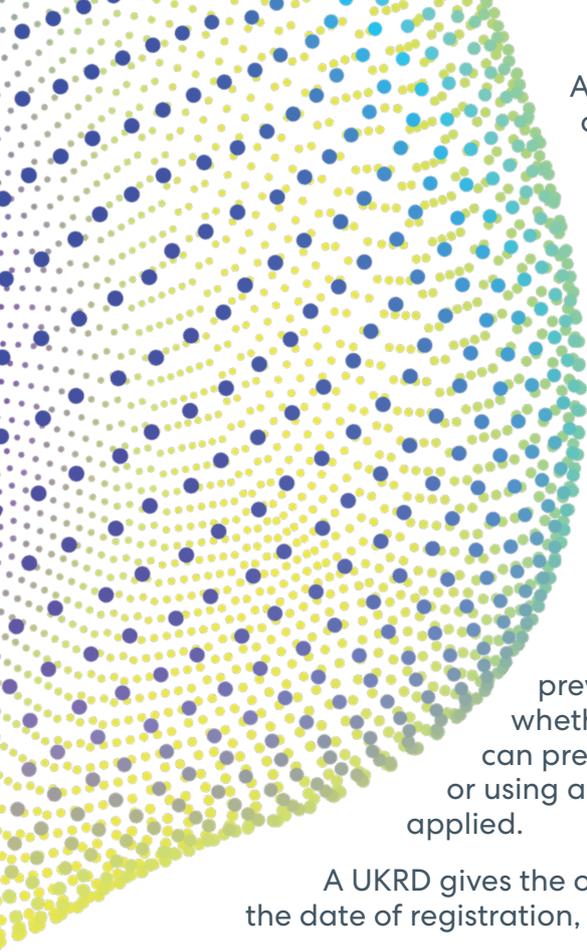
UKRDs protect the appearance of a whole product or part of a product. The “appearance” can include visual features of the design including the lines, edges, contours, colours, shape, texture, materials, ornamentation, and/or surface decoration of the product. A product can include any industrial or handicraft item.

For the appearance of the UKRD to give valid protection, the design must be new and have individual character.

A design is new if no identical or immaterially-different design has been made available to the public before the date of the application for the design.

A design has individual character if the overall impression it produces on a notional ‘informed user’ differs from the overall impression produced on such a user by any design which has been made available to the public before the date of the application for the UKRD.

The ‘informed user’ is a legal tool used to assess whether a design has ‘individual character’. Exactly who the ‘informed user’ may be, and what knowledge they have about a design, varies depending on the product to which a design is applied. Normally, the informed user is considered an end user of the product. The ‘informed user’ could be defined as someone who does not have average attention of the design of a particular product, but is someone who is particularly observant, either because of their personal experience or their extensive knowledge of the sector in question.



An exception in the assessment of novelty and individual character is that disclosures made by the designer of a UKRD are subject to a 12 month grace period prior to the filing of the UKRD. Thus, public disclosure of the design made by the designer up to 12 months from the filing of the design are not considered for the assessment of novelty and individual character of the design. However, many territories do not recognise such a grace period. Thus it is preferable to file a UKRD before publicly disclosing the design.

There are some exceptions to the features that can be protected by a UKRD. They may not protect features of the appearance that are solely dictated by technical function or features of the appearance that must fit with another product so that one or both products may perform their function.

A UKRD gives the owner of the design a monopoly right to prevent others from ‘using’ the design in the UK. Regardless of whether the design has been copied or not, the owner of a UKRD can prevent others from making, offering, selling, importing, exporting or using a product in which the design is incorporated or to which it is applied.

A UKRD gives the owner a monopoly right for a maximum term of 25 years from the date of registration, with renewal fees due every 5 years.

A UKRD application gives rise to a right of priority, so long as it is the first filing of the design. The right of priority lasts six months from the filing date of the UKRD. A UKRD can also claim priority from a design filed in another territory, as long as the UKRD is filed within 6 months of the previous design.

UK Unregistered design right (UDR)

A UDR is an automatic right that, much like copyright, can exist upon the making of an article to a particular design or by the creation of a “design document”. A “design document” may take any form, such as a drawing (including those created in software), photograph etc.

In other words, there is no formal registration process required for an unregistered design right to arise.

However, whether a design qualifies for a UK UDR depends on whether the design was created by a “qualifying person”. A “qualifying person” may be an individual resident in a “qualifying country” or a company formed, or with a substantial place of business, in a “qualifying country”. A “qualifying country” includes the UK and a certain list of countries with which the UK has reciprocal agreements, most notably Hong Kong and New Zealand. Importantly, since 1st January 2021, EU member states are no longer included as a “qualifying country”. However, a corresponding EU unregistered design right also exists (see below).

A UK UDR can also belong to a party if the first marketing of an article made to the design is done so in a “qualifying country”. However, such a “first marketer” would only own the UK UDR if the person or company who created the design was not considered a “qualifying person”, as described above.

If a UK UDR arises, then it protects the shape or configuration (whether internal or external) of the whole article or part of an article.

A UK UDR also only provides valid protection if the design is “original”, which means it is not commonplace in a “qualifying country” in the design field in question. Like its registered counterpart, there are exceptions to the features that a UK UDR can protect, such as:

- features of the shape or configuration of an article which fit with another article for either



article to form its function;

- features of the shape or configuration of an article which are dependent upon the appearance of another article i.e. that 'match' another article; and
- surface decoration.

This differs from UKRDs, which can provide protection for surface decoration.

An important difference between UK UDRs and UKRDs is that in order to infringe a UK UDR, the owner of the UK UDR must show that the design was copied by making an article to the design. An article is considered to infringe a UK UDR if the design of the article was copied and the article is exactly or substantially the same as the UK UDR. A UK UDR is also infringed if a person imports into the UK, has possession of, sells, hires or offers to sell or hire, an infringing article that they know or have reason to believe is an article infringing a UK UDR.

A UK UDR lasts for a maximum of 15 years from the end of the calendar year in which the design was first created, or if an article bearing the design is put on the market, then 10 years from the end of the calendar year that the article was put on the market.

Corresponding EU design IP rights

Corresponding registered and unregistered design rights can also exist across the EU. These are termed 'community' design rights, which can exist in registered and unregistered form.

Registered community designs (RCD) are a very similar right to UKRDs. Much of the discussion above with regard to UKRDs is also applicable to RCDs. The main differences are that RCDs provide protection across every EU member state and not the UK, and that RCDs are registered with the European Union Intellectual Property Office (EUIPO), rather than the UKIPO.

Unregistered community designs (UCD) are similar in some respects to UK UDRs, such as a UCD can only be infringed if it is copied. Protection provided by a UCD is similar to that of a UKRD in that it protects 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, provided that the design is novel and has individual character.

However, there are some key differences to note.

A UCD has a much shorter term than a UK UDR. A UCD last for only 3 years from the date that the design is deemed to have been made available to the public within the EU. 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 those specialised in the sector concerned and operating within the EU.

A UCD may also become available to any person or company, regardless of their respective nationality or residence, which differs from the complex way in which a UK UDR may arise.

Summary

There are thus several ways in which a design may be protected in the UK and EU.

Below is a summary table of some of the key features of the above-discussed design IP rights:

Design IP right	Max. Duration	How is it obtained?	Who may obtain it?	Who can it be enforced against?
UKRD	25 years	Application to UK-IPO	Anyone	Anyone who “uses” the design
CRD	25 years	Application to EUIPO	Anyone	Anyone who “uses” the design
UK UDR	15 years (10 years if marketed)	Upon creation of the design	If made by a “qualifying person”	Anyone who “uses” the design by copying
UCD	3 years	Upon creation of the design	Anyone	Anyone who “uses” the design by copying

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