

IP Intros: Design Protection

Designs are perhaps not the most well-known form of intellectual property (IP) protection. However, for many IP-savvy businesses, registered designs can form a crucial part of an IP portfolio.

But what exactly is a registered design?

Overview

A design registration (also known as a registered design) protects the way a product or item looks, and can last for up to 25 years.

A design registration gives the owner of the registration the right to prevent others from ‘using’ a product or item bearing the design. ‘Using’ the design includes selling, importing, making or exporting a product bearing the design.

Why is this useful for my business?

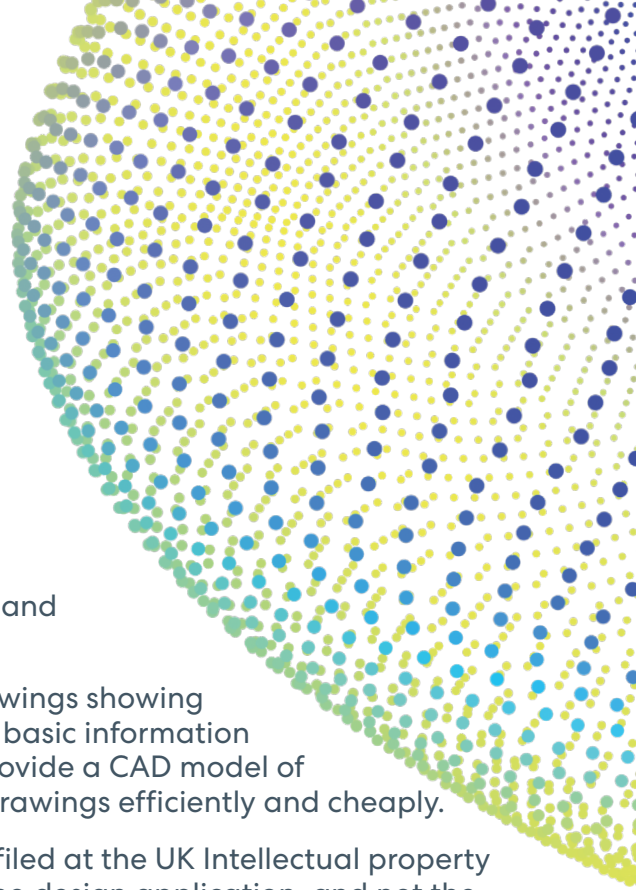
A registered design acts as a ‘keep off the grass’ sign to your competitors. If a product is protected by a registered design, it may deter third parties from seeking to copy the design because a valid registration may give the owner the right to prevent others from using the design and also seek damages for any such use.

A design registration is also useful because it makes the design IP into a tangible business asset. For example, a license for the design registration may be granted to a third party seller of a product bearing the design in exchange for licensing fees or royalties.

Are all designs protectable?

No. There are certain criteria that a design must meet to result in a valid design registration. The design must be new and have ‘individual character’ i.e. it must be distinctive compared to all other designs that were publicly available before the filing date of the design registration.

In some countries, including the UK and Europe, any disclosure made by the designer(s) themselves in the 12 months before the filing of the design is subject to a grace period, and will



not be considered in the assessment of the validity of the design. This means that a business can publicly disclose a product bearing the design e.g. begin advertising or selling, to see if the design is generating good business before they incur the costs of registering it. A registration for the design can then be made within 12 months from the date of the first public disclosure e.g. the earlier date of the advertising or selling, without such disclosure affecting the validity of the design.

However, not all countries provide such a grace period, and therefore, in general, it is preferable to register a design before it is publicly disclosed.

How do I obtain a design registration?

HLK can assist you with all the necessary steps in preparing and filing an application for a design registration.

In summary, the application generally includes multiple drawings showing different views of a product or item to the design and some basic information regarding the product which bears the design. If you can provide a CAD model of the design, then this can help us to prepare the necessary drawings efficiently and cheaply.

To obtain a design registration in the UK, the application is filed at the UK Intellectual property Office (UKIPO). The UKIPO only examine the formalities of the design application, and not the 'new' and 'individual character' requirements, meaning that a design application is generally registered within a few months from the date of filing the design application.

Publication of the design registration may be delayed by paying some modest additional fees. Such a delay can be useful if you wish to get design registrations in place before a new product launch without making the design public in advance.

If you are interested in protecting a design outside of the UK, HLK can also assist in obtaining a design registration in all other major territories, including European community registered designs which cover the entire EU with one registration.

How much does a design registration cost?

The initial cost for filing a design application (including official fees payable to the UKIPO) is typically in the region of £500-£1000. If significant work is needed to prepare the drawings, then costs can be more. Compared to other forms of IP, such as patents, design registrations are relatively inexpensive, as fees associated with preparing and prosecuting a patent application to grant can quickly run into the tens of thousands.

Once registered, a UK design registration can last up to a maximum of 25 years. To remain in force, the registration must be renewed by paying a renewal fee every 5 years. The further cost to renew a registration up to the maximum term of 25 years is typically in the hundreds.

This is for general information only and does not constitute legal advice. Should you require advice on this or any other topic then please contact hlk@hlk-ip.com or your usual Haseltine Lake Kempner advisor.