

Protection of Designs

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1. Introduction

Design registration is a powerful, cost effective tool for protecting visual aspects of novel products. Effective use of design registrations requires a clear understanding of the nature of the rights they provide and how these rights are defined.

The procedure is relatively straightforward and cost effective, but the application documents have a significant impact on the scope and strength of the rights secured.

Designs are distinct forms of protection, different from patents and trade marks, the other major components of that collection of intangible rights in aspects of modern business, collectively referred to as intellectual property. However, designs can overlap with either or both patents and trade marks, and aspects of a registrable design may also be susceptible of patent protection (if there is a new invention involved), and/or of trade mark protection (if employed in branding).

2. Territories

Design protection is available throughout the world as both separate national or regional rights. The term and scope of protection varies from country to country.

There is an international filing system established under The Hague Agreement (The Hague System), which allows for protection in multiple countries or regions by filing a central application. Both [the UK](#) and the EU are a contracting party to the Hague Agreement.

UK and EU design registrations are available for the appearance of **the whole or a part of a product** resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.

As outlined in section 7, the 'design' that is protected by a registration is defined by the representations filed in support of the application. It is therefore crucial to ensure that the representations are prepared to reflect appropriately the novel feature(s) of the product sought to be protected without any additional, unnecessary features.

UK design registrations are only enforceable in the UK, whilst EU design registrations provide EU-wide protection.

3. Validity

Designs are only protectable if they are new and have individual character. A design is new if no identical design ("earlier design") has been made available to the public before the filing or priority date of the application for registration (but see section 9 below for disclosures connected with the design). A design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any earlier design.

If the design is applied to or incorporated into a component part of a complex product, only features of the design that are visible during normal use are considered when assessing the novelty and individual character requirements.

Design protection is not available for any features which are solely dictated by their technical function or which are necessary for the mechanical connection or the placement of a product incorporating the design in, around or against another product in order for either product to function. Design protection is also excluded for any designs which are contrary to public policy or accepted principles of morality.

4. Ownership

The design belongs to the designer or his successor in title, unless the design was developed by an employee in the course of employment. If two or more persons jointly develop a design, then the design vests in them jointly and the employment provisions apply to each of the designers individually.

For commissioned designs, the party commissioning the design should secure an assignment of the design rights from the designer to take ownership of the design.

5. Procedure

The registration process for UK and EU designs is short, simple and cost effective. This is mainly due to the lack of examination of the requirements for novelty and individual character at the point of filing. In general, UK and EU designs register within one or two months from filing, although registration of EU designs within one or two days is possible where no priority is claimed. An Applicant can choose to defer publication for up to 30 months, otherwise designs publish shortly after registration. A design registration can be exercised against infringers once the design registration is published.

UK and EU designs each have a maximum term of 25 years, subject to renewal fees every 5 years.

6. Locarno classification

Design applications must indicate the products in which the design is incorporated or applied using the Locarno Classification. The Locarno Classification is an international classification for industrial designs where products are classified in 32 classes according to their nature and/or purpose.

Each product must be classified in only one class of the Locarno Classification. However, neither the product indication nor the classification affects the scope of protection of a design as such. The classification information serves the purely administrative purpose of allowing third parties to search the UK and EU design registers.

7. Representations

As mentioned above, the 'design' that is protected by a registration is defined by the representations that are employed to secure the registration. Therefore, the appearance of the representations is of paramount importance to the scope of the design registration. If there is an infringement, the allegedly infringing product is compared against the representations, not against a product that the design owner sells themselves. Consequently, the representations should be as broad as possible. What that means is that they should have as few limiting features visible in the representations as possible.

On the other hand, representations that include all of the features of an infringing design are better for concluding that the infringing design is, in fact, an infringement. Also, for assessment of the novelty of a design, the representations employed are compared against known designs and must show features which in combination are materially different. These conflicting requirements must be balanced, and it would be feasible to file several design registrations relating to the same design using different representations having varying breadth of scope and distinctiveness.

The representation of the design must consist of a graphic reproduction of the design, either in black and white or in colour.

Representations can be in the form of (a) line drawings, (b) computer-aided design ('CAD') images or (c) photographs. Often, no single form will fully represent all aspects of a design.

All features included in representations (unless disclaimed) are considered when assessing the scope and validity of a design. It is important that the representations disclose clearly all aspects of the design for which protection is sought.

Line drawings usually provide the broadest protection with regard to the shape of a product. However, they cannot protect colour and it is often difficult to accurately represent surface decoration and/or contouring.

CAD images can represent colour features, surface decoration and/or surface contouring. CAD images also allow for use of greyscale to represent tonal contrast without limiting protection to specific colour combinations. However, CAD images may not closely represent the design in use.

Photographs are perhaps the most limiting form of representation because they will usually be interpreted as intended to protect the design as a whole in all its elements. However, photos can be a helpful medium to represent differences in colour, texture and/or materials.

Depending on the aspects of the design intended to be protected, using a combination of design representations in different media (as separate designs) may be advisable.

For more information on design representations, please contact your HGF attorney who can provide you with specific advice or additional material which provides more detail with some examples.

8. Identifiers and disclaimers

It is possible to disclaim protection for features of a design or highlight portions of a design. However, this cannot be achieved by way of a verbal statement or description; all disclaimers and/or identifiers must be apparent and fully contained in the representation of the design.

Examples of acceptable visual disclaimers/identifiers include:

- **Broken lines:** consist of a trace made up of dots or dashes (or a combination of both) and are used to indicate that no protection is sought for features shown using an interrupted trace;
- **Blurring:** consists in obscuring the features for which protection is not sought. Blurred features must be clearly distinguishable from protected features of the design;
- **Colour shading:** consists in using contrasting tones to sufficiently obscure the features for which protection is not sought. Disclaimed features must be represented in a different tone to protected features as to appear blurred or imperceptible;

- **Boundaries:** consist of a clear boundary containing the features for which protection is sought whereas all features outside the boundary are not protected.

9. Disclosure

Any designs made available to the public will be deemed to have been disclosed. Disclosure of earlier designs may impact on the assessment of novelty and individual character of undisclosed later designs. Disclosure may also impact the capacity of the design holder to validly register the design.

The nature, geographical scope and effect of prior disclosures varies between different countries. For UK and EU designs, any prior disclosure of the design, anywhere in the world will be relevant unless the disclosure could not reasonably have become known to the relevant business circles in the European Economic Area (EEA).

10. Grace Period

In the UK and EU, a designer is given a period of 12 months during which the designer can disclose the design without destroying the novelty and/or individual character of the design. The 'grace period' is intended to allow designers to test the commercial viability of their designs before seeking registration.

The grace period provides protection from potential invalidity caused by self-disclosure; it does not protect from potential invalidity caused by disclosure by third parties during the grace period. The grace period does not bring the filing/priority date forward by 12 months and the effect of any self-disclosure varies in foreign countries.

11. Priority

Designers may claim the filing date ('priority') of the first filing for a specific design for any subsequent filings for the same design in Paris convention countries, provided the applications are filed within 6 months from the filing date of the original filing.

A valid priority claim requires that the Applicant, design and Locarno Class are the same; however, interpretation of these requirements varies between countries. In the UK and EU, the designs must be identical, without any addition or suppression of features, for two designs to be considered the 'same'.

12. Multiple Designs

In the UK and EU, multiple designs can be included in the same application resulting in significant cost savings. The designs must share the same owner and Locarno Class. Each design in an application is a separate right. There is currently no limit to the number of designs that can be included in an application.

13. Protecting Part of a Product

Design rights can protect part of a product. However, the term 'part of a product' does not extend to spare parts as component parts of complex products. This option allows designers to only seek protection of novel elements of their designs. Availability and requirements for protection for part of a product vary between countries.