

Abel+Imray

Guide to Registered Designs



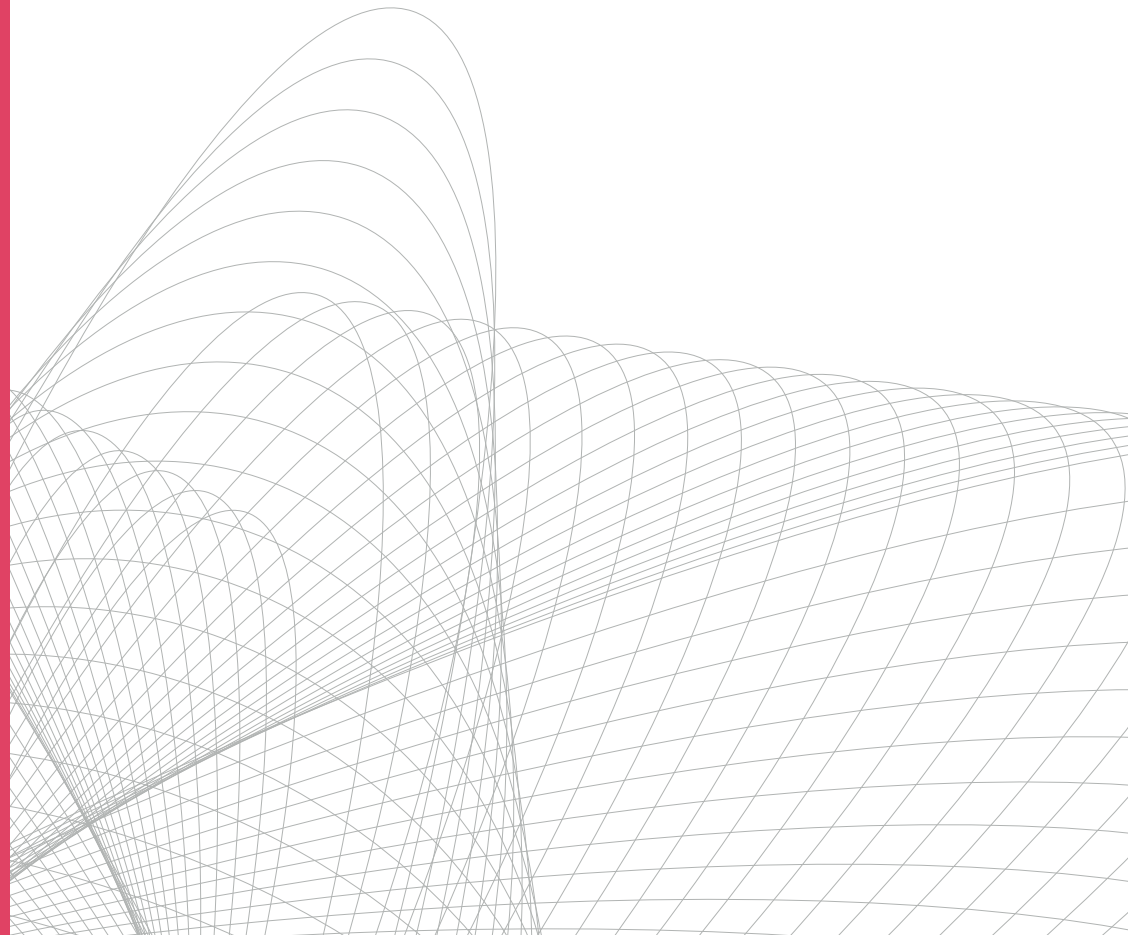
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Section 1

General Guide to Registered Designs



What is a registered design?

A registered design is a registered intellectual property (“IP”) right which protects what something looks like. A registered design allows the holder to stop third parties from using, selling, making etc., something which looks the same as the registered design in the country or countries in which they hold that registered design.

Protection can be obtained for the appearance of a product, which may result from the product’s shape, colours, contours, texture and surface decoration. It is possible to obtain registered design protection for part of a product, graphic symbols, product get-up, packaging and typefaces.

If you want to protect the way something works, then a patent would be more suitable. If you want to protect branding or a company name, then registered trade mark protection would be more appropriate. Our other Guides (which can be found on our website) can provide further details on these other types of protection.

Why should I register my design? Can’t I rely on unregistered design right?

There are many benefits of registering your design. The most important benefit is that registering a design gives legal rights that allow you to stop others from using that design, even if the other person has not copied the design and arrived at the design independently. In order to enforce an unregistered design, you have to prove to a court that someone has copied your design. Unregistered design right also has a shorter term than a registered design.

A registered design gives you a tangible, published, registered right that is readily visible to third parties. This, in itself, can act as a deterrent to would-be infringers.

How do I register my design?

Registered design protection is territorial. In order to obtain a registered design, you make an application to the official body responsible for granting intellectual property rights in the particular territory of interest. For example, registered design protection in the UK may be secured through registration at the UK Intellectual Property Office (“UK IPO”). Registered design protection covering the European Union may be secured through registration at the European Union Intellectual Property Office (“EU IPO”).

In many territories, such as the EU and the UK, the design application only undergoes an examination to see if certain formalities are met and is not subject to substantive examination to see whether the design is sufficiently different from existing designs to be registerable and enforceable. As a result, filing a design application tends to be a straightforward way of obtaining a registered IP right.

What makes a registered design valid?

In order for a UK or EU design registration to be valid, the design must be new and must have individual character. “New” means that the design is not the same as any publicly-known design. For a design to have “individual character” it must give a different overall impression to “an informed user” when compared to any existing publicly-known design.

There are exceptions which may lead to a known design not being considered when assessing whether or not a design is new and has individual character. For example, if you disclose your design to the public (e.g. by putting a product onto the market), then in some territories (such as the EU) you can still get a valid registered design if you file your design application within a year of your first public disclosure of the design.

The design freedom of the designer is also taken into consideration. For example, if there is little design freedom, then small differences between existing designs and your design can still give you a valid, enforceable design registration.

In the EU and the UK, when deciding whether a design registration is valid, certain features are considered as not attracting any design protection, such as features of appearance which are solely dictated by technical function and features which need to be reproduced to allow a product to be connected to or placed in or against another product so that either product can work.

Different criteria apply in other countries. For example, some countries require that the design is ornamental. If you would like to discuss validity of designs please ask your usual Abel & Imray contact.

When should I register my design?

A registered design protects appearance so you should not file a registered design application if the appearance of your product is going to change. It therefore usually makes sense to defer filing a registered design application until the appearance of your product has been finalised. Unlike patents, it is not necessary to file a registered design application before you put your design into the public domain, but it is often sensible to do so. If you put your design onto the market, then you have a year after the first public disclosure of the design in which to file a registered design application in some countries in order for your disclosure not to count against your design application, but in other countries this disclosure could be fatal to the validity of a design.

If you are thinking of filing a patent application for your product, then we would strongly recommend filing the patent application before you file your design application. This is because design applications are often published very quickly after filing (unless deferment of publication is requested). Such publications could prevent you from obtaining valid patent protection for your product, if the design application is published before your patent application is filed.

It is possible to defer publication of the design for up to 30 months in the EU and by up to 12 months in the UK if you want to keep the design secret or if you think that your design is probably in its final form, but you are not quite sure. If the design changes so that it is not protected by the design application, then you can allow the unpublished application to lapse.

I have got lots of different tweaks or variants to my design. How can I protect those?

The UK and EU design system allows you to register lots of designs in one application, provided that all of the designs relate to the same type or classification of product. This will allow you to protect different design variants in one filing. Furthermore, the cost per design is far lower than if you filed one application for each design individually.

Should I search for other registered designs before filing a registered design application?

There is no obligation to conduct searches prior to filing a registered design application. In some countries (such as the US), the government authorities will conduct a search for potentially relevant earlier design applications and registrations. In the EU and the UK, the government authorities do not conduct such a search.

If you are interested in having any design searches conducted, we suggest that you discuss this with your attorney so that you can weigh up the pros and cons of doing so.

What do I need to provide you with in order to file a registered design application?

In order to file a registered design application we will need the following:

- + the name and address of the applicant (the person or company that will own the registered design)
- + the figures or images you would like to file as part of the registered design application, preferably in .jpeg format. We can assist you with obtaining suitable images if required
- + details of the designer(s) (the person or people who came-up with the design) so that we can ensure that the applicant owns the right to file the registered design
- + details of any earlier rights for the same design from which priority may be claimed.

How much will it cost?

Registered designs are considerably less expensive than patents. However, it is difficult to predict with certainty exactly how much any one design application may cost. For example, as mentioned above, in the UK and the EU, it is possible to register lots of designs in one filing or application, provided that all of the designs relate to the same type or classification of product. The registration of multiple designs in one filing will increase costs relative to filing a single application for one design, but is far cheaper than filing a single application for each design.

Also, if the images or figures you provide are not optimised for filing as part of a registered design application, then we may recommend that we ask a specialist draughtsman to prepare images for the design application, and this will incur both professional charges from us for our advice as to the nature of the images to be used and disbursements for the charges of the draughtsman.

More information regarding our costs can be found on our website.

How long will it take?

Assuming that there are no official objections, European and UK Registered Design applications may be allowed in as little as a few days. Timescales in other countries can vary considerably.

How long does a registered design last?

In Europe and the UK, a registered design lasts for twenty five years from the filing date, so long as renewal fees are paid every five years.

What happens if someone copies my registered design after I have filed a registered design application?

Registered design infringement proceedings based on a UK or EU registered design can only be brought once the design is registered, but all rights in the registration date back to the date of filing the application. This is usually not an issue for UK or EU registered designs because they are usually registered very shortly after filing.

If you do have a registered design, you can launch legal action through the courts, seeking an injunction to stop another party's activity, and damages or accounts of profits to compensate you for their infringement. Legal actions are costly and complex, and this is usually a last resort.

A first step is often your attorney making your competitor aware of your rights. This may result in the infringing activity stopping without the need for legal action. We do not recommend approaching an alleged infringer yourself without speaking to us first because in the UK there are "groundless threats" provisions which may lead to you having to pay damages if it is proved that infringement is not taking place. Your attorney can advise further in the event of any potential infringement dispute.

If your application is still pending, you cannot launch court action, but you can take steps to put the alleged infringer on notice so that if and when your design is registered you can show that the alleged infringer was aware of your rights. Again, we recommend that any contact you have with the alleged infringer is via your attorney.

Once I have filed my registered design application, am I free to use it?

A design registration is a "negative" right in that it allows you to prevent others from doing things. A design registration does not give you the right to do anything yourself. Your use of your design may infringe someone else's registered design rights regardless of the rights you hold.

How can I be sure that I am not infringing any other registered designs?

Whether or not you are infringing other design registrations can be a difficult question to answer. Whilst you may be able to reduce the risk of infringing other registered designs by having considered and directed design searches conducted, there are of course limitations inherent in those searches.

Structure of a registered design application

UK and EU registered design applications are relatively simple, but there are two parts which are important to get right; the identity of the applicant and the representations. The representations are the images used to define the protection you are seeking in the registered design.

Applicant

The applicant is the person or entity which will own the right. A design registration and an application for registration are both personal property. Accordingly, the applicant for registration must be an individual (a natural person) or some sort of legal person, capable of owning property in their own name.

Representations

The representations are the images you use to define the protection given by your registered design. The images should show the features for which you are seeking registered design protection and should not include features that are non-essential. You should generally avoid the use of shading or colour unless it is part of the design you want to register. In the UK and EU, the use of line drawings is usually recommended, but your attorney will be able to advise you further.

Section 2

Registered Design Application Procedure



How can I get protection all over the world?

It is not possible to obtain a worldwide registration, but there are ways of registering a design in more than one country in a cost-effective manner. An EU design registration gives protection in all countries in the EU. The Hague Agreement allows you to file one application which at least initially covers lots of different countries, enabling considerable cost savings. This single application can lead to a separate registration in each country included in the initial single application.

What is priority?

After you have filed your first application for a given design, you then have a period of six months in which to file further applications for the same design in other countries, and each of those applications is effectively treated as having been filed on the same date as the first application. This is called the priority period. In this way you can defer the cost of filing in several countries for a few months if necessary.

Can anything go wrong after registration?

Yes. The validity of your design registration can be challenged at any time, including after registration. A third party can apply to invalidate your design registration by showing that the design should not have been registered in the first place, for example, on the grounds that the design was the same as, or was too similar to, an existing design when the design application was filed.

What are renewal fees and when do I have to pay them?

In most countries, renewal fees must be paid for a design registration to remain in force. In the UK and Europe, a design registration lasts for 25 years from the date of application, subject to the payment of renewal fees every 5 years.

Who is Clarivate (formerly CPA Global)?

Abel + Imray do not offer a renewals payment service for routine renewals. Since it is vital that you have reliable renewal arrangements in place to avoid inadvertent loss of rights through failure to pay renewal fees, we will supply details of your cases to Clarivate (a specialist designs renewals reminder and payment service, formerly CPA Global) unless we know you have made provision with another specialist renewals provider. Once Clarivate has your details, they will send you reminders regarding any renewals due, together with details of their renewals payment service.

Who else keeps sending me invoices and renewal fee reminders?

There are a number of companies that send out unsolicited mail to applicants following publication of their registered design, typically requesting payment in order to maintain the design registration or include it on a register. If you receive unsolicited requests for payment, it may be a scam.

If you have any doubts regarding the credibility of correspondence you receive, please contact your attorney. Your attorney will then advise on whether or not the payment reminder/request is genuine and if any action is required.

“The service they provide is tailored to exactly what we want, it’s not a stock service; they offer a very flexible service, so everything can be done how we want it done, even things like billing structures. It makes my life and job easier.”

– Chris Docker, Regional IP & Standards Manager, ASSA ABLOY

Section 3

Your Relationship with Abel & Imray

For full details of how our relationship with you is defined, please see our full Terms of Business document.

Why should I use a patent or trade mark attorney?

You do not have to use a patent or trade mark attorney. However, the protection and use of designs is a complex area of law. Therefore there are distinct advantages to using a professional. For example, a design registration based on poorly-prepared and/or chosen representations or images can be effectively worthless. If a design registration is important to the success of your business, we highly recommend that you engage a Chartered Patent Attorney or a Chartered Trade Mark Attorney.

How are my bills worked out?

Our invoices are made up of three main elements.

Fixed charge work – this relates to the more administrative aspects of our work, for example, the completion of a new application form together with entering the new application details onto our records and docketing system.

Professional time – professional time spent by our attorneys is charged at an hourly rate. An example of professional time is the time spent reviewing images provided as part of a design application or in identifying and resolving ownership issues. It also includes time spent in meetings and on telephone calls and emails. We may be able to answer some of your queries quickly and without sending you a bill. However, if we are required to spend professional time in order to provide you with an answer, this time will be invoiced.

Disbursements – this includes official fees payable to patent offices, payment of the charges of draughtsmen for the preparation of images and also payment of the charges of foreign attorneys where you have filed design applications overseas.

