

DESIGNS AND COPYRIGHT

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As a firm of Chartered and European Patent Attorneys and Trade Mark Attorneys, we act in all professional matters relating to patents, designs and trade marks. This note provides a brief explanation of the topics of designs and copyright. Separate notes are available regarding patents and trade marks.

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SUMMARY

- A UK or Community registered design provides a right by which the proprietor of the design can prevent third parties making, using, selling, etc. the design or a similar design, regardless of whether or not the design was copied. Fees are payable in order to register the design. The design must be different from known designs in order to be registrable.
- UK unregistered design right is a UK right by which the design right owner can prevent third parties copying the internal or external shape of a product. Design right arises automatically on creation of the design but only nationals or residents of European Union and a few other countries qualify for design right protection.
- Community unregistered design right is a right effective across the whole of the European Union by which the holder of the right can prevent third parties copying the design. The Community unregistered design right arises automatically on creation of the design.
- Copyright is a right by which the copyright owner can prevent third parties from copying the whole or a substantial part of a literary, dramatic, musical or artistic work, a film, a sound recording, a typographical work, a broadcast or a cable programme. Computer programs are regarded as literary works for this purpose. Copyright arises automatically on creation of the work. In the UK, in general copyright does not protect the shape, i.e. the three dimensional aspects, of industrial designs.

- In summary, the unregistered protection afforded to commercially produced goods, be it by way of copyright or unregistered design right, is typically narrow, uncertain, of short duration and only of use where actual copying can be proved. On the other hand, the protection afforded by a registered design is of longer duration, usually more definite, more easily enforced and is applicable against any infringement whether by copying or by independent design.

REGISTERED DESIGNS

Protection in United Kingdom

The design of a product can be registered with the Designs Registry and indeed more than one design can be included in a single design registration. “Design” is defined very broadly and means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation. “Product” is also defined very broadly and means any industrial or handicraft item and includes, in particular, packaging, get-up, graphic symbols, and typographic typefaces. However, features of appearance of a product cannot be protected if they are dictated solely by the product’s technical function.

In order to be validly registered the design must be new. A design is regarded as being new if no identical design, or no design whose features differ only in immaterial

details, has been made available, in a reasonably accessible manner, to persons in business in the European Economic Area in the sector concerned. In addition, a design must have individual character if it is to be validly registered. 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 design which has been made available to persons in business in the European Economic Area in the sector concerned. In general terms, therefore, to be validly registered a design must have a distinctive appearance compared with other designs which were known previously.

In some circumstances, a prior disclosure may be excluded when determining whether a design is new and has individual character. One particular exclusion is disclosures made by the designer (or as a result of information obtained from the designer) in the 12 months before the filing or priority date of the application to register the design. Thus, in general there is a 12 months grace period during which a designer can test the market before deciding whether or not to file an application to register the design for the UK. As discussed further below, whilst some other countries (for example the US) also provide for a grace period of 6 months or 12 months, there are other countries which do not provide any such grace period and therefore if protection for such countries is required it will be necessary to file an application to register the design before there is any disclosure of the design. Where a design is for a component part of a so-called complex product, the design of

that component part will only be validly registered if that component part remains visible during normal use of the complex product. Normal use in this sense does not include maintenance, servicing or repair work in relation to the product.

The registration of a design gives the registered proprietor the right to prevent third parties using the design, or any design which does not produce on the informed user a different overall impression, commercially in the UK. There is, at present at least, a “repair” exclusion whereby a registered design for a component part which may be used for repairing a complex product so as to restore its original appearance is not infringed by use of that component part for repair of the complex product.

A design registration is granted for an initial period of five years from the application date. It can be renewed for four subsequent periods of five years each (giving a maximum term of 25 years from the application date), subject to the payment of appropriate renewal fees.

It is important to realise that the protection given by a registered design is limited solely to the appearance of the article as judged by the eye. In contrast to the protection given by a patent, no protection is given by a registered design to the function of the article. Thus, a similar article designed by a competitor to perform the same function but having a quite different appearance to the design that has been registered would not infringe the registered design.

The protection provided by a United Kingdom registered design extends automatically to a number of countries, typically former colonies or dependent territories.

Filing an Application for Registration

An application for registration of one or more designs can be prepared and filed by the individual proprietor of the design(s), but usually such applications are prepared and filed by a Chartered Patent Attorney or Trade Mark Attorney or other professional representative who acts on behalf of the proprietor. If you wish us to act on your behalf, the first step is to supply us with drawings or photographs showing the design(s) to be protected, so that we can prepare the necessary representations to be submitted to the Designs Registry.

After the application is filed, the Designs Registry makes a formal check of the application papers. Objections to the application are rarely raised by the Designs Registry. The design(s) is/are typically registered within a few weeks of the necessary formalities having been completed, though the applicant may decide for commercial reasons to delay registration given that the design is published by the Designs Registry as soon as the design is registered. The costs of preparing and filing an application for registration of a design vary from case to case depending on how much work is involved. On the rare occasion that objections to the application are raised by the Designs Registry, these are likely to be serious and thus prosecution

costs could be significant if objections are raised.

Overseas Protection

The normal practice for a United Kingdom resident is to file an application for design registration first in the United Kingdom and then to follow this with corresponding applications in individual countries abroad within a period of 6 months. The reason for this is that for most countries, it is possible to claim the priority date of the United Kingdom design application for any subsequent applications which are made to register the same design in most overseas countries. However, the overseas applications must be filed within a strict time limit of six months. If the time limit is exceeded, the overseas applications will merely be entitled to their own filing date, and in many countries such applications will be invalid if there has already been publication of the design(s) before the date of filing of the foreign application. In some countries abroad, as in the UK, several designs can be covered in a single application. As mentioned above, whilst like the UK some countries provide a grace period such that disclosures by the designer (or as a result of information obtained from the designer) within a certain period prior to an application being filed are ignored, other countries do not have such a grace period. Accordingly, it is important to consider the countries in which it may be desired to register the design prior to the design being made public and to seek advice if necessary.

Community Registered Design

A European Community registered design system enables a single registered design to be obtained that is effective across the whole of the European Union. The requirements for registration and exclusions from protection are essentially the same as for UK registered designs discussed above.

It is possible to register more than one design in a single Community design application provided that certain conditions are met. It is also possible to request that publication of the design be delayed. This enables design applications to be filed for designs which the owner wishes to keep secret for a period of time.

UK UNREGISTERED DESIGN RIGHT

Design right, also known as “unregistered design right”, is a UK national right that is similar to copyright in the sense that it protects a design against copying. UK design right protects the design of any aspect of the shape or configuration of the whole or part of an article. UK design right does not protect for example surface decoration. The design must be original to qualify for UK design right. UK design right protection extends to solely functional designs.

As with copyright, UK design right comes into existence automatically upon the recording of a design and without any act of registration, whether the design is made in the form of a drawing, written description, model or prototype or with the aid of a computer. The UK design right only comes into existence if the designer, the designer's employer, a person who commissioned the design or the first marketer of the design is "qualified". In general, nationals or residents of the United Kingdom and other EU countries are qualified. Citizens and residents of other countries will be given this status if their country gives similar protection to United Kingdom citizens and residents. However, presently only nationals or residents of a number of Commonwealth countries, including Hong Kong and New Zealand, are given such protection under United Kingdom law.

Similar steps to those discussed below in the section on copyright should be taken to help the owner prove ownership of the UK design right. Thus, the original design first made should be kept safely with a record of the date of its creation and the date of its first marketing. Original drawings or the like can be countersigned by an independent party who should indicate on the drawings that the drawings have been seen on the given date and represented as being the original work of the author. It is also possible to submit a copy of the drawings, or other work, to the UK Copyright Service as mentioned below.

Where the design was created as a prototype or model, it is this that is the

original work which should be retained. Where it is difficult or inconvenient to store the original, it may be sufficient to take photographs which can be signed and dated by the author, countersigned by an independent party, and then safely retained.

Infringement of design right requires that the design of the infringing product be the same or substantially the same as the protected design. Design right is only infringed by actual copying of the design. If an alleged infringer can prove that its own design was arrived at by way of an independent route, without copying, there will be no infringement. This is in distinction to the protection afforded by a registered design or a patent, where infringement takes place if the infringement falls within the scope of the statutory protection provided, irrespective of whether the infringer actually copied anything.

The maximum period of protection provided by design right is the end of the year 10 years from the first marketing of articles made to the design, subject to a maximum of 15 years from the end of the year of creation of the design.

During the last 5 years for which the design right exists, licences are available to third parties as of right. This means that anyone who wants to produce the article can do so subject only to the payment of royalties to the owner of the design right. If the parties cannot agree between them the terms of the licence, either party can apply to the Comptroller of the Patent Office to settle suitable terms.

COPYRIGHT

In the United Kingdom, copyright is the protection that arises automatically when someone produces an original literary, dramatic, musical or artistic work. Familiar examples are copyright in books, plays, music and paintings. Computer programs are regarded as literary works for this purpose. No act of registration is required to obtain copyright protection in the United Kingdom.

The period of protection enjoyed by copyright varies according to the type of work concerned, but in most cases is either the life of the author plus 70 years, or 50 or 70 years from a date associated with the first publication of the work. A significant exception to this long period of protection is where an artistic work has been exploited commercially by making and selling more than 50 copies of the artistic work which have been made by an industrial process, in which case the period of protection will typically expire 25 years from first marketing of such copies. Moreover, in general the design of any aspect of the shape or configuration of the whole or part of an article is not protected by copyright in the United Kingdom unless the article itself is an artistic work, such as a sculpture or the like (though such designs may be protected by design right: see above).

As mentioned above, copyright arises automatically. For example, once the rules for a new game, a knitting pattern or the program for a computer have been completed, copyright subsists automatically and no specific act of registration is

Where an article is to be connected to another article, those of its features that enable that connection to be made are excluded from protection by design right. Likewise, if an article is part of another article, features that are dependent upon the appearance of that other article are similarly not protected by design right. These so-called “must fit” and “must match” exclusions mean that competitors are generally free to copy those parts of a design which enable an article to interengage or interface with other articles.

EUROPEAN COMMUNITY UNREGISTERED DESIGN RIGHT

A Community unregistered design right applies across the whole of the E.U. to protect a design against copying. The community unregistered design right arises automatically on creation of the design and applies to the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation. The requirements for and exclusions from protection are essentially the same as for UK registered designs discussed above, although the right is not a monopoly right and protects against copying only. The Community unregistered design right expires 3 years from first disclosure of the design in the E.U., provided that disclosure could reasonably be known to persons carrying on normal course of business in the E.U. and specialising in the sector concerned.

required to obtain copyright protection. However, certain steps may be taken to help the owner to prove his title to copyright. For example, the original of the work should be safely retained, its author or creator should be identified, and the date on which it was made should be recorded. In most cases, the simplest way to do this is to have the author sign and date the original and then file it safely away. Works generated with the aid of computers or word processors can be stored either on tape or disk or on hard copy. A record should also be kept of the date on which the work is published, or otherwise made available to the public. Conveniently, the original work can be countersigned by an independent party to verify the date of its existence. That independent party should indicate on the work that it has been seen by him on the given date and represented to him as being the original work of the author. Another means of attempting to establish ownership is to submit a copy of the drawings or other work to the UK Copyright Service, whose website is at www.copyrightservice.co.uk, who for a fee will issue a receipt verifying that they are keeping a copy of the documents in which copyright is claimed.

Copyright is only infringed by actual copying of the whole or a substantial part of the original work. Thus, in addition to showing that the whole or a substantial part of the original work has been reproduced, it is also necessary to show that the alleged infringer had access to the original work,

whether directly or indirectly. Where the original work is a computer program or a database, it may be helpful to include a distinctive, inoperative routine or dummy records which if reproduced by a third party will indicate that the third party has in fact copied the original work. It is important to remember that if the alleged infringer can prove that he/she arrived at the work by means of an independent route, without copying, there will be no infringement of copyright. This is in contrast to the protection afforded by a registered design or a patent, where infringement takes place if the infringement falls within the scope of the statutory protection provided, irrespective of whether the infringer actually copied anything.

Where copies of a work in which copyright subsists are to be made available to the public, for example by sale, hire or in any other way, it is advisable that the copies should carry an appropriate copyright notice. For example, this notice could comprise the familiar © device followed by the name of the owner of the copyright and the year in which the work was first made available to the public.

Please contact us if you require any advice or assistance in connection with registered designs, copyright or design right matters.

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