

A quick guide to... design protection in the UK and EU

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We consider the two main forms of registered and unregistered design protection available in the UK and EU.

Since the law governing the UK forms of protection is currently substantially the same as that covering the EU forms, the below applies to both.

What types of design protection are available in the UK?

There are two main types of design protection available in the UK: a registered design (known as a UK Registered Design or UKRD) and an unregistered design (known as a Supplementary Unregistered Design or SUD). SUDs are a new form of unregistered design that the UK agreed to protect on Brexit. They are called supplementary unregistered designs to distinguish them from the other form of unregistered design (called Design Right) that already existed in – and is unique to – the UK. Design right is only covered briefly (and where specified) in this guide.

What types of pan-EU design protection are available?

Likewise, there are two forms of pan-EU design protection available: a pan-EU registered design (currently called a Registered Community Design or RCD) and a pan-EU unregistered design (currently called an Unregistered Community Design or UCD).

What law applies?

Since the law governing the UK forms of protection is currently substantially the same as that covering the EU forms, this guide applies to both.

What is protected?

The law of designs protects the appearance of the whole or 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. The definition of a design is broad enough to cover packaging, surface decoration and logos, as well as the designs of 2D and 3D products. Protection is given for the design itself. This means that the design is protected for all products not just the product in which it is incorporated. To be valid, a design must be new, have individual character and not otherwise be excluded from protection.

When is a design new?

A design is new if no identical design (or no design whose features differ only in immaterial details) has been made available to the public before the priority/filing date of the design (for registered designs) and before the design was first made available to the public (for unregistered designs).

What is meant by individual character?

A design has individual character if it produces a different overall impression on the informed user compared to any design that has been made available to the public before the priority/filing date of the design (for registered designs) and before the design was first made available to the public (for unregistered designs).

What types of design are excluded?

There are four main exclusions:

(i) designs solely dictated by the technical function of the product; (ii) designs of component parts of complex products which are not visible during normal use of the product; (iii) designs of interconnecting products ('must fit', 'must match' designs) and (iv) designs that are contrary to public policy or morality.

What constitutes design infringement?

The owner of a registered design has the exclusive right to use the design (and any other design which does not produce a different overall impression on the informed user) and to prevent any third party not having his consent from using it. Use includes the making, offering, putting on the

market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for these purposes. Since the design itself is protected, there can be infringement even if the protected design is incorporated into a different product. The owner of an unregistered design has a similar right except that copying the protected design is required for infringement.

Are there any exceptions to infringement?

Permitted acts include acts done privately and for non-commercial purposes, acts done for experimental purposes, certain acts by government, and certain acts of reproduction for the purpose of making citations or of teaching. There is also a limited right of prior use for registered designs.

How long does design protection last?

Registered designs can be registered for a maximum of 25 years, with registrations renewed every five years. Unregistered designs arise when the design is first made available to the public (meaning that it comes to the attention of the relevant circles in the trade). They last for three years from that date and so are much shorter in duration than registered designs.

Is there a time limit for registering a design?

There is a one-year grace period to register a design after it has been made available to the public. This potentially allows the design to be tested in the market before the cost of registration is incurred. If the design is not applied for within this one-year time limit, it will not be considered new even if it was disclosed by the designer. The designer would have to rely on unregistered design rights only. Disclosure of a design therefore has two consequences, triggering the one-year grace period for registration and the three-year period of unregistered design protection.

What are the pros and cons of registration?

Registered designs have a longer duration of protection than unregistered designs and copying is not required for infringement. Conversely, unregistered designs are cheaper and there is no requirement to specify what the design covers in an application (which can be an advantage if there is an infringement).

Is registration expensive and time consuming?

Design registration is relatively low-cost, and several different designs can be protected by one application. The designs do not need to be linked. Each design is separately examined. Registration is relatively quick and easy to obtain, there being little examination (eg there is no automatic search or examination for novelty). Where there are no objections, a design will typically be registered within a month of filing the application.

How did Brexit impact pan-EU designs?

As a result of Brexit, RCDs and UCDs no longer cover the UK, but the UK made provision for any RCDs and UCDs already in existence at the end of the Brexit transition period to remain protected in the UK for the life of the right. UK rights stemming from RCDs are called re-registered designs and from UCDs are called continuing unregistered designs. The law summarised in this guide also applies to these rights, including the distinctions as to the registered and unregistered forms of protection.

Can a person benefit from both UK and pan-EU registered protection for the same design?

There is nothing to stop applications for registration being filed in both the UK and at EU level – and filing in both jurisdictions is recommended if protection is required in both. Applications should normally be filed within less than one year of each other to avoid one application destroying the novelty of the other.

Can a person benefit from both UK and pan-EU unregistered protection for the same design?

This isn't clear. There is conflicting information about whether unregistered protection in the UK (in the form of the SUD) arises if the first disclosure of the design occurs outside of the UK and whether protection in the EU (in the form of the UCD) arises if the first disclosure of the design occurs outside of the EU. If first disclosure of the design is required in the UK for SUD to arise and in the EU for UCD to arise, then clearly the same design cannot be protected (in unregistered form) in both the UK and EU.

What should designers do as a result?

Whilst the uncertainty continues, those who rely on unregistered designs at both UK and EU level should consider: (a) whether simultaneous disclosure (eg online) in both jurisdictions can be achieved (although it is not yet known whether this will be sufficient for protection to arise), (b) whether they might be able to benefit from the other form of UK unregistered design (design right) and (c) relying more heavily on registered designs.

What is UK Design Right?

This is a species of unregistered design unique to the UK. It protects the design of the shape or configuration (whether internal or external) of the whole or part of an article. However (unlike all other forms of design covered in this guide), it does not protect surface ornamentation and certain other aspects of a design. Design Right protects designs created by a 'qualifying person' or first put on the market in a 'qualifying country'. It can sometimes protect designs in the UK where SUDs would not arise.

What about plans to update the law governing pan-EU designs?

There are proposals to modernise EU legislation on designs at EU-wide level (covering RCDs and UCDs) and national member state level (covering the national species of design). The proposals would particularly make the system more accessible and fit for purpose in the digital age. Key changes include the expansion of the definition of a design (to include the movement, transition or any other sort of animation of the features of the appearance of a product) and the definition of a product (to include such things as digital products and the spatial arrangement of interior environments). If adopted, the proposals will see UK and EU law on designs diverge. For more, see [our article here](#).



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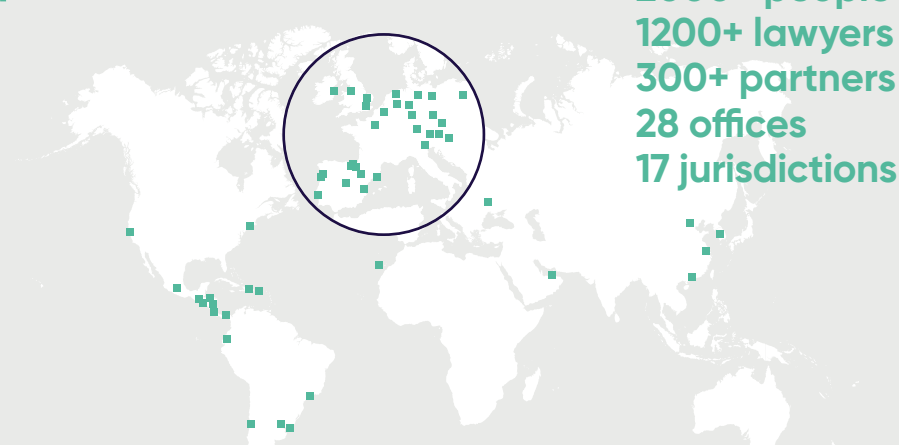
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