

For example, it will most likely protect an LED beam reflector forming part of a more complex product, but it will probably not protect the lip, on its own, at the outer end of the reflector. The IPO suggests that very small and trivial parts would not be protected by this law change, but the author's opinion in the light of previous case law is that this will prove not to be the case, with size alone being irrelevant.

In summary, unregistered design right is useful for stopping third parties from exactly, or almost exactly, copying the original design of separate parts and/or whole articles whether or not they are visible in normal use. But, you must be able to show that they have been copied and that you own the right.

Registered Designs

Turning now to registered designs, it is possible to register a design in just the UK or the EU as a whole. The law is essentially the same for both and can be summed up as follows.

The design:

- . . . must be new (i.e. it must not have become known to other European designers in the relevant field more than 12 months before the application is filed).
- . . . must have individual character (i.e. it must be materially different from any other published/publicly disclosed design).
- . . . must be visible in normal use (normal use does not include maintenance).
- . . . cannot be a product which is dictated solely by its technical function (but again, if the designer has had a choice in how to make it look then it would not be excluded).
- . . . will not have protection which extends to the aspects of the product's appearance which 'must-fit' or 'must-match' with the appearance of another product.

A registered design provides protection for both the shape and configuration of the product and the surface decoration of the product, which includes patterns and ornamentation. This may apply to, for example, 3D items such as an uplighter, or 2D features such as the design of a GUI or other purely decorative items. A 2D design does not have to be limited to any particular product.

It is strongly recommended that you use a patent attorney to handle the application process, as they know how to get you the broadest protection possible. The consequences of how the design was presented in the application have come back to haunt the owners of the Trunki ride-on kid's suitcases recently, when they lost an infringement action at the Court of Appeal.

Registered designs last for an initial period of five years from the application date. Protection is renewable for four further periods of five years, each on payment of a government extension fee. Thus, the maximum protection available is 25 years from filing the application.

A registered design may be used to stop third parties from dealing in products which produce the same overall influence on the informed user. In the UK courts this is typically construed quite narrowly, meaning that the product must be quite close to the one registered for infringement to be found. Recent case law suggests that the more ground-breaking and/or innovative a design is, the broader the protection is likely to be. That means that if you develop a new design of a product for an already saturated market, the protection you get may be viewed quite narrowly - meaning that the product must be quite close to the one registered for infringement to be found. However, like unregistered designs, they are certainly useful against exact, and almost-exact, copies.

In the UK, EU and USA it is possible to register a design within a 12-month grace period after the design has been first disclosed and even sold. However - beware - this grace period is not available in all countries of the world and, therefore, if you are thinking of applying to register your design in other countries such prior disclosure may very well cause you problems. Therefore, it is probably always best to apply in the UK or EU before going public.

What to do if you find an infringing product

If you come across a product which you think is infringing, you should be careful about what you say as you can be held liable for their losses if you wrongly accuse them of infringement such that they lose money or goodwill. Rather, it is suggested that you obtain a sample and seek legal advice. Most patent attorneys handle design matters and will be able to give you an opinion on the likelihood of infringement being found. This risk applies to both registered and unregistered designs.

Most IP infringements don't end up in court, contrary to popular belief. Instead, the two sides negotiate a deal, or more often than not, the infringer stops infringing! However, another change in October 2014 - which you have probably heard about from the media - is that infringement of registered designs will become a criminal, rather than a civil, offence. The copying must be shown to be intentional and in reality it is unlikely that anyone will go to prison for it - but they may end-up with a criminal record.

In summary, registered designs are very useful because they are relatively cheap and last a long time. They can be used to stop copies and can act as a deterrent. You can use the official numbers on the products and in your marketing material, and they are an asset to your company.

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