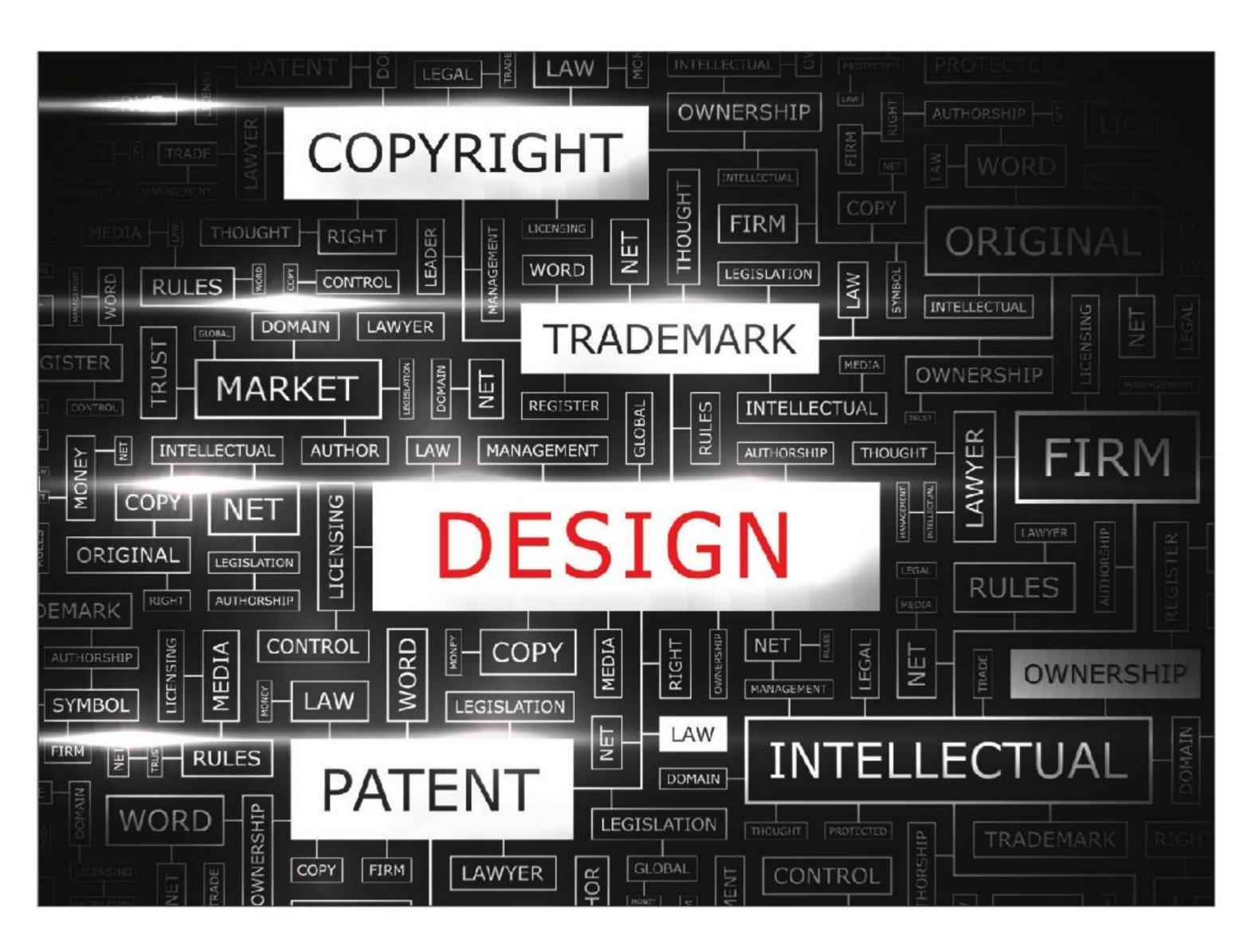
Design Protection



Engineer-turned-patent attorney Lewis Hands on how to protect your intellectual property . . .

In the fast moving area of the lighting and sound industry new products are constantly being developed. Intellectual property is the area of law which protects the investment you have made. After all, why should someone else get the benefit of your blood, sweat and tears?

There are four main forms of intellectual property protection available in the UK - these are patents, which protect the way things work, or methods of use/manufacture; trademarks, which protect brands, names and logos; copyright, which protects artistic works; and designs, which protects the way articles or products look. This article will consider the last form - designs . . .

But before starting, it's worth saying that if you have a new product and its newness, or novelty, lies in how it works, then you should consider patent protection as this protects the way it works, its 'look' being irrelevant. Unfortunately, we all know that not all products are capable of being patented as they are not 'inventive' enough or their originality depends on their appearance. In these cases designs are useful.

In the UK we have UK unregistered design right, EU unregistered design right, and registered design protection available.

Unregistered Design Right

UK unregistered design right is, as its name suggests, an unregistered right, which applies to original, non-commonplace designs in regards to the shape or configuration of 3D articles (but not 2D designs or surface decoration). UK unregistered design right gives you the right to stop competitors from copying your design for up to five years after you first market articles made to the design, and to

require a royalty payment for copies made in a subsequent five years. It is an automatic protection arising on creation of the design and can co-exist with registered design protection. In other words, you get this right automatically: you do not have to register it.

The protection is for the design of the shape or configuration of the whole or part of an article. In the UK there is no 'visible in use' requirement as there is for registered designs and for EU unregistered designs: in other words, it protects the inside parts not usually seen by the user. Design features enabling an article to be functionally fitted (the 'must fit' exception), or aesthetically matched to another article (the 'must match' exception) get no protection. An example of the must fit exception is the standard socket for connecting a bayonet bulb. However, if the designer has had any design freedom, such that he or she can choose how to make it look, then the exception most probably does not apply.

In the EU a slightly different form of unregistered design right also exists. This design right is effective in all members of the EU; accordingly, it is also effective in the UK. It requires that the design is new and displays individual character. The term of protection for an EU unregistered design is, however, a far poorer three years from when the design was first made available to the public within the European Community. But again, it is automatic and requires no registration.

Both UK and EU unregistered design right protect against direct copying. The UK law says that to infringe the article must be exactly or substantially the same. The former is a binary test (yes or no) but the latter is rather subjective. A body of case law from previous years exists to

provide guidance but every case is different. The EU law says that to infringe the design must not produce a different overall impression on the informed user. Copying, and not accidental arrival at the same design, must also be shown for both UK and EU laws. This latter point is anecdotally addressed by original designers by including spurious features (e.g. an additional screw, hole or bracket) so that if the product is directly copied the designer can point to these features and say, "look, they've even copied my unnecessary internal moulding!"

To claim unregistered design right, whether it be UK or EU, you need to be able to prove when and what you created. Therefore, you should keep records such as a diary, dated electronic files, dated drawings, dated photographs and the like. Designs in the UK presently belong to the commissioner or the employer, unlike in the EU where they belong to the designer or employer. This is going to change in October 2014 when the UK will fall into line with the EU. Therefore, if you use an external designer you must ensure that he or she assigns the design right to you, otherwise you may find that when you challenge an infringer you cannot prove you own it. Assignment terms can be included in the contract for the commission.

Another change occurring in October 2014 is that UK unregistered design right will now not cover 'parts of parts'. It is not yet clear how this will be interpreted by the courts, but it is suggested that it means that if only part of a unitary article was copied it would not be an infringement (e.g. one end of a one-piece bracket). However, this does not mean that the whole product must be copied for infringement to occur - it will still provide protection for components making up a larger article.

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.

Lewis Hands is an engineer-turned-patent attorney. He is senior partner in Handsome I.P. a firm of patent and trademark attorneys with offices in Bath, Gloucester, Exeter and London. He has worked with various PLASA members for more than five years to protect and exploit their IP.

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