

Design Right: Some Facts

The intellectual property rights that relate to designs are collectively known as design rights and exist to protect industrial designs from being copied. They relate to how an article looks and not how it functions. There are two forms of design right:

- **Registered Designs** which are granted if you make a successful application to register your design; and
- **Unregistered Designs** which arise automatically once a design has been created

There are laws which apply solely to the UK and also to the European Union as a whole (community design rights). This fact sheet will primarily cover some of the basic points pertaining to UK design right laws.

UK Registered Design Right

Registered design rights (more commonly referred to as Registered Designs) have existed in the UK since 1911 and allows the registration of a design so that the owner of the design has a monopoly over the commercial use of that design. Registered designs refer to the appearance of the whole or a part of a product, and in particular the lines, contours, colours, shape, texture and ornamentation of the product. Registered designs cover both 2-dimensional and 3-dimensional designs. Design registration lasts for a maximum of 25 years (registration must be renewed every 5 years) and like any other intellectual property right can be bought, sold or licensed. To qualify for registration, designs must be novel (novelty in design right means that the design must be completely new upon the date of filing with no details of this design, any identical design or design whose features differ only in minor details having been made available to the public prior to this date, although there is a 12 month grace period meaning that disclosures by the designer in the 12 months preceding the filing date do not count), have individual character (meaning that the overall impression it produces on an informed user of the design must differ from the overall impression produced on such a user by any other design which has already been made available to the public). However, the design of internal components of complex products which are not visible in normal use (e.g. a piston in a car engine) or designs solely concerned with how a product works cannot be registered. Features solely dictated by technical function and "must fit" requirements are also excluded. The ownership of the right rests with the employer if the design was produced by an employee as part of their employment, or, if the design was commissioned, with the commissioner (this is different to copyright; see copyright fact sheet for more details). Registered designs are made publicly available so cannot be kept as a "trade secret".

UK Unregistered Design Right

Unregistered design was introduced in the UK in 1988 in response to flaws in the existing design right laws which allowed for the dual protection of designs under registered design and copyright laws. This had led to a dispute over spare parts for cars in the early 1970's between British Leyland and Armstrong which was resolved by the House of Lords coming up with a "spare parts exception" to copyright law. This exception prevented the manufacturer of an article such as a car from using its copyright to prevent the owner from having free access to the market for spare parts. Unregistered designs are protected from copying for 10 years after a product has been put on sale, subject to an overall limit of 15 years from the creation of the design, although in the last 5 years of protection any person is entitled to "a licence of right" to make, sell or import the design in the UK. Unregistered design right protects any aspect of the shape or configuration of the whole or part of an article whether aesthetic or functional in nature, and unlike registered design does not apply to 2-dimensional designs. Surface decoration and principles or methods of construction as well as features of a shape or configuration referred to as "must fit" and "must match" requirements are also excluded from this right. Ownership of unregistered designs is with the original designer except where they are employed to create the design or commissioned to create it. In cases of infringement, it has to be proved that the original design was copied; however, this can often be difficult to prove.

European Design Right Law

Registered and unregistered community design rights came into effect in December 2001 and March 2002 respectively and allow for protection of designs throughout the European Union. Whereas UK registered design and registered community design laws are broadly the same, there are differences between UK and European law for unregistered designs. The net result is that protection of the appearance of a product can be a complex issue and you should contact Medipex if you require further advice on this subject.



Design Right: Some FAQs

I have designed a device for use in an operating theatre, but have subsequently discovered that it looks identical to a product which is already for sale on the market for a different purpose. Would my device infringe any of the design rights attached to the already available product?

If the design of the existing product is registered in the UK or EU, then it is likely that using your product commercially will infringe that registered design. However, if the design of the available product is not registered and if you can show that you did not copy the design of the existing product, then you will not have infringed any unregistered design rights.

I recently got a local company to design a market-ready version of a prototype lifting device that I have been developing. They now claim that they own the rights to the design and are looking to sell the product commercially themselves. Are they within their rights to do this?

If you commissioned the company to design your market-ready product then it is you as the commissioner who owns the rights to the design, unless you have signed something to the contrary. In cases such as this, you should contact Medipex or your IP lead, preferably prior to commissioning the design.

A couple of years ago, I was developing a device in conjunction with a colleague who has subsequently left the trust in which we both worked. I continued to develop the device independently and last year it was put onto the market and has been moderately successful. Last month, a competing product was launched by my former colleague which had an identical design to my product, aside from some surface decoration. What rights (if any) have been infringed?

In all cases such as this, it is worth remembering that the ownership of any IP developed in the course of employment rests with the employer and that therefore your former colleague would not have had any rights in developing the product further without permission from the trust. In this case it would seem that the design of your product is protected under the unregistered design laws, so you would have to show that your design was either directly copied by your former colleague or that your designs were used as the basis for this design. Both your IP lead and Medipex should be informed of the situation.

I have written a software programme that produces an on-screen icon. Can I protect the software or the icon under design right laws?

If it is new and has individual character, the design of the icon can be protected by a UK or EU Registered Design. It will also be protected by EU Unregistered Design right. Software is not protected by design rights, but is protected by copyright (see the copyright information fact sheet for more information).

Useful Links:

The UK Intellectual Property Office: <http://www.ipo.gov.uk>

Business Link: <http://www.businesslink.gov.uk/bdotg/action/layer?topicId=1073940183>

UK Intellectual Property Online: <http://www.intellectual-property.gov.uk>

Further Information or Advice:

Please contact Medipex on the contact details given below

This fact sheet has been produced in conjunction with Urquhart-Dykes and Lord, Patent Attorneys (Tel: 0113 245 2388; e-mail: email@udl.co.uk). It is provided for the purposes of information only and is not intended as a comprehensive guide to setting up and working in collaborations. In any cases where you have concerns or require advice regarding intellectual property matters, you should get in touch with your IP lead or Medipex.

