

### UK Registered Designs

In the context of intellectual property, the “design” of a product is generally its shape or ornamentation applied to it, although the exact definition varies between different types of protection. Essentially, the design of a product relates to its appearance, rather than to technical principles of its construction or operation.

There are a number of ways in which designs can be protected, and this information sheet deals with how to register your design in the United Kingdom. There are three other information sheets on designs: one addresses EU-wide registration, one addresses International registration and the other addresses automatic design protection that arises without registration.

#### WHAT IS A UK REGISTERED DESIGN?

A UK registered design gives a “monopoly” right, i.e. a right to stop anybody else using the registered design irrespective of whether they copied it.

A UK registered design gives its proprietor the exclusive right in the United Kingdom to make, use, sell, import and export any product embodying the design, if it is a shape, or bearing the design if it is ornamentation. These rights extend to similar designs which do not produce a substantially different impression on the informed user.

The proprietor can take action against any third party who carries out any of the rights exclusive to the proprietor within the United Kingdom without the proprietor’s permission, even if they are using a design that they created independently and without copying.

A UK registered design cannot be used to control the movement of goods put on the market in the European Economic Area (EEA) by the proprietor of the design, or with their consent.

#### How do I get a UK registered design?

To obtain a United Kingdom registered design, it is necessary to file a formal application at the Designs Registry (a part of the UK Intellectual Property Office).

#### Duration of registration

If granted, the registration can last 25 years, but to do so it must be renewed (through payment of a fee) at five-yearly intervals.

#### What can be protected by registration?

A design may be the appearance of a whole or part of a product (including its inside) and may arise from the lines, contours, colours, shape, texture, material or ornamentation of the product. The product may even be a graphic symbol, e.g. a computer icon, or a typographical typeface.

The design which is the subject of an application for registration must meet two criteria.

It must:

- be novel; and
- possess individual character.

Both these criteria are judged with reference to designs which have been made available to the public before the effective filing date of the application. Designs may be made available by publication, use or any other means.

#### Grace period

One important exception to the above is that the prior disclosures of a design made by its designer, or in consequence of a disclosure made by the designer, within 12 months before the effective filing date of the application do not count for the determination of Novelty or Individual Character.

However, such disclosures may prevent registering the design in foreign countries, especially outside the European Union, as many countries in the world do not allow such a grace period, or allow a shorter period.

This provision *does not* exclude disclosures made independently of the designer during this period, and therefore applications should be filed before the design is disclosed if possible.

## Safeguard clause

Another exception to the above requirements is that prior disclosures which could not have become known before the effective filing date in the EEA in the business sector concerned are disregarded. This provision is thought only to exclude obscure disclosures, whether by virtue of the extent, location or time of disclosure.

## Novelty

For a design to be novel it must differ from prior designs by more than immaterial details.

## Individual character

For a design to possess individual character, it must produce a different overall impression on the informed user from prior designs. In many cases, the informed user is likely to be the end user of the product.

In fields where the designer has less design freedom, the difference between registrable designs and prior designs will not be as great as where the designer had complete design freedom. This is also reflected in the infringement rights arising from the registration.

## Complex products and spare parts

Complex products are defined as products which are composed of two or more replaceable component parts which permit disassembly and reassembly of the product. The designs of component parts of such products can only be registered if the component parts remain visible during normal use of the complex product.

Further, the repair of a complex product so as to restore it to its original appearance by the use of a component part does not infringe a design registered for the design of that component part. This is aimed at continuing to permit the manufacture and sale of "non-genuine" car parts, for example, even if such parts are registered.

## Excluded features and designs

A design registration cannot protect features of a design which are solely dictated by the product's technical function, or features which are required to permit the product to be connected to or placed in, around or against another product so that either product may perform its function.

However, a design which serves the purpose of allowing the assembly of modular products may be registered.

It is not allowable to register designs which incorporate protected emblems which include, for example, the Olympic symbols, Royal arms and national flags. Nor is allowable to incorporate third parties' trade marks or copyright material into a design to be registered.

## The application process

We can deal with all aspects of filing an application and obtaining a registration of a design on your behalf.

## Filing an application

To enable us to prepare the documents for filing an application, we need drawings or photographs showing all features of the design. Alternatively, if a specimen or model is available, we can prepare drawings or photographs from it. It is possible to file a specimen in certain circumstances.

We also need to know:

- the full name, address and nationality of the applicant (which may be an individual or company); and
- a description or general name of the article to which the design is to be applied (if this is not obvious);
- full details of any application from which you wish to claim priority.

We can also include a brief explanation of the design in the application, but this is not compulsory.

There is no requirement, or any provision, for providing details of the designer(s).

On filing it is necessary to pay the application fee.

If priority is claimed, then it is necessary to submit a certified copy of the priority application within three months of filing.

## Deferment of registration and publication

UK Registered Designs are usually registered and published once they are in order for registration, but the registration and publication can be deferred for up to 12 months from the filing of the application.

This is achieved by not consenting to the publication of the design in filing, and then filing a subsequent consent at some point before 12 months from the filing date.

There is an additional fee for consenting to publication if not done with the application, although the initial application fee is reduced.

## Multiple applications

It is possible to file applications covering more than one design, with no restriction on the designs which are grouped together. The advantage of filing such multiple applications is a reduced cost compared to single applications.

Each of the designs in the multiple application is a separate piece of property and therefore can be licensed and assigned separately.

At renewal, not all the designs have to be renewed. It is possible to claim different priorities for each design and to defer the registration and publication of only some of the designs.

### Invalidity

Applications for invalidity may be filed once the design is registered. They may be filed on the basis of a lack of novelty, individual character, or that the proprietor is not entitled to the design. Additionally, the holder of an earlier trade mark or copyright may file a request for invalidity based on their earlier rights.

### Overseas registration

The filing of a United Kingdom design application generates a "priority date" which can be claimed to support corresponding design applications filed abroad within six months of the UK filing date.

It is also possible for a UK registered design application to claim priority from an overseas filing.

### Specimens

It is possible to file a UK registered design application using a specimen of a two-dimensional design rather than using a conventional representation.

If the design is a repeating pattern, the whole pattern which repeats must be shown on the specimen. This also applies to designs where a representation is filed with the application.

This approach would be typically used in cases where the design is that of a fabric or wallpaper.

The specimen cannot exceed 29.7cm x 21cm x 1cm.

It is only possible to file a specimen if a representation of the design is subsequently filed with a request for publication.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at [www.mewburn.com](http://www.mewburn.com). Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at 33 Gutter Lane, London EC2V 8AS

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