



GUIDE TO DESIGN PROTECTION

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REGISTERED DESIGNS PROTECT THE APPEARANCE OF THE WHOLE OR PART OF A PRODUCT

Registered designs are used to protect the overall visual appearance of a product or a part of a product for up to 25 years.

A registered design can be fundamental to ensuring that aesthetic, but non-technical features of your products are protected from unauthorised use by third parties. It can offer a number of benefits over neighbouring rights such as copyright and (unregistered) design right. Whilst design right may help to stop people using your design if you can prove it was intentionally copied, it is difficult to enforce, lasts a maximum of 15 years and does not cover 2D designs. Copyright **may** help with offering protection for your 2D designs, but again you must prove it was intentionally copied to stop people using your design.

A registered design is obtained through an **application procedure**. Your design should be new and the overall impression of the design should be considerably different from the overall impression of other existing designs if your registration is to be valid. Ideally, a design is confidential at the time a registered design application is filed, but it is possible **in some countries** to file an application up to 12 months following the first date the design was disclosed.

A registered design will not cover any feature of the design where the appearance is dictated solely by its function. Therefore, if the entire appearance has to be a certain way to enable it to function, then it is unlikely that the design will be a valid registration. Any features of a design that are required to enable the article to be connected to another article (must fit) or that are dependent upon the appearance of another article (must match) are not protected by a registered design.

Geographical Coverage

To obtain a registered design in a particular country an application must be filed in that country. Most countries provide an application procedure with the appropriate organisation which is then examined for registerability under the relevant law. If there are no objections the design will be registered and a registration certificate will be issued. A number of application procedures cover multiple countries, for example, the Community (European) design procedure and the International (Hague) design procedure: both can simplify matters and reduce costs in some cases.

THE DESIGN PROCEDURE

A. Preparation

The initial stage in the process is the preparation of an application including optional multiple representations of the design from various angles (if 3D).

A design application has specific legal requirements if it is to be acceptable. It is common for applications to be filed with inaccurate or insufficient representations of the design and it is generally not possible to change the design once submitted. It is sometimes possible to broaden the scope of protection by registering only part of a design. For these reasons, it is important to take advice at the beginning to avoid unnecessary fees and disappointment.

B. Filing a Design Application (0 weeks)

The additional documents that form a design application are prepared and filed at a Design Office. The application is given a filing date and a filing number.

We typically recommend that the design application is first filed in the UK for cost and flexibility reasons.

In some countries, including the UK, it is possible to file a design application up to 12 months after it has been disclosed publically (a grace period). However, if you wish to obtain protection for the design **outside the EC and USA** a first application (whether in the UK or otherwise) should be filed before the design has been made public and foreign design applications should be either filed at the same time or in accordance with the procedure in Step F.

In a number of countries, the initial filing date starts the clock for the 6 month deadline in Step F.

C. Receipt of Formalities Report(s) (2 to 3 weeks)

We may receive reports from each country where applications have been filed that raise formalities issues. These reports are not common, but may raise issues with clarity or claimed content of the representations that were submitted.

If any reports are received, we are given a deadline by which to respond with changes or clarifications. Please note that any changes made at this stage cannot involve the addition of features that are not in the application on file.

D. Deferred Publication

It is possible to request deferred publication of the design application at the outset. If this is done, once any formalities matters (Step C) have been dealt with, the application simply remains pending and unpublished for up to 12 months, unless publication is requested in the meantime.

If deferred publication is not requested on filing, this step will be omitted.

E. Registration (2 to 4 weeks)

Registration will usually be achieved within 2 to 4 weeks of the date of filing.

It is important to note that due to little consideration being given to the merits of a design during the application process, many designs are registered that may not in fact be valid. In order to achieve a valid and therefore, enforceable registered design, it should be new and the overall impression of the design should be considerably different from the overall impression of other existing designs.

F. Foreign Protection (6 months)

Within 6 months of filing the initial application it is possible to file foreign design applications for the same design whilst benefiting from being treated as having been filed on the same day as the initial application (referred to as claiming priority). However, please note that the 12 month grace period (see Step B) should be used with caution if foreign protection is required.

If you require protection abroad, we can advise you of the

best filing strategy, arrange for the applications to be filed in the geographical locations of your choice and manage the portfolio and further deadlines for you.

We will remind you of this important date well in advance and prepare any necessary documentation on your instruction.

Please refer to our timelines over the page for more information about the stages and costs.

Renewal Fees (every five years)

Renewal fees are payable on every registered design in every country. There is usually a maximum term of between 15 and 25 years. In most countries the renewal fees are paid every five years on the anniversary of the filing date.

Enforcement & Exploitation

The right to **enforce** a Registered Design begins after the registration has been confirmed: It is not possible to sue for infringement until it has been confirmed.

It is possible to **exploit** a design during the application process by granting licences or otherwise commercially using the design.

The unified nature of a Community Registration does have many advantages and some disadvantages. It is worth seeking advice as to where the balance may lie for your requirements.

Post-grant Procedures

A registration can be challenged at any time on the basis that it is not 'valid', i.e. should not have been registered. This typically involves National Courts.

Using the Multiple-Country Procedures to Obtain Foreign Protection

International System (Hague)

The Hague system enables a single International design application to be filed for seeking foreign protection. It is necessary for an applicant to specifically designate WHICH COUNTRIES they want to seek protection in at the outset. The application will eventually be granted as an international registration, but is then subject to an examination by each of the foreign design Offices. If a particular Office ultimately refuses to uphold the International Registration in their country then the International Registration is amended to remove that country.

The system provides an easy way to file and process foreign patent applications for most countries of the world at a time-critical stage (Step H). It also makes it easy to maintain the registration by allowing renewal fees to be paid to a central organisation. The alternative is to file individual applications in each country at Step H.

The Hague system does have both advantages and disadvantages. It is worth seeking advice for your individual requirements.

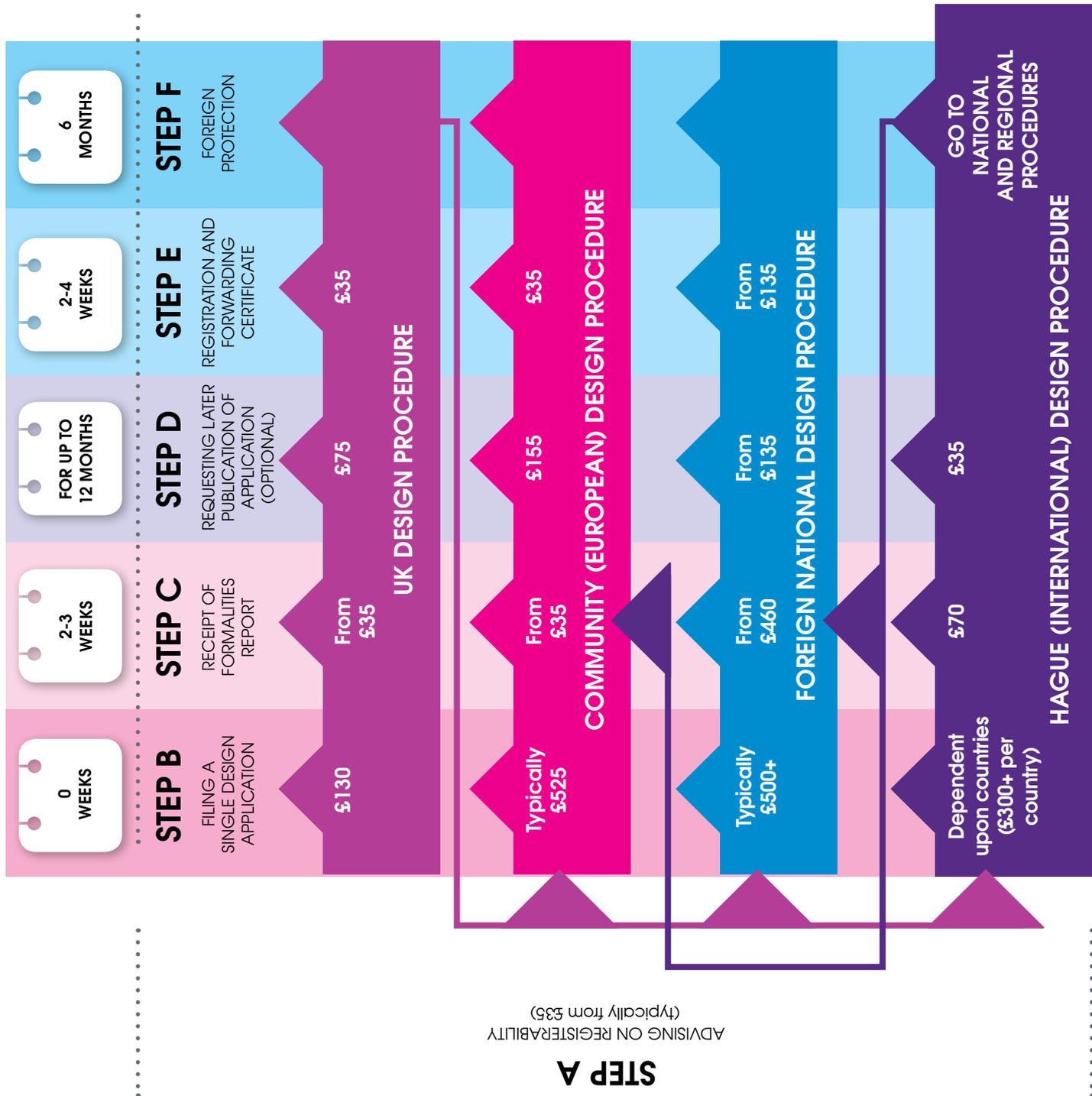
Community Registered Designs

The Community Registered Design system enables a single design application to be filed. Unlike the International procedure, the entire application procedure is based at the Community Office (OHIM) and if successful results in a Community Registration. The Registration is maintained as a single unified entity effective in all of the countries in the system. The Community system is a cost effective way to seek design protection in a number of European countries. The alternative is to file individual applications in each country at Step H.

Advantageously, the Community system can be used following the International system if designated in the International application.

TYPICAL DESIGN PROCEDURES

We have shown the timings and costs for a typical case starting with a UK design application. They are intended as guidelines only and may differ as Design Office fees, exchange rates and Foreign Associates charges change. Where we are able to anticipate that there may be higher charges than those shown, we will make every effort to advise you in advance. The information provided is for general information only and is not legal advice. Brooke-Jones LTD does not accept any liability for any loss or harm arising from your reliance on this general information. You must seek appropriate advice. Please note that all estimates shown are exclusive of VAT.



STEP A
ADVISING ON REGISTERABILITY
(typically from £35)