



The Institute of
Trade Mark
Attorneys

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WHAT IS A DESIGN?

“Design” means the appearance of the whole or part of a product or logo.

The particular features which make up a design include contours, lines, shapes, colours and ornamentation. There is no need for the design to appeal to the eye but component parts are only eligible for protection if the part is visible during normal use.

Design does not protect the way in which the product works or fits together with other parts. That is not to say that you cannot protect your design for a functional product. It is merely that protection for the design will not extend to those features dictated solely by function.

TO WHAT PRODUCTS CAN YOU APPLY A DESIGN?

The “product” to which a design may be applied or in which it may be incorporated includes almost everything, including industrial or handicraft products, packaging and logos.

WHY PROTECT DESIGN?

A substantial part of the goodwill enjoyed by a business is often associated with the design of the products that it creates, their packaging and the visual materials used to advertise the products to the public.

It follows that your ability to prevent others from mimicking your designs can be crucial in defending your rights and ensuring that what differentiates your products and logos from those of competitors is not lost.

The key points to note about registering your design either in the UK or throughout the European Community are as follows:

- A properly registered design gives the owner a maximum 25-year monopoly on the use of that design in respect of all goods.
- Registration can be obtained very quickly; in the European Community sometimes on the very day that the application is filed. Accordingly, an enforceable monopoly right can be obtained at an early stage in any marketing or product launch strategy.
- Once you have a registered design, products incorporating that design (or a design creating the same overall impression) can only be made by you or with your consent.
- Registering your design provides certainty as to your rights in the design and your rights to exploit it.
- Your registered design is an asset like any other asset of the business and can be licensed, transferred or offered as collateral in return for valuable consideration.

Members of ITMA, The Institute of Trade Mark Attorneys, can guide you through the complexities of registered designs and can identify the most appropriate strategy for registration.

WHAT ARE THE ESSENTIAL CRITERIA FOR REGISTRATION?

Registered designs need to be:

- new; and
- have “individual character”.

Having “individual character” means that it creates a different overall impression from existing designs.

It is important to note that public disclosure of your own design is relevant to whether your design is “new”. However, you have a “grace period” of 12 months from first disclosure before your application allowing you to test-market a product before deciding whether to file.

If your design has been in the public arena for more than 12 months, it will not be possible to obtain a valid design registration. It therefore pays to think about registering your design at the outset.

WHY FILE FOR REGISTERED DESIGN PROTECTION EARLY?

Although an application for a UK registered design is not invalidated by your own disclosures in the 12 months preceding filing, that proviso does not extend to disclosures of other designs created independently of your own. Also, there may not be a grace period in some other countries, so it is a good idea to speak to an ITMA design expert before disclosing anything.

ARE THERE OTHER FORMS OF PROTECTION FOR DESIGNS IN THE UK AND THE EU?

It is possible that your design will qualify for copyright or unregistered design rights for which no registration is required.

However, the owner of a design registration is presumed to own the design and it is also assumed that the design is original. It is up to the alleged infringer to prove the opposite.

With copyright and unregistered design, it is up to the owner of the relevant right to show that the right exists and this is often difficult to show many years after the design was created. This reversed burden for copyright and unregistered design rights makes legal action to enforce those rights very much more difficult and expensive than is the case for registered designs.

Registered designs protect against all infringements even when the infringer is unaware of your rights. With copyright and unregistered design rights, you must convince the court that the alleged infringer has copied your design. Independent creation is a defence to copyright or unregistered design right infringement but not to a claim to infringement of a registered design.

It may also be possible to register a design as a trade mark. This is particularly true for logos. For three-dimensional products, it is often, but not always, necessary to provide evidence that the relevant consumers have over time come to recognise that your design acts as a sign denoting the trade origin of the product.

HOW MUCH WILL IT COST?

The cost of registering a design is made up of:

Fixed fees paid to the UK Intellectual Property Office www.ipo.gov.uk or the European Community Office www.oami.europa.eu; and professional fees charged by your ITMA member.

The costs will vary depending on the complexity of the particular matter and the work involved in preparing appropriate representations.

If you have several new designs, these can generally be filed in the same application and the cost per design can be considerably reduced.

WHERE CAN I GET HELP?

If you are thinking of launching a new brand or product, you should consider consulting a member of The Institute of Trade Mark Attorneys (ITMA) who will guide you through the complexities of registered designs and identify the most appropriate strategy for registration.

There is now considerable overlap between Trade Marks and Registered Designs and often both forms of protection should be considered.

Employing a member of the Institute will provide you with someone who possesses specialised knowledge and experience and access to an extensive network of international associations to guide you through the different rules and regulations world-wide.