How do design rights work? – *Video Transcript*

How do you file for a registered design right?

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So, if you want to file a registered design, essentially there are online portals, both at the UK and at the EU level. I would say they're relatively easy to follow, and relatively user friendly. The process is, particularly on the UK side, similar to the UK trademark filing process, so essentially you need to provide: who you are, a bit of detail around the design itself, at both the UK and the EU level you can register up to seven different faces on a design. So, to go to the bag example, you could register seven different aspects, so you might have the front aspect, then you would do a side-on, you might do that side, and then maybe you could do the back as well. You can do up to seven different sides to the particular product. You can also register additional designs at the same time, and the reason why that's something that you might want to do, is that you've only got a one year period in which to do it as a design and it's a lot cheaper to register a lot of designs at the same time, than it is to register a separate design on a regular occasion.

So, for example, I've done a lot of work with fashion companies, and what they tend to do is review all of their products, on at least a, generally, seasonal basis, every six months, and they'll identify any products that are coming up that they think are worth registering as a design. Sometimes they go through that process and decide that there's nothing and that they don't want to commit their money to expanding the portfolio, but it's a good process to go through, just to think about what's really important and what might be innovative in terms of the product design process.

It's super-fast to get a design. In the European Intellectual Property Office, it takes maybe a week or so – I mean I've had it happen within twenty-four hours, but that was when they were being super-efficient. Most of the time you're looking at between five working days; at the longest ten working days. Obviously, that assumes that there's been no deficiencies in the application. If there are any issues that the examiner comes back to you with, then it could take a bit longer. But they're not looking to see whether it's novel or has a different overall impression to what's come before. All they're looking is to check that it meets their

requirements as far as the quality of the image and the way in which it's, you know, you can only have seven different faces for the same product, so for example if you don't register seven different faces for the same design but included seven different designs in a single design application, that could cause problems, or it would cause problems and you would probably have the design rejected. Those are the major types of problem that come up. In practice, it's generally a quite straightforward process.

I think it's fair to say that the EUIPO is relatively relaxed in terms of what it allows to be registered – you wouldn't be able to register, say, a block of colour, but most other things you might be able to get onto the register. The problem then is whether will stand up if it's actually challenged when you come to rely on it in court. And another really important thing to be aware of, is that, if you haven't issued proceedings in a particular member state, and you're relying on a European Union intellectual property right, there's quite a significant risk that somebody could apply to invalidate that right at the registry level and then you can't rely on it in court proceedings until the registry has completed its process, and then assess whether it should be invalidated. And the reason why this is quite important is it basically 'gundges' up the whole process and it can lead to a really long delay, so even if you do have a registered design, before you write to anyone and think about whether it's something that you want to allege has been infringed, it's very important to get specialised legal advice, because you can find yourself kind of caught out if you haven't taken the correct steps to preserve your position.

The cost of obtaining a registered design

In terms of the relative cost, designs are basically the cheapest compared to trademarks, where you're looking at somewhere between five hundred and, maybe, a thousand pounds, just on the filing fee level, dependent on how many different classes of goods and services you include; right the way through to multiple thousands for a patent, certainly once you're looking at registering lots of different territories. If you wanted to get protection across all 28 member states for a patent, then you'd be looking at multiples, maybe even one hundred thousand pounds to get a patent, whereas you can get design protection for three hundred and fifty pounds, or three hundred and fifty euros, so there's obviously a huge difference there and it's not going to cover the same sorts of things, so it's much more limited to the particular visual appearance of a product. But on the other hand, often that's the key thing when you're looking at what other people are going to be copying and that might be the thing that's most important to you from a branding perspective.

As far as the costs are concerned, it's very very cheap. For the UK, I believe it's round about one hundred pounds, and then you're looking at fifty pounds for each additional design that you register at the same point in time. For the EU, obviously it's a euro fee rather than a pound fee but it's round about three hundred pounds and then another one hundred and fifty pounds for each additional application. That then gets tapered, so if you registered more than ten designs, then it gets cheaper again. So, it's really worth thinking about exactly what it is that you want to register. That is just the filing fee and there is an additional fee, obviously if you get a lawyer or a trademark attorney involved, and they assist with the design filing process. I cannot stress enough how sensible it is to get that expert advice because if you don't there's a real risk of spending the money on getting something that ultimately is not going to be useful when it comes to a point in time when you actually want to rely on it – and it can also give you something of a false sense of security where you think that you've got protection for something when in fact you don't.

Requirements for registering a design

So, in order to register a design, you need to have identified exactly what it is that you want to register. So that could be that you've got a really good quality photographs of the product – you've got to make sure that there's nothing else in the background of the photograph, that it is literally just the product and ideally the different faces to that product.

You could also choose to register a CAD, but bear in mind that any shading or anything that's distinctive on the CAD will also be considered to be part of the design – and this was the big problem in the Trunki case that became quite famous and was highly reported.

And then finally for a line drawing. You can obviously do that yourself from a CAD, but there are specialist line drawers who have much more expertise in terms of making sure that it is compliant with the different

intellectual property offices, both in Europe and internationally. So, if you're registering a line drawing then it's really worth investing the additional money in getting their expertise and help.

Multi-part registered designs

An important feature of designs is that you don't necessarily need to just protect the product, so the entire product, you can also protect parts of it – and that can apply both at the registered and at the unregistered level – and the reason why that is super helpful is because sometimes you might have, when you compare the products side by side, they don't actually look that similar because an infringing product might have had a lot of other elements added to it and your original product could have lots of other features that haven't been copied. But if you're breaking it down into terms of the parts, say a handle or the texture or some other aspect of the product, then that particular part might be something that you've registered, or even if it hasn't, if you're within that three year period, it's something that you can rely on as an unregistered community design. And if it's purely a feature, a shape, then it's something that you can rely on for up to ten years, from a UK unregistered design right perspective. And when you're thinking about registering, it's really sensible to think in terms of that stratification – so register the whole product but then also think about which parts of that product are much more distinctive and are going to be much more commerically valuable and register just those elements on their own. And the reason why that's really helpful is that it gives you much more scope for taking action against an infringer when you come down the line. So if you're thinking, from an unregistered design perspective, when you're registering a design, then you can give yourself a much stronger position, and as I mentioned earlier you can, essentially, the more designs you register in one go, the cheaper it becomes, so there is an 'economies of scale' approach to designs and that's why it can make a lot of sense to register both the exterior of a product from a photograph, from a CAD and from a line drawing perspective and then to break that down for individual parts that are really distinctive as well.

Moderator: Thanks for watching. Don't forget to check out the additional resources below, and we'll see you in video 3.