



How do design rights work? – *Video Transcript*

How useful are design rights?

[Click here for video](#)

So, I've said before that designs are IP's best kept secret, and I think that's 100 per cent the case. They are something where many people don't understand or even know that they exist in the first place. I'd say that's partly due to the media reporting – even when you have a case that is to do with designs, like the famous Tunki decision, often it's misreported as being a case to do with copyright, patents or maybe even trademarks. So, there's very limited knowledge that designs even exist, and even if that knowledge does exist, there's not really the understanding of the different types of designs, so the unregistered and the registered; and the fact that it can be at a national and at an EU level; and also that there's obviously this international dimension as well with countries such as the United States, Japan and may other territories also offering forms of design protection.

The reason why I think they are a 'best kept secret,' is because they are very very helpful when it comes to stopping somebody releasing a product that's very similar and they are often ignored and simply left – and so, I suppose, a really good example of this is a case that I heard recently where somebody was alleging that a particular dress was an infringement from a copyright and from a passing off perspective – and that's fine, copyright obviously protects the surface decoration of a dress and passing off is possible in some circumstances where there's 'get up' of a product, but passing off is a really difficult case to bring because you need to show that there's goodwill in the get up of a product, so that's ignoring the brand name, you need to show that your product has developed such a significant amount of goodwill that people would automatically associate it as coming from your business, regardless of the brand name. Then you also need to show that there's been a misrepresentation to the product to the public that that product comes from a different entity, and that again is a really difficult hurdle to meet.

When you're talking about a design, it's so much simpler because you're either looking at a registered, you know, literally you've got your bit of paper there that delineates the extent of your design, or you're talking

about the visual appearance of the product, which is really easy to depict and to articulate. So, it's much simpler to rely on designs, they're much more likely to succeed. The number of cases where an unregistered design has succeeded in the courts, when I did some research back in 2012, there hadn't been a single case where an unregistered design had been alleged in court proceedings that had gone through to trial where that hadn't been successful. There have been a few cases since then, but it's still few and far between.

Generally, you will get an injunction and you will get damages based on an unregistered design. It's more challenging with registered designs because you need to identify and invest the time and money upfront in identifying exactly what is registerable and what is likely to be copied, but it is still a really valuable right and if you've got your registered designs in order, then again, there's a very very high prospect of success when it actually comes to court. And I think a really important point to be aware of is that it is easy to look at the data from cases that are litigated right the way through to trial, but a lot of data that isn't captured from all of the cases that don't reach the claim form stage, where somebody like me is writing to somebody who has infringed and reaches a resolution much more quickly without needing to issue proceedings because you've got your registered right and you've got the evidence of the unregistered design, for example.

The 'Trunki Case'

The 'Trunki case' is one of the more notorious design cases, and there are three important points that come out of it. The first, which I cannot stress enough, is that the case on the unregistered design (so they relied on UK unregistered design right), that was successful, and they were able to get an injunction in the United Kingdom against a product that essentially copied the Trunki suitcase. The problem with the design, with the registered design, was that it was not quite close enough to the infringement and also there were some examples, including an earlier example of a prototype that had been shared publicly before this one year grace period kicked in that meant that the scope for protection was much more limited. So, in that particular case, the design included shading on the wheels, and on the horns of the Trunki animal and that meant that that particular element, so the comparison, the darker shading on the wheels and on the horns was taken to be a feature of the design and when you actually looked at what the infringement was, those features weren't carried through.

So, the big take-away as far as the IP community is concerned is the importance of registering if you've got the money and if you've got the inclination to go through this much detail, is to register at each different level that I have spoken about. So, you have a line drawing to protect the shape on its own, a CAD to protect features of the surface decoration, and then also photographs to protect the particular way in which you use that product. It's also worth bearing in mind, with the Trunki case, that obviously the design that they registered was of one particular product, but they had all sorts of iterations themselves and in some cases what had been copied was a different iteration of the Trunki design – and that's why again, the case on the unregistered design was much more successful and led to them getting a much longer injunction. It's simple in terms of the term of protection to bear in mind that whilst a design can last up to twenty-five years, an unregistered community design will only last three years, and the UK unregistered design can last up to ten years from the first public disclosure. So, that's why very often, although it obviously only covers the UK, the unregistered design system that we have in the UK, and have had for many years, can be invaluable for many designers, particularly if they're focused more on the shape of a product rather than say graphic design where the surface decoration is a bit more important.

How to make better use of design rights

So, my number one bit of advice is to regularly review your new product chain. When you're coming to a, for example, a rebrand, thinking about registering the logo, the new logo, thinking even about registering things like any particularly distinctive graphical user interfaces, anything that is really important to the get-up of your business. Think about whether it is something that you'd be happy with a competitor copying and, particularly if it is something where, maybe there isn't a strong pattern or surface decoration element, then really you're looking at design as being the thing that is going to protect you and that's the point at which you should get specialised legal advice and speak to somebody to identify the designs that are going to be best for you. You might decide to do nothing off the back of that or you might decide that that's a route that you want to try and, believe me, the first time that you come to rely on a design and you are successful, you will really be very grateful for having your design portfolio in place.

But, even if you don't go to the trouble of registering a design, it's still really important to keep a good record of where you first disclosed because the qualifying criteria for a European design are that it needs to have been first disclosed in the European Union. Obviously if you are a UK business, that's quite likely to happen, but if, for example, you are part of a country that is not, or is no longer a member of the European Union, you need to be very careful to first disclose in the European Union itself – and maybe you need to also think about simultaneous disclosure. If, say, for example, you're in a country like, potentially the UK, which is no longer a member of the European Union, you might want to register, or have rights in both the UK and the EU, you'd want to look at ways in which you could share that design publicly in both forums. So, one way of doing this is via a website which is available in both territories. Another way is arguably via an Instagram account, where certainly there isn't settled law on this point, but it's arguable that that is an international disclosure, so it's happening in all jurisdictions at the same time.

Finally, as with all legal problems, one of the most important things to do is to keep really good records and having good records of when something was disclosed and how it was disclosed in public is really important. It's really sensible to maintain a list from your social media feeds, particularly if something is or maybe deleted in the future, so you've got a really clear record of when it was first shared.

Another important thing to keep track of is who actually designed the product because evidence from the designer is often really important when it comes to litigating and also, as far as the UK unregistered design right is concerned, the identity of the designer is really important in terms of whether it qualifies for design right protection. So, essentially, you need to, or one of the designers needs to be a European Union citizen, or a citizen of various other countries that have international treaties with the UK, of which I would say, the most obvious are Hong Kong and some of the Caribbean countries. So, if in doubt, do your research and maybe get another designer onto the team who would qualify for UK unregistered design rights.

Data sources for design rights

So, designs are much less popular and consequently there's a lot less data on them. The EU IPO has very good, it's a fantastic database of all of the different designs. It can be quite challenging to actually identify designs that are relevant. When you're applying to register a design, you do need to identify it, by identifying the particular class and goods that it's going to be applied to but when it actually comes down to it, that's not a relevant thing that is going to be looked at by any court when you're determining whether or not something is valid or not. Essentially, any product that looks the same can be used to invalidate your design, even if it's for a completely different product.

So, a good example of this is the, there are these massage balls that have a sort of a plastic product, with little spokes that go out, and there are also laundry balls that look almost exactly the same and, although they are obviously for different products, all that designs are concerned about is the visual appearance and, as a result, the massage ball invalidated the laundry ball because they looked the same. So, it's kind of, that can make it very difficult to search via the Locarno class system because you might search for, I don't know, a particular type of product and you go through all of that and you see that nobody has anything similar, but there could well be another product that is essentially totally different in terms of functionality but looks the same and that could be a problem for you.

I'm not aware of any database that has gone through this sophisticated process of making this a much more easier thing to look at, and again, I'm not aware of anything that looks at the names of people, so either the inventors or the applicants of different designs and tracks through, but that's certainly something that, as well as looking at patent data and trademark data, is a relevant thing, particularly when you're looking at due diligence on a business.

Design rights in different industries

The way in which designs are used definitely varies between different industries. For example, the fashion industry, which is very high turnaround, they tend to have excellent reliance on unregistered community designs because that three-year period is plenty for most designs. By the time three years is over, it's probably out of fashion anyway. The more, sort of, large scale businesses have got a lot more sophisticated at registering the designs as well.

So particularly for core products like a bag, or maybe jewellery, they've got quite a good system in place for registering these sorts of products when they come out. Other industries, it's a bit more variable I would say, the automotive industry have been very good at registering different parts of their vehicles. The tech community has not embraced them to quite the same degree, but, for example, there are, some companies that have been very active at registering game characters or the graphical user interface for a product – and logos, obviously. And this is a really clever way of ensuring that you're able to rely on something from a merchandising point of view as well.

So, the best industries have generally been ones where it's either like a product, so like toy companies, for example, or ones where they've got a lot of cash, so the automotive industry being a really good example of that. It's also, in some circumstances, actually just registering the get-up of a packaging without the brand name can be a really good way of getting that, sort of, broader scope of protection and in some circumstances, the pharmaceutical industry has looked at that. But again, you've got that short time period in which to do that, so only one year – and also, in lots of circumstances, it's probably not going to be sufficiently novel, or have a different overall impression to what's gone before. So again, whilst they might be able to get it onto the register, it's very likely to be capable of being invalidated in the future.

Moderator: Thank you for watching. We'll see you in the last video on this course and don't forget to check out the additional resources.