

Brexit and design rights

A practical guide

The UK's departure from the EU has added additional hurdles for the protection of design rights in Europe. Alongside decision-making as to whether to seek registered protection (as opposed to unregistered design rights), creators also need to consider new challenges relating to disclosure and scope of protection. We compare the systems and provide some guidance below:

Registered Design Rights

Previously, to benefit from registered design protection in the UK, holders could either secure national rights by way of a UK Registered Design or EU-wide rights (i.e. the EU27 & the UK) as a Registered Community Design (RCD). Since the UK's departure from the EU, Registered Community Designs are now only protected in the EU27 and the UK is no longer covered within the scope of protection.

Nevertheless, owners of RCDs (including those protected under the Hague Convention) which were registered at the end of the transition period have been given continuity of protection in the UK by way of the automatic cloning of all such registered rights on 1 January. This has created many new national UK Registered Designs, referred to as UK comparable or re-registered designs. If an RCD was pending at the end of the transition period, or indeed, registered but with publication deferred, the right has not automatically been cloned, but the owner has until 30 September 2021 to apply for an equivalent national UK registration.

The UK Registered Design and RCD systems are currently aligned in that they protect the appearance of the whole or part of a product resulting from the features of, in particular, the lines, the contours, the shape, the texture or materials comprising the product and/or its ornamentation. The legislative definition of a product is aligned between the UK and EU system, along with the tests for novelty and individual character (although the geographical definitions are now slightly different).

Moreover, both the national UK system and the EU system provide registered protection for up to a maximum of 25 years from the filing date, with the registrations being renewable every five years. There are no geographical limitations on eligibility of holders for either UK Registered Designs or RCDs. This means UK holders can continue to seek RCD protection by filing new RCDs and non-UK holders can continue to seek UK national design rights by filing new UK Registered Design applications.

While the systems are broadly aligned, there are some small differences. For instance, publication of a UK Registered Design can only be deferred for 12 months from the date of filing and if publication is not requested by this date, the registration is considered abandoned. The RCD system allows deferment of publication for 30 months and publication must be requested before expiry of the 27th month.

These small differences are likely to increase in number, as the UK will no longer be bound by EU law and there is likely to be a gradual divergence between the two systems.

Unregistered Designs Rights

While the registered design systems are broadly aligned between the EU and the UK, the same is not true for the protection of unregistered designs.

Prior to the end of the transition period, the protection of unregistered design rights in the UK could be summarised as follows:

1) UK Unregistered Design (UKUD)

- Automatically arises when a design is created (by recording in a design document) providing the eligibility criteria are satisfied.
- The designer must have a connection with the UK or EU (or a number of other qualifying countries specified in UK legislation) and this connection must arise from the location of the designers, the employer of the designer and/or the first marketing.

- The design must fall within the statutory definition of a "design", being a shape or configuration (internal or external) of the whole or part of an article. Important to note that this does not cover colour scheme, decorations, 2D designs or other surface decorations.
- The design must be original, not commonplace and recorded in a design document or an article made to the design.
- The design must not be a method or principle of construction (i.e. have a functional purpose) or fall foul of the must fit or must match exclusions.
- Providing the eligibility requirements are met, protection lasts for up to 15 years from the end of the year in which the design was first recorded or a corresponding article was first made (whichever is first).

2) Unregistered Community Design (UCD)

- Automatically arises when a design is first made available to the public within the Community.
- The definition of a design is the same as that for a registered design (as outlined above) and will therefore protect both 3D and 2D designs, including surface decoration.
- The design must be novel and have individual character, with the same tests applying and designers will have to decide whether to firstly disclose their design in the EU to benefit from UCD protection or within the UK, so as to benefit from unregistered protection in the UK.

In addition to the choice of where to first disclose, designers should also be aware of the uncertainty and risks attached to first disclosure online. There is currently no clarity as to whether first disclosure online will satisfy the disclosure requirements for the UK or the EU. As such, designers who first disclose online could be left in a difficult situation of losing out on protection in both territories.

Key tips and advice

As with many topics, the UK's departure from the EU and the impact on protection of design rights is far from straightforward. While steps have been taken to ensure continuity of protection, this has left an already complex landscape of rights even more difficult to navigate.

Some guidance:

- For holders of existing RCDs, be sure to understand what rights have been automatically created in the UK and ensure these have been added to your portfolio management database. For all Novagraaf clients, we have automatically added the cloned rights to our records.
- If equivalent UK registered rights were already in place, there may now be a duplication of protection which could enable cost savings to be realised by allowing duplicate registrations to lapse on renewal.
- For holders of RCDs which were pending at the end of the transition period, be sure to diarise the deadline of 30 September 2021 to apply for equivalent UK protection. All Novagraaf clients with such applications on our records will be contacted to remind you of this deadline and discuss the strategy considerations for seeking protection in the UK.
- When considering registered protection for new designs, if holders are interested in the EU and the UK, it will now be necessary to file separate applications and this needs to be taken into account in budget preparations, not only at the point of filing but also when planning for maintenance.

- For rights holders that usually utilise only the RCD system and will now also need to file separate UK applications, the difference in publication deferment must be taken into account when considering filing and disclosure strategy.
- When clearing a design for use and/or looking to enforce existing rights, be aware of the continuity of protection granted to UCD in place at the end of the transition period and the fact that disclosure outside the UK will not impact the validity of the resulting UCD.
- For designers who routinely rely on unregistered rights, be sure to carefully consider how the changes to disclosure might affect the scope of protection moving forward and take steps to ensure qualifying disclosure is made in the most relevant territory.
- When operating in more than one territory, take steps to ensure first disclosure is clearly made in one territory to benefit from unregistered rights in that territory and look to apply for registered protection in any other territory of interest. Of course, if budget allows, securing registered rights in all territories of interest will provide the most reliable form of protection and should be prioritised where possible.

Get in touch

If you need any help with your registered or unregistered design rights, reach out to your representative at LondonTM@novagraaf.com.