

Important Design Law Briefing Note

A number of important changes in UK design law will come into effect next week (1 October 2014) which may be of interest to clients.

We have listed some of the more relevant changes below for your background reference; however, the most important change will make *intentional* copying of registered design rights a ***criminal*** offence. The main purpose behind this change is to strengthen the rights conferred by registering designs and to prevent companies and individuals profiting from making (or using) slavish copies of other people's designs. There may of course be a number of long term repercussions resulting from this change in the law; however, there are also two short term repercussions as follows:-

- 1) This gives business and individuals a significant additional commercial reason to register their designs; and
- 2) This means that businesses and individuals will need to be *extremely* careful to ensure that they are not copying anyone else's registered design rights since the consequences of such are severe.

In addition to the above, there are a number of other changes being made to UK design law on 1 October. How important these will be in your particular case will depend on a number of factors; however, for your reference these additional changes are summarised below:-

Originality

In order to qualify for Unregistered Design Rights (UDR), a design must not be commonplace in the design field in question at the time it was created. Previously the design laws were silent on the geographical range of the design field in question which created some uncertainty. However, the law on this point has now been clarified by specifically stating that, from 1 October, despite where the design was originally created, it will only be protected as a UK UDR if it is not well known in the UK or EU (or in certain specific countries which have reciprocal arrangements with the UK).

Default Ownership

Absent of a contract to the contrary, prior to 1 October, if you commissioned a third party to produce a design for you, the default position was that, as commissioner, you would own the design under *UK* law; however, this was contradictory to the position under *EU* law. Therefore, from 1 October 2014, the law will change such that, if you commission a non-employee to produce a design for you, a written agreement will be necessary to ensure that all design rights belong to you as commissioner.

Private Non-Commercial Use

From 1 October, privately using the design of another for non-commercial, experimental or teaching purposes will not be deemed an infringement of that design.

Future Changes

Although not yet implemented, a number of changes in addition to those outlined above are scheduled to take place in 2015. These include the UK Intellectual Property Office (UKIPO) improving its online access to their registered design files and the UK joining the Hague International design registration system which should reduce the overall cost for UK businesses to obtain foreign design registrations in certain member countries.

Summary

The above changes should generally improve the system of obtaining registered design rights in the UK and internationally and should encourage businesses and individuals to a) ensure that they are registering their designs and b) ensure that they are not infringing the design rights of others. To what extent these changes will achieve those aims remains to be seen; however, they certainly do make obtaining *registered* design rights even more important than it has been in the past. This, coupled with the relative speed and cost-effectiveness of obtaining registered design protection, means businesses and individuals should be considering carefully whether their designs should be being registered at an early stage.

If you require any advice or information on registering your designs, or avoiding infringing the design rights of others, please do not hesitate to contact us.