

REGISTERED DESIGNS



The advertisement features a background of various sized gears in shades of grey and blue. In the center, there is a smaller inset image showing a globe surrounded by several interlocking gears. Below this, a larger globe is shown with the text 'Bailey Walsh & Co. LLP' curved around it. At the bottom of the globe, the text 'Cost effective protection for your ideas™' is written. Below this, a horizontal line of small blue dots separates the text 'PATENTS • TRADE MARKS • DESIGNS • COPYRIGHT'.

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REGISTERED DESIGNS

Registered designs protect the aesthetic appearance of a whole or part of a novel design, including novel features of shape and configuration of an article and/or pattern and ornamentation applied to an article, providing these features are visible to the eye during normal use of the article. Other features which can be protected by registered designs include novel arrangements of lines, contours, shapes, textures, packaging, get-up, graphical symbols and type faces.

The owner of a registered design has the sole right in the country in which the design is registered to make, sell, import for sale, hire or use in business the design or such articles incorporating the design as registered (or a design not substantially different), as well as the right to take legal action against an infringer and claim damages, for up to a maximum of twenty five years.

PROCESS FOR OBTAINING A REGISTERED DESIGN

The procedure for obtaining a registered design in the United Kingdom can be divided into three stages.

- 1) Filing
- 2) Prosecution
- 3) Registration

A summary of each of the above stages is given below.

FILING A REGISTERED DESIGN APPLICATION

The first stage of the process is to file a registered design application at the UK Design Registry. The application must include a number of representations of the article or design for which protection is desired. These representations may be in the form of photographs or drawings and should include different views of the article or design, sufficient to show all aspects of the article or design. In most cases “informal” representations or even a sample of the design can be filed to secure a filing date, and the necessary “formal” representations can be prepared later.



Once the application is filed, a filing date and application number is given to the application and the application is then prosecuted by the UK Design Registry to determine whether it complies with UK Design Law Requirements.

PROSECUTION

The UK Design Registry do not undertake a detailed search to determine whether a design is novel, although such a search can be undertaken upon specific request by the applicant. However, the Design Registry will still object to the registration of designs obviously lacking novelty. In most cases the application will proceed to registration without objection but some modifications to the application may be considered necessary to comply with formal requirements of the UK Design Registry.

REGISTRATION

Once the UK Design Registry consider the design application is acceptable, they will register the design and issue a Certificate of Registration. The registration will be effective for an initial period of five years but this is extendable upon payment of renewal fees for four further periods of 5 years, giving a total possible term of protection of 25 years. In addition, upon registration the design will become publicly available and will be published by the Design Registry.

VALIDITY OF A REGISTERED DESIGN

For a design registration to be valid in the UK, the design for which protection is sought must be novel at the date of filing the application for registration and have individual character. A design is considered to be novel if it has not been disclosed to the public anywhere in the world prior to the filing date of the application. A design is considered to have individual character if the overall impression it produces on a user is different to that of other designs made available to the public.

There is a grace period of one year in which the application for registration can be filed from when the design is first made available to the public which will not destroy the novelty of the design. However, the application for



registration should be made as soon as possible to ensure a third party does not obtain protection for the same or similar design during this one year period.

A design registration does not protect features dictated solely by the function the article or design has to perform, or features of shape or configuration which are dependant on the appearance of another article of which the proposed design forms an integral part.

REGISTERED DESIGN PROTECTION IN FOREIGN COUNTRIES

If you require registered design protection abroad to protect your export markets or manufacturing interests, this can be done in two ways:-

- a) filing separate registered design applications in each country in which registered design protection is desired;
- b) file a European Community Design Application covering all the European Union Countries

The requirements for the design to be novel and for representations of the design or article to be filed with the application when making applications for design registration in foreign countries are the same as in the UK. The process is also broadly the same, although in some foreign countries the relevant Design Registry will undertake more thorough searching procedures.

Once a first design application for a particular design has been filed, the novelty of the design will not be destroyed in other countries for which design protection is desired, providing one or more foreign design applications are filed in the relevant countries within six months of the first filing date, and a “priority” claim to the first application is made.

Multiple designs in the same class of goods can be filed in a single application in respect of a European Community Design Application providing additional fees are paid. In addition, publication of the design registration can be deferred for up to 30 months from the filing date if specifically requested in Europe.



OUR SERVICE TO YOU

We offer a free, no-obligation consultation to discuss the above registered design procedure in more detail, to answer any of your queries and to provide you with an initial assessment as to whether your design is likely to meet the criteria for design registration and/or whether there is some other form of intellectual property protection which would be more suited to your requirements.

We can undertake initial searching of the UK Designs Registry and provide you with an opinion as to whether there are any prior published designs which are the same or similar to your design and which may prevent your design from being registered. Such searching can also reveal previously published registered designs which your design may infringe if sold, made, imported or otherwise without permission in the United Kingdom or other selected countries.

We can prepare and file the UK Registered Design Application and one or more foreign design applications. We will forward all documentation received from the Design Registry in relation to your design application to you, together with an explanation as to meaning of the documentation and details relating to the actions that need to be taken to keep the design application or registration in force. Reminder letters are also sent in relation to deadlines for which we require your instructions.

A summary of some of the other services we offer are:

- General Advice on Intellectual Property Matters
- Filing, Prosecution and Management of Intellectual Property Rights
- Management of Intellectual Property Portfolios
- Registered Design Searching
- Registered Design Filing and Prosecution in the UK and Abroad
- Advice on Entitlement Issues
- Licensing
- Assignments
- Infringement Assessments
- Renewals



- Bring and Defend Actions for the Revocation of a Design
- Send Letters Before Action

Please do not hesitate to contact one of our advisors if you have any queries relating to our services and/or would like to arrange a meeting or to instruct us to undertake work on your behalf. Further information can also be found on our website at www.bailey-walsh.com

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