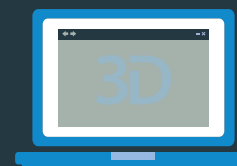




# Welcome to the fourth edition of DesignWrites

*At Bird & Bird we're passionate about design. DesignWrites will unravel and explore the seemingly complex world of design protection, offering practical advice by looking at recent design cases, hearing from industry experts and sharing stories from the wider design community.*

If you would like advice on how best to protect your designs or take action to stop copycats, please contact Ewan Grist via [ewan.grist@twobirds.com](mailto:ewan.grist@twobirds.com) for a complimentary consultation.



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# UK: Calculating damages for design infringement



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The case of *Kohler Mira Limited v Bristan Group Limited*<sup>1</sup> related to the infringement of two Community registered designs and a number of UK unregistered design rights (“UDRs”) for electric shower units. In January 2014 the court found that three models sold by Bristan infringed certain of the UDRs owned by Kohler and so Kohler was entitled to damages in respect of this infringement. The resulting inquiry as to damages proceedings highlighted some of the factors to be taken into account when approaching the notoriously difficult exercise of calculating damages, which are summarised below.

## Innocent infringement

With regard to UDRs, no damages are payable where “the defendant did not know, and had no reason to believe, that design right subsisted in the design”. The court however noted that a defendant is generally “likely to have good reason to suppose that design right subsists in an industrial article” unless he has some reason to believe otherwise. It would seem therefore that the default position is that defendant will be taken to have reason to believe that design right subsisted.

## Lost sales

The court held that while Kohler could in principle recover damages for lost sales of both protected products and sales of related but unprotected items (i.e. goods sold with the protected product or spare parts), this depended on whether such losses were “too speculative and too open to inaccuracy”. In this instance, since Bristan had significantly undercut Kohler in price, it could not be assumed that each of Bristan’s sales was a lost sale to Kohler. Absent sufficient evidence to enable the court to make an assessment of damages on the loss of profit basis, even on a rough and ready basis, Kohler was not able to recover damages in respect of lost sales.

## Reasonable royalty

Damages were therefore calculated on a reasonable royalty basis based on Kohler hypothetically licensing the infringed designs to Bristan. Where a comparable license

was available, this would usually provide the foundations for the assessment of damages under this head. Where no comparable license exists, as was the case here, the defendant’s profits on sales needed to be calculated and then apportioned between the parties according to what might reasonably have been negotiated if Kohler were a willing licensor and Bristan a willing licensee.

Bristan had made an average profit of 22.2% on its sales price. Following the apportionment approach used by the UK Intellectual Property Office (“IPO”) in *NIC Instruments Ltd’s License of Right (Design Right) Application [2005] RPC 1* (in which the IPO awarded 25% of the infringer’s profits to the claimant), the court elected to award 30% to Kohler since its designs “were something of a breakthrough in the industry”. Accordingly, Kohler was awarded damages based on a royalty of 6.7% of the net sales price of the infringing products.

## Comment

While the court stressed each damages assessment will depend on its facts, this case does set out some useful guidance for design owners seeking to work out how much they stand to gain in damages if they succeed at trial. It also flags some of the difficulties inherent in calculating damages, particularly where the infringing product undercuts the genuine product (as will often be the case). Design owners should of course keep in mind that they may elect to pursue an account of profits from the defendant instead of damages and in some circumstances, doing so may prove more fruitful.

1. [2014] EWHC 1931 (IPEC)

# Fashion designers welcome CJEU ruling on unregistered Community designs

The Court of Justice of the European Union (CJEU) has followed the Opinion of Advocate General Wathelet, delivered in April 2014, answering questions referred to it by the Irish Supreme Court in Karen Millen's favour. The questions concerned how the individual character of a design which is claimed to be entitled to be protected as an unregistered Community design is to be assessed.

## Background

Karen Millen is a UK registered company which produces and sells women's clothing in a number of retail outlets and in its own stores in Ireland. Dunnes Stores also has a retail business in women's clothing in Ireland. Karen Millen brought proceedings against Dunnes Stores in Ireland in 2007, claiming that a black knit top, a blue shirt and a brown shirt offered for sale by Dunnes Stores under its 'Savida' label in 2006 infringed its unregistered Community designs in garments which it had offered for sale in Ireland in 2005. At the trial before the High Court of Ireland, Dunnes Stores did not deny that its top and shirts had been produced by copying Karen Millen's designs. However, it denied that Karen Millen was entitled to unregistered Community designs in its top and shirts on the grounds that: (i) The Karen Millen garments did not have individual character, and (ii) the Design Regulation required Karen Millen to prove, as a matter of fact, that the garments had individual character. The High Court of Ireland refused to make a reference to the CJEU and found that Dunnes Stores had failed to establish that Karen Millen's top and shirts did not fulfil the individual character requirement in Article 6. Dunnes Stores appealed to the Irish Supreme Court which referred the questions below to the CJEU.

*“Unregistered designs are an important IP right for the fashion industry, given the short lives of fashion designs which may not justify the cost of design registrations.”*

## Questions referred to the CJEU

The questions referred to the CJEU by the Irish Supreme Court were as follows:

- In consideration of the individual character of a design which is claimed to be entitled to be protected as an unregistered Community design for the purposes of Council Regulation (EC) No 6/2002 of 12th December, 2001 on Community designs (the “Design Regulation”), is the overall impression it produces on the informed user, within the meaning of Article 6 of that Regulation, to be considered by reference to whether it differs from the overall impression produced on such a user by
  - » any individual design which has previously been made available to the public, or
  - » any combination of known design features from more than one such earlier design?
- Is a Community design court obliged to treat an unregistered Community design as valid for the purposes of Article 85(2) of the Design Regulation where the right holder merely indicates what constitutes the individual character of the design or is the right holder obliged to prove that the design has individual character in accordance with Article 6 of that Regulation?



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### CJEU's decision

The CJEU has ruled as follows:

- In order for a design to be considered to have individual character, the overall impression it produces on the informed user must be different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually.
- In order for a Community design court to treat an unregistered Community design as valid for the purposes of Article 85(2) of the Design Regulation, the right holder need only indicate the element or elements of the design concerned which give it individual character.

The CJEU's ruling is therefore in Karen Millen's favour in respect of both questions referred.

### Comment

The CJEU's decision will be welcomed by Karen Millen and other high end fashion designers and retailers who rely on unregistered design rights in their designs. Unregistered designs are an important IP right for the fashion industry, given the short lives of fashion designs which may not justify the cost of design registrations. The CJEU's decision bolsters the protection afforded to designs which are new and have individual character, and require lower-end, 'fast fashion' retailers to take even greater care when producing similar designs for sale at a lower price point, given the high threshold for challenging the validity of unregistered design rights.



# Supreme Court confirms the partial nullity of a Registered Community Design for a lollipop container

On 30 April 2014, the Supreme Court confirmed a judgment by the Court of Appeal of Alicante, declaring the partial invalidity of a Registered Community Design (RCD) for a lollipop container.

The dispute was started by the Italian company Perfetti Van Melle, S.p.A., owner of the RCD no. 000721543-0001, a lollipop container comprising the following four views.

Perfetti filed a claim against the Spanish company Fiesta, S.A. at the CTM Court for infringement of its RCD. Fiesta denied infringement arguing that its product was significantly different and created a dissimilar overall impression on the informed user. Moreover, Fiesta filed a counterclaim requesting the invalidity of Perfetti's RCD on the basis that it lacked novelty and individual character. Alternatively, Fiesta requested the invalidity of views 1 and 2 of the RCD.

The CTM Court however confirmed the infringement and dismissed the RCD invalidity request, as Fiesta had not proven that the giant lollipops were containers and not in fact lollipops themselves.



View 1



View 2

Fiesta filed an appeal against the judgment, which was subsequently upheld by the Court of Appeal of Alicante, therefore revoking the first instance ruling, declaring the partial nullity of the RCD and finding that the remaining views had not been infringed.

Perfetti brought the case to the Supreme Court requesting a judicial review. The procedural statements of the appeal were all flatly rejected by the Supreme Court, declaring that the contested decision did not lack consistency or contain defective reasoning.

The Supreme Court referred in the first instance to the question of specific products to which the designs were applied, stating that normally there is an inverse relationship between the overall appearance of two designs and the similarity to the nature of the products to which they are applied.

In the case at stake, the Supreme Court found that despite being different, the products belonged to the same industry sector and consequently the relevant informed user would be the usual buyer or consumer of such sweets and other directly related accessories.

The Supreme Court therefore confirmed the invalidity of views 1 and 2 of the RCD, as they were reproductions of the usual products to which the RCD is applied and created the same overall impression to the informed user.



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In connection with the valid RCD views 3 and 4, the Supreme Court upheld the finding of non-infringement by the Court of Appeal, stating that in comparison to trade marks, the average consumer perceives the sign as a whole, without paying attention to details, whereas the informed user observes the product which reproduces the design more carefully due to his/her personal experience or deep knowledge.

### Conclusion

Consequently, the Supreme Court confirmed the findings of the Court of Appeal in the sense that the analysis between designs should be focused on the elements which are different from the general shape of lollipops, and determined that there were enough differences between the RCD and Fiesta's design to create a different overall impression.



View 3



View 4



# Surface decoration, line drawings and CADs in Community design registrations - a review



By Ewan Grist

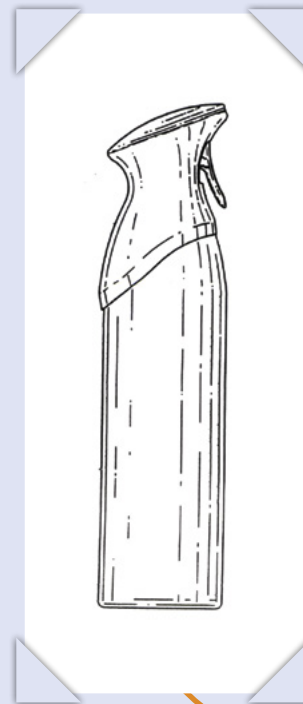
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One of the issues which has arisen repeatedly in English design cases in recent years, but still remains unsettled, is how the presence of colour(s), shading, patterns and even logos (i.e. surface decoration) on either the design registration or indeed the allegedly infringing design itself should be treated when assessing infringement and how such surface decoration should be represented in design registrations.

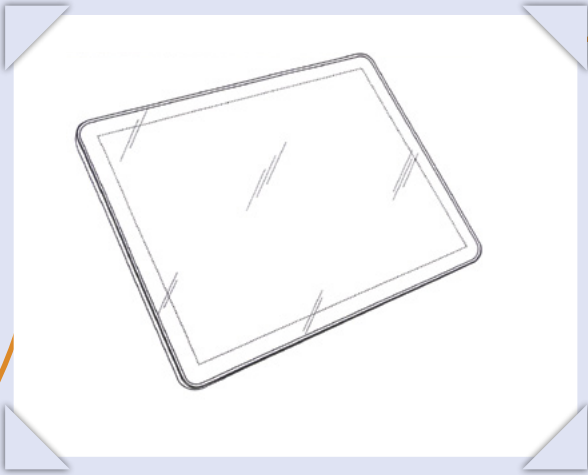
One of the first cases to have addressed the issue of surface decoration was *Procter & Gamble*<sup>1</sup>. In this case, the registered design was for a spray canister depicted as a series of black and white line drawings (one of which is pictured on the right), rather than by way of a depiction of the claimant's actual air freshener product (complete with labels, logos, etc). It was accepted by the court that, by filing the design as a black and white line drawing, colour did not form any part of the protected design, which was limited to the shape of the canister alone.

The key question was whether the infringement comparison should be (i) between the registered design and the design of the defendant's actual product (i.e. complete with its surface decoration); or (ii) between the registered design and the design of the defendant's product shorn of such surface decoration. The court held that the latter comparison was correct: where the design registration simply depicts the shape of the product (i.e. without any surface decoration or colour), it should be compared with the defendant's design stripped of any surface decoration.



<sup>1</sup> *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936





*“There are distinct advantages to both line drawings and CAD drawings as means for rendering designs for registration and both should continue to be considered as potentially useful tools in the creation of an effective registered design portfolio.”*

A slightly different issue faced the court in *Apple*<sup>2</sup> however. Here again the registered design was a black and white line drawing of a tablet, a representation of which is shown above. When characterising its design, Apple contended that a feature of it was *“a flat transparent surface without any ornamentation...”*

One question with which the court had to grapple was the effect of the presence of the Samsung logo which was prominently positioned on one surface of Samsung’s tablet design. Ordinarily, one might expect the presence of a logo on an infringing design to be disregarded from the assessment of overall impression, on the basis that the informed user would be well used to seeing logos on products and discount them accordingly. The Court of Appeal however took the view that because the *lack* of ornamentation was a key feature of Apple’s registered design, the fact that Samsung’s design prominently featured ornamentation had to be regarded as a point of difference between the respective designs. It did not matter that the ornamentation in question happened to be a logo. This might therefore be regarded as a modification of the *Procter & Gamble* principle: in certain (arguably very specific) circumstances, surface decoration present on an allegedly infringing design can be taken into account even when surface decoration did not form part of the registered design.



<sup>2</sup> Samsung Electronics (UK) Ltd v Apple Inc [2012] EWCA Civ 1339

Most recently, the issue of surface decoration arose in the *Trunki* case<sup>3</sup>. Magmatic's registered design was for a child's ride-on suitcase in the shape of a horned animal and was depicted using by a series of CAD drawings, one of which is shown below.

The defendant's (PMS) designs were also for a child's ride on suitcases in the shape of various animals and featured prominent surface decoration, such as the stripes and whiskers found on the tiger design below:

At first instance, the High Court took the view (following the principle set out in *Procter & Gamble*) that the correct comparison was between the registered design, which protected the shape of the product only, and the PMS' design shorn of all of its surface decoration. On this basis, the court held that the designs created the same overall impression and Magmatic's design was infringed.

The Court of Appeal found that the High Court judge had erred in two important respects. Firstly, the judge was wrong to disregard altogether the surface decoration of PMS' design.

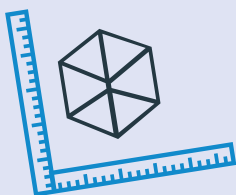
The Court of Appeal felt that the surface decoration in the form of, for example, the stripes and whiskers significantly affected how the shape struck the eye and so contributed to the overall impression created by it, which was in this instance a tiger and plainly not a horned animal (being the impression created by Magmatic's registered design).

Secondly, the judge erred by failing to appreciate that there were aspects of surface decoration in Magmatic's registered design, even though it was monochrome and so not limited to any particular colours. The Court of Appeal noted that there was a distinct contrast in the shading used, for instance, between the wheels and the body of the case, which represented an (unspecified) colour contrast between these components. As PMS' design did not have such a colour contrast, this was a point of distinction between the respective designs which the judge had failed to take into account.

Based on these oversights, the Court of Appeal considered it free to form its own opinion and found that the designs did not create the same overall impression, overturning the judge's finding of infringement.



<sup>3</sup> Magmatic Ltd v PMS International Ltd [2014] EWCA Civ 181



This decision has sparked significant disappointment in the design community for two reasons. Firstly, after a series of high profile findings of non-infringement (*Procter & Gamble*, *Dyson*<sup>4</sup>, *Apple*), the first instance decision in *Trunki* was warmly welcomed by design owners who had understandably (although probably unfairly) started to regard the English courts as being anti-design. Secondly, it was widely accepted that the *Trunki* design was revolutionary in its field and had proven to be hugely successful, leaving some to wonder how the English courts could green light what many perceived to be a blatant copycat product.

### Doubt raised over the use of CAD

The decision has also led to some commentary on strength of registered designs depicted using CAD drawings. It has long been accepted that if a designer wishes to protect their design against copycat products of any colour, the best approach (barring registering the design in each colour separately) is to register the design either as a black & white line drawing, or increasingly more commonly, as a monochrome CAD drawing. It has been suggested that the Court of Appeal's decision in *Trunki* casts doubt on the use of CAD drawings for this purpose and that designers should instead revert to the use of simple line drawings which offer a broader scope of protection. This has obviously led to significant concern amongst design owners who have historically used CADs.

Arguably, this warning against the use of CAD drawings in registered design filings is premature until the courts give clearer guidance on the issue. The Court of Appeal in *Trunki* was not criticising the use of CAD drawings *per se*. Rather, it was simply saying that the specific CAD drawings which happened to have been used in Magmatic's registered design

showed a prominent (unspecified) colour distinction between various components. Had Magmatic avoided this colour distinction, as it could easily have done, then the point would not have arisen and the Court of Appeal may possibly have found in its favour.

It therefore remains the case that CAD drawings can offer some real advantages over line drawings. It is for instance often difficult to accurately and unambiguously depict design features such as curvature, gradient or light reflection using simple line drawings. It is also much easier to add crucial detail using CADs and CADs are by their very nature easily manipulated so that designs can be shown in the best possible way.

It is also worth treating the proposition that 'the broader the design, the better' with some caution. Notwithstanding the fact that the broader the registration the more likely it is to be invalid, the 'best' design registration is the one that is most likely to be found infringed by a competitor's design which may not necessarily be the 'broadest' one. For instance, a simple black and white line drawing, with its limited detail, will likely be 'broader' than the counterpart CAD drawing, but this will not be advantageous to the design owner if the necessary similarity to support a finding of infringement in fact resided in the very detailing which was missing from the line drawing.

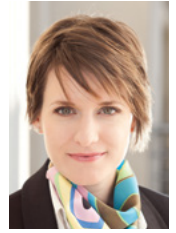
### Conclusion

There are distinct advantages to both line drawings and CAD drawings as means for rendering designs for registration and both should continue to be considered as potentially useful tools in the creation of an effective registered design portfolio.

<sup>4</sup> *Dyson Ltd v Vax Ltd* [2011] EWCA Civ 1206

# Incubation program for Hungarian designer start-ups

The Consultation Program, which kicked off in May 2014, is a significant step forward in the financial and business development of the Hungarian design industry.



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Design Terminal, a Hungarian state agency responsible for the stimulation of the creative industries, is playing a refreshing and diverse role by committing itself to changing the perception of design, fashion and architecture as businesses among the young and talented, and has started an open Consultation as well as a scholarship-based Mentoring Program.

## State agency for design

Design Terminal was founded in January 2014 specifically with the aim of utilising the inherent possibilities of the sector as part of the growth strategy of the European Union and its new program, “Creative Europe”.

The fields of activities - innovative technologies, industrial design, fashion industry and urban planning - are chosen according to 3 criteria:

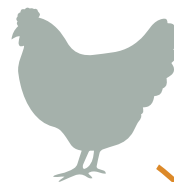
- to encourage the sectors in which Hungary has significant industry tradition and indisputable authenticity;
- to possess demonstrable contemporary potential, i.e. a significant amount of new talent; and
- to be effective in fields which can positively change the country's perception.

The agency has already helped many local design entrepreneurs, such as IVANKA [<http://ivanka.hu/>] in finding the necessary connections, funds or publicity for their projects to take off, and organised many professional events and exhibitions, such as the Central European Fashion Designer Competition (“Gombold újra!”), the annual meeting of the Google Lunar XPRIZE and the Budapest 3D Printing Days.

## Consultation and mentoring program

The monthly Consultation Program was launched in spring 2014, with the aim of giving practical high-level advice to local designers on how to handle the communication, brand management, finance, investment and legal decisions that they will face.

Following the Consultation, the participation in a Mentoring Program will be provided to those Hungarian small enterprises whose products can potentially conquer international markets. The purpose of the 3-6 month program is to help designers to create a strategy, conduct negotiations and market their work. Bird & Bird's team in Budapest is proud to be on the advisory panel for this programme.



# Review of Registered Designs Regime in Singapore



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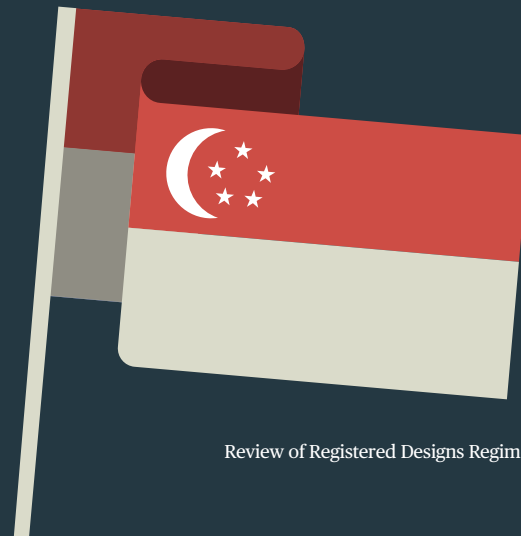
As part of the IP Hub Master Plan adopted by the Singapore Government in April 2013, which sets out a 10-year master plan for Singapore to become the global IP hub in Asia, the Intellectual Property Office of Singapore (IPOS) is reviewing its registered design regime and has recently (from 16 May 2014 to 6 June 2014) conducted a public consultation on possible changes.

The objective of the review is to develop a design regime that is “relevant to stakeholders, that supports and encourages the growth of designs-related industries, and that is able to deal with the advent of new technologies and business models”.

Some notable issues raised for consultation are:

- Whether the definition of “design” (*viz.*, “features of shape, configuration, pattern or ornament applied to an article by any industrial process”) should be widened to include other types of designs - e.g. dynamic Graphical User Interfaces (GUIs), arrangement or interior layout of rooms or storefronts, and designs meant to be applied to all types of articles, such as computer-generated graphics. All the 3 types of designs are included in the current (Tenth) edition of the Locarno Classification. In Singapore, however, the operative edition of the Locarno Classification is the Seventh edition.
- Whether an unregistered design right should be introduced to provide automatic, free protection for designs.
- Whether substantive examination should be introduced for design applications. At present, there is only a formalities examination and a design will be accepted for registration as long as the formality requirements are complied with.
- Whether a grace period should be provided to allow the design owner to publicly disclose his design prior to filing.
- Whether dual protection under the Copyright Act and the Registered Designs Act should be allowed. Currently, the provisions in the Copyright Act operate such that copyright protection is excluded or limited if the design corresponding to an artistic work is registered or registrable pursuant to the Registered Designs Act.
- Whether any changes should be made to the registered designs regime to take into account the emergence of 3D printing.

We will report on any updates in future editions of DesignWrites



# The role of aesthetic elements in slavish imitations

On 3 February 2014, the Court of Appeal of Milan, overturning the first instance decision, found that Bratz dolls had been slavishly imitated by the “PopStyle” dolls, reproducing the same aesthetic features that were found on the original toys, including the unusual aggressive facial expression.



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## Judgment

By analysing the shape of the respective products, the Court of Appeal held that:

- The marketing of a doll having the same characterising features of a doll manufactured and distributed by a competitor constitutes an act of unfair competition for slavish imitation if the ensemble of the characteristics (e.g. the proportion of head and body, the accentuation of certain facial, the prominent make-up, etc) are such as to provide the appearance of a doll with a distinctive and unusual aggressive appearance, which appreciably differs from those of other dolls on the market;
- The above assessment does not change, even if the claimant’s product is provided with some elements that were already available on the market, since “*the distinctive and unusual aggressive profile of the Bratz doll substantially differs from both the typology of dolls targeted at younger children - characterised by an appearance designed to inspire tenderness and protection - and those loved by older girls that offer a kind of proportioned doll, with pleasing traits as a representation of a model of a successful girl, ideal beauty and seduction*”;
- The claimant is required to indicate what constitutes the characterising features of its product which have been imitated by the defendant’s product. This burden is discharged even if the characterising and distinctive capacity is provided by aesthetic features only.

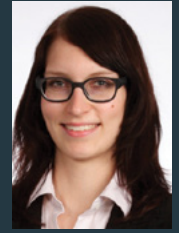
## Comment

By drawing the Bratz v PopStyle battle to a close, the Court of Appeal stressed that, for the kind of products at issue, it is almost impossible to imagine “*unessential and fanciful features*” (which are therefore characterising) “*with no aesthetic connotation*”. Therefore, to the extent that the prohibition against slavish imitation concerns the unessential (i.e. not functional) and fanciful features, for doll products, the assessment of slavish imitation will inevitably require an aesthetic approach. Otherwise an entire category of products would remain unprotected.



# The new Intellectual Property Court of Finland

A new centralised intellectual property (IP) court (the “Market Court”) was established in Finland in September 2013, which could prove to be a useful forum for design cases.



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Following the reform, the Market Court now has exclusive jurisdiction to hear all IP cases at the first instance with the exception that IP cases which involve criminal proceedings will remain within the remit of the District Courts. Since its establishment, the Market Court has heard various types of cases, including appeals related to trade mark and patent applications, interim injunction application for alleged patent infringement, copyright and unfair trade practices claims.

## Case law worth watching

New case law of the Market Court will be of particular importance for two reasons:

- 1) The court houses specialised IP judges who have particular interest and experience in IP law; and
- 2) The decisions of this new IP court will in many cases remain final because in most instances an appeal is possible only in circumstances where the Finnish Supreme Court grants a leave to appeal. Leave to appeal has traditionally been granted in around 10% of the cases, and only for those deemed to have precedential value.

## A smooth(i)er future?

The new system enables the claimant to combine different types of claims more efficiently than was previously the case. For example, a single claim may include elements of a design infringement, trade mark infringement and unfair trade practices, which can all now be heard under one roof. As a result, the centralised IP court may be especially useful in cases which relate to products whose appearance plays a significant role in attracting consumers.

Last year, just before its reform, the Market Court issued a decision in a case relating to smoothies<sup>1</sup>. The claim was pursued on the basis of unfair trade practices and concerned the packaging of smoothies marketed

under the brands “Froosh” (the claimant’s product, below left) and “Mehuiza” (the defendant’s product, below right), respectively. The Market Court did not issue an injunction on the basis of unfair trade practices.

As you can see from the pictures, there are several marked similarities between the two types of products in terms of both bottle design and labelling. Had this case been heard following the reform of the court (and the resultant ability to combine several different types of IP claims into one action), the outcome may well have been different and an injunction granted.



1. MAO:198/13, decision date 7 May 2013

# Important changes to UK design law

A number of changes to design law in the UK will come into force on 1 October 2014. These changes are being introduced by the Intellectual Property Act 2014 and are largely intended to implement a number of the recommendations arising from the wide ranging Hargreaves Review of Intellectual Property which took place in 2011. We outline some of the key changes below.



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## New criminal offence for intentional copying of registered designs

Until now, criminal offences for intellectual property infringement have been restricted to copyright and trade marks in the UK. One of the most significant changes in the Act is the introduction of a criminal offence for the intentional copying of a UK or Community registered design in the course of a business. A person will commit an offence if they intentionally copy a registered design without the consent of the registered owner of the design, so as to make a product exactly to that design, or with features that differ only in immaterial details from that design. The person must know, or have reason to believe, that the design is a registered design. It will also be an offence to deal with such a product. The penalty will be a fine and/or up to 10 years' imprisonment.

This new offence clearly has potentially very significant ramifications for businesses and designers alike. However, there is a defence which is likely to be of great practical significance: it is a defence if a person charged with the new offence can show that they reasonably believed that the registration of the design was invalid, or that it was not infringed.

## Recommendations

We therefore recommend that businesses/designers seeking to launch a product which they believe might infringe a registered design should first obtain a lawyer's written opinion on infringement and/or validity which can be cited as evidence (should it ever be needed) that the business/designer reasonably believed that design was invalid and/or not infringed.

## Ownership of commissioned UK registered or unregistered designs

Under the current law, any commissioned UK registered or unregistered designs are owned by the commissioner and not the designer. This differs from the current position in copyright law and Community design law, where commissioned works are first owned by the author/designer. Under the Act, UK registered or unregistered designs in commissioned works will now be owned by the designer, unless specified otherwise in commission contract. This is of significant practical importance, since businesses will have to ensure that contracts entered into after the coming into force of the Act provide for a transfer of ownership from designers to the commissioner, if that is desired.

## UK Unregistered Design

There have been a number of changes to the law of UK unregistered design, which include the following:

- UK unregistered design rights currently protect the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article. Under the Act, the words "any aspect of" are to be deleted. The intention behind this change is to prevent the 'cropping' of the asserted design to just those small or trivial parts that may have been replicated in the allegedly infringing design.





- Furthermore, it is a requirement for protection that unregistered designs are ‘original’, that is not commonplace. The Act has amended the definition of ‘commonplace’, clarifying that a design must not have been commonplace in a particular geographical area, namely the UK, EU and certain additional countries with reciprocal agreements with the UK.
- The Act also introduces new defences to unregistered design right infringement equivalent to those found in the law of registered UK and Community designs; namely defences which allow use of a design in relation to activities which are for non-commercial private purposes, experimental purposes, teaching and citation purposes, and using equipment on non-UK registered ships or planes which are temporarily in the UK.

#### Prior use of UK registered designs

The Act has introduced some protection, similar to that available for registered Community designs, for those who start to use a UK registered design which is subsequently registered by someone else. The Act will allow the person who started to use the design (or made serious and effective preparations to do so) to continue to use that design without infringing the later registered design, as long as the first design is only used for the same original purpose and was not copied from the subsequently registered design.

*“One of the most significant changes in the Act is the introduction of a criminal offence for the intentional copying of a UK or Community registered design in the course of a business.”*

#### Looking further - future amendments

Currently, designs registered under the Hague System for the International Registration of Industrial Designs can only obtain protection in the UK if they opt for EU wide coverage. The Act paves the way for the UK to join the Hague System in its own right, so applicants will be able to save on filing fees if there is no need to obtain EU wide coverage. The UK IPO has stated that this is unlikely to take place before the end of 2015.

The UK IPO also intends to introduce a designs opinions service, which will provide non-binding opinions on questions of design law. The scope of this advice service has not yet been finalised, however it is very likely to include opinions on infringement of registered designs. The UK IPO intends to introduce this service in 2015.



#### Comment

The Act is not a wholesale reform of design law in the UK but will introduce a number of notable changes and refinements. Several of these changes are likely to be of significant practical importance to businesses and designers. In particular, the new criminal offence of intentional copying of registered designs increases the importance for businesses of obtaining a legal opinion if the business has reason to suspect that they may be infringing a registered design.

# Working with ACID - A passion for design



The Bird & Bird IP team in London are delighted to have been appointed as a Legal Affiliate of ACID (Anti Copying in Design), a further sign of our commitment to supporting the design industry.

## About ACID

ACID is a trade association created in 1996 for designers and manufacturers, with a core aim of upholding the value of original design. ACID actively encourages design talent and seeks to develop a safer trade environment for designers in the UK. They share our passion of raising IP awareness and enabling commercialisation by connecting designers with IP experts and other business support specialists through their Affiliate Partners programme.



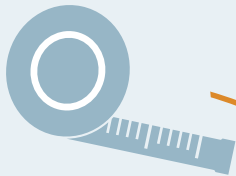
For more information or to attend one of ACID's events, please visit [www.acid.uk.com](http://www.acid.uk.com)

## About our design practice

Bird & Bird has a long-standing reputation in the field of IP and, with our passion for design law, we are ideally placed to help designers to protect, commercialise and enforce their valuable designs. We have acted for some of the most prominent names in the design world but we also act for many small design companies and individual designers as well. Our work has helped protect designs in a huge variety of areas including fashion, digital media, furniture and consumer electronics.

We have a long and successful history of representing clients in court proceedings involving both Community designs and national rights. With leading design lawyers in each of our offices, we can advise clients on their designs internationally to provide a coordinated and effective protection and enforcement strategy.

Our relationship with ACID is another addition to the numerous design activities in which the group are involved, including sponsoring the London Design Museum and keeping designers up to speed with the latest developments in the design world through this publication.





# Design Museum: what's on

The Design Museum's new exhibition celebrates the work of Louis Kahn - the great American architect who is hugely respected within the architectural community but little known outside of it.

Kahn (1901-1974) was a visionary architect, an expert manipulator of form and light, a creator of uniquely dramatic buildings, and a highly complex individual. Described in his New York Times obituary as having been one of America's foremost living architects, he nonetheless realised few buildings in his lifetime and died practically bankrupt.

Coming of age in the era of modernism, Kahn drew on a wide range of sources, from ancient ruins to the work of Le Corbusier. He used innovations in construction techniques to design modern buildings that also project an elemental, primitive power. He was a perfectionist and an artist, who also believed that architects have an important social responsibility.

In this time of 'stararchitects' and relentless globalisation, Kahn's reputation is being redefined - his search for an architecture that grows out of a sense of place seems more important than ever.

Kahn was an influence on many architects who came after him - the Design Museum exhibition features interviews with Frank Gehry, Renzo Piano, Peter Zumthor and Sou Fujimoto amongst others. Also on show are architectural models, original drawings, travel sketches, photographs and films.

Kahn's greatest masterpieces all take the form of inspiring institutions: The Salk Institute in La Jolla, California, designed to be 'a facility worthy of a visit by Picasso'; the Kimbell Art Museum in Fort Worth, Texas - a showcase for Kahn's extraordinary ability to work with light; and the National Assembly Building in Dhaka, Bangladesh - testament to the incredible impact of his monumental style. Each project is fully represented in the exhibition, which aims to bring one of the twentieth century's greatest master builders to a new audience.



Louis Kahn: The Power of Architecture is on show at the Design Museum until 12 October 2014.



Yale University Art Gallery, New Haven, Connecticut, Louis Kahn, 1951-53 © Elizabeth Felicella

# Upcoming industry events and awards

## Domaine de Boisbuchet

22 June - 13 September 2014  
Boisbuchet, France

This event sees architects and designers coming together to host interactive workshops for professionals and students with a keen interest in the creative process of design.

[www.boisbuchet.org/workshops](http://www.boisbuchet.org/workshops)



## Bird & Bird and The Printable World

18 September 2014

Bird & Bird offices, London, UK

Join us for an evening of discussion on the important IP and IT legal issues raised by the revolution of 3D printing. Take a peek at 3D printing in action and see the potential of the 3D platform through our exhibitors, who will be showcasing a variety of different products and designs throughout the evening.

[www.twobirds.com/en/events/uk/2014/the-printable-world](http://www.twobirds.com/en/events/uk/2014/the-printable-world)

## Design Miami

3 - 7 December 2014  
Miami, USA

The USA's largest design event featuring talks, exhibitions and parties.

[www.designmiami.com](http://www.designmiami.com)

## London Design Festival

13 - 21 September 2014  
London, UK

London Design Festival is a celebration of all things design. The events take place over nine days in up to 300 venues throughout the city.  
[www.londondesignfestival.com](http://www.londondesignfestival.com)

## SBID International Design Awards

14 November 2014  
London, UK

Recognising design excellence in a range of categories, the International Design Awards is an established event in the design industry.  
[www.internationaldesignexcellenceawards.com](http://www.internationaldesignexcellenceawards.com)

## China International Industrial Design Fair

29 November - 2 December 2014  
Shenzhen, China

A design trade exhibition covering various topics such as the future of design, branding, strategy and new materials.  
[www.ciidf.com](http://www.ciidf.com)

## World Architecture Festival

1 - 3 October 2014  
Singapore

Recognising global architectural excellence in 2014, the festival's shortlist includes architects in over 40 countries, covering 30 categories.  
[www.worldarchitecturefestival.com](http://www.worldarchitecturefestival.com)

## 7<sup>th</sup> SA Innovation Summit

17 - 18 September 2014  
Cape Town, South Africa

This year, the South Africa Innovation Summit's theme encompasses "Local Innovation, Global Conversation". The event showcases South Africa's wealth of originality, innovation and creativity in design.  
[www.innovationsummit.co.za](http://www.innovationsummit.co.za)

## Downtown Design Dubai

28 - 31 October 2014  
Dubai, UAE

Downtown Design is an international design fair showcasing the most iconic and ground-breaking design brands.  
[www.downtowndesign.com](http://www.downtowndesign.com)

## Melbourne Indesign

22 - 23 August 2014  
Melbourne, Australia

Indesign: The Event is an annual event in the Asia Pacific. Over the past 11 years, the event has brought together international and regional creative figures from the architecture and design industry.  
[www.melbourneindesign.com.au](http://www.melbourneindesign.com.au)

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