

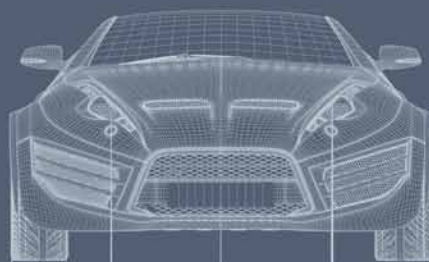
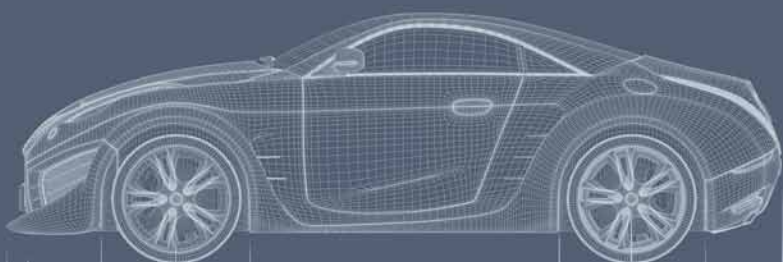
IP Review

Summer 2014



Success by design

Great design can make all the difference -
protecting it can secure your advantage.



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Registered designs

The forgotten tool for technology companies?

The UK Intellectual Property Office recently conducted a survey into the awareness and use of registered designs. The report stated that “There was a very strong feeling amongst all respondents that the design of the product does help to differentiate against competitors. So, design registrations can affect commercial success. However, despite this perceived importance of design to competition, relatively few firms (41%) own a registered design. In technology-based firms, registration is especially low (11%).”

Amongst technology companies, the most common reason given for not registering the design of a new product was that ‘they had not considered it’. Therefore, many companies are missing out on a valuable form of protection for their new products.

When a new product is developed, technology companies will often file patent applications to protect the inventive aspects of the new product, and rightly so. Patents provide broad protection as they generally cover the concept behind a product rather than the product itself. This means they can be used to stop a competitor from developing a competing product even if it is not exactly the same as the patented product.

Technology companies will also often use trade marks to build up a brand associated with their product and company. This can help to maintain or increase their market share as the company and its products build up a reputation. This can also help to deter other parties from trying to enter the market.

However, it is also possible to protect the appearance of a new product by registering the design of the product. For example, a design can be registered so that it is protected in the UK or even across the whole of the EU by a single application. Design applications are relatively inexpensive, particularly when compared to patents. In the UK and EU, multiple different designs can be included in the same application which makes design protection even more cost effective.

One well known UK based technology company that bucks the trend and actively protects its designs is Dyson. Dyson has registered well over 100 different designs across Europe for vacuum cleaners, vacuum

cleaner parts and attachments, hand dryers, bladeless fans and heaters. In fact, Dyson has deliberately made the design of its products unique. This is one of the reasons why Dyson products are very recognisable, and this uniqueness has added to the value of the Dyson brand.

Neither has Dyson been afraid to enforce its registered designs. Dyson has sued both Vax and Dirt Devil for producing products which Dyson claimed infringed its registered designs.

Dyson’s experience shows that registering the design of your products can not only protect their appearance, but can also help to build the brand of a company and increase its value, which might otherwise not have been possible to the same extent.

Some technology companies rely on unregistered design rights, especially in Europe and the UK, to protect their designs. These unregistered rights are generally weaker than registered designs, as they do not last as long, and it is also necessary to prove a competitor copied the design when trying to enforce them.

In summary, registered designs are a valuable but often overlooked tool which can be used to protect the design of products. When used in conjunction with patents and trade marks, they can really add to the value of your company. Therefore, make sure you consider this option to see if it can benefit you.

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Are designs simple?

You be the judge

The UK courts have repeatedly stated that “it should be possible to decide a registered design case in a few hours”, and that there are only three important things - the design, the prior art and the alleged infringement. For this IP Review, we thought we would have some fun with this, and give you the chance to don the judge’s robe...



On the following page are the details of three recent cases which have been heard in the UK courts. You will be given three sets of pictures - the design, the alleged infringement and the prior art.

You need to decide:

1. Is there an infringement? i.e. is the alleged infringement the same as the design, or if not does

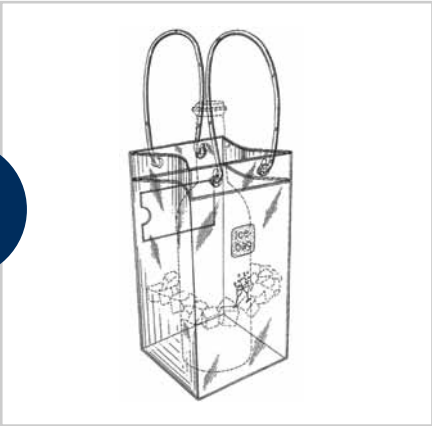
it give the same overall impression as the registered design?

2. Is the design valid? i.e. it is new and does it provide a different overall impression compared to the prior art?

To answer both questions you need to stand in the shoes of the “informed user” - in each case we’ll tell you who that is. Answers on page 15!

1

The design



The alleged infringement

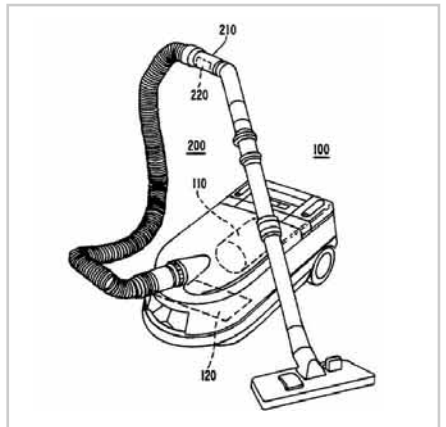


The prior art



The informed user is a user of bottle chillers, i.e. ice buckets, wine coolers and wine cooling sleeves.

2



The informed user is a knowledgeable user of domestic vacuum cleaners.

3



The “informed user” is the parent, carer or relative of the child who the product is bought for.



University technology making a positive impact

or: Why universities should file patent applications

The question of whether universities should protect their IP is one that can lead to heated debate.

The research activities of the majority of European universities are publically funded - should the results of this funding be monopolised by the Universities through the filing of patents which could prevent the public from benefiting from this research? Well, of course not. However, the question itself is wrong. Patents do not prevent the public from benefiting from publically funded research. In fact, the position is quite the opposite. This is especially obvious in the Biotech sector where the results of the academic research are generally several years and many millions of pounds away from being sufficiently developed to actively benefit the public. The work and investment required

to get the research from the academic lab to a clinical treatment is enormous and it's easy to appreciate why no one (with the possible exception of some charities) would embark on such an exercise without any prospect of recouping that investment. The 20 years of exclusivity provided by a patent provides a means to do this. Without this, many research concepts would simply be abandoned, and despite their promise would never be developed to the point of commercialisation.

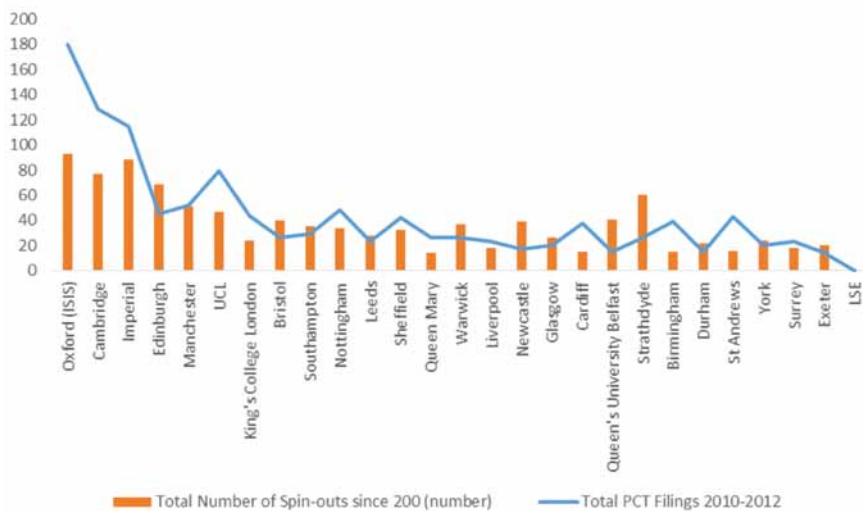
However, universities are not usually the entities doing the commercial development, so the question remains, why should universities

file patent applications? In fact, there are many reasons, not least of which is the increasing importance of "impact" in the assessment and award of grant funding - it is now widely accepted that investment will be prioritised where research funds have the most impact. So, what is "impact"?

Impact has been defined by the Research Excellence Framework as:

"An effect on, change or benefit to the economy, society, culture, public policy or services, health, the environment or quality of life, beyond academia [...] the demonstrable

No. Spin-outs since 2000 vs. No. PCT filings 2010-2012



contribution that excellent research makes to society and the economy".

Which is all well and good, but not very easy to quantify. However, there are some metric indicators that can be measured, such as job creation, granted patents and spin outs. By its very definition, the subject matter of a patent must be new and inventive, so where a patent filing results from research it can be an indicator of the elusive "excellent research", which will lead to high quality impact.

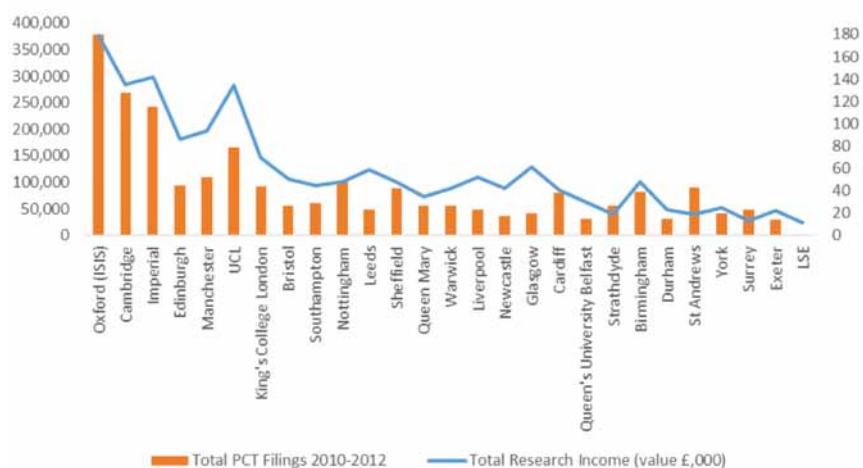
The Withers & Rogers Higher Education Specialist Practice Group analysed the IP activities of some of the top UK universities in terms of total PCT filings, total number of spinouts and license agreements. Our findings are summarised in the graphs to the left.

A strong correlation can be seen between research income and numbers of patent filings. The universities with the most funding are most likely to be able to provide the "excellent research" that leads to patent filings. The patents granted from these filings provide a metric for high quality impact help to ensure that future grant applications will be successful. There is also, perhaps unsurprisingly, a correlation between PCT filings and successful commercialisation of IP in terms of spin outs (another metric for assessing impact) and IP transaction agreements.

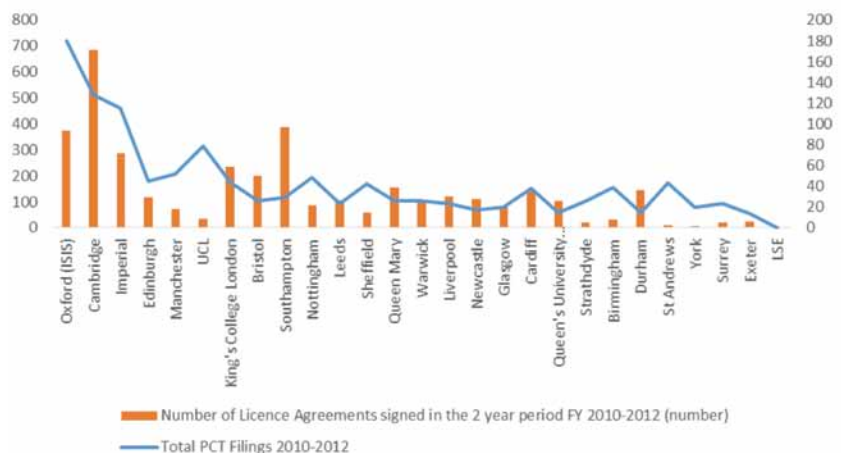
It is therefore clear that the Universities who are filing patent applications are also those with the best record at obtaining grant funding, and the greatest impact.

For those not in academia, it is useful to know that universities have unprecedented access to world experts working in almost any technical field one cares to name and they are actively developing extensive patent portfolios around their research. Development and commercialisation of these portfolios is generally handled by dedicated Technology Transfer Offices, employing experienced business managers, who handle commercialisation of this IP. Companies should be looking to these Technology Transfer Offices almost as "IP Supermarkets", where they can access and benefit from this research. In this way, universities can pass the baton, ensuring that their research efforts are developed into real world products, in return for allowing the corporate world to build on this world class academic research.

Research Income 2007/2008 vs. Number of PCT Filings 2010-2012



No. Licence Agreements FY2010-2012 vs. No. PCT Filings 2010-2012



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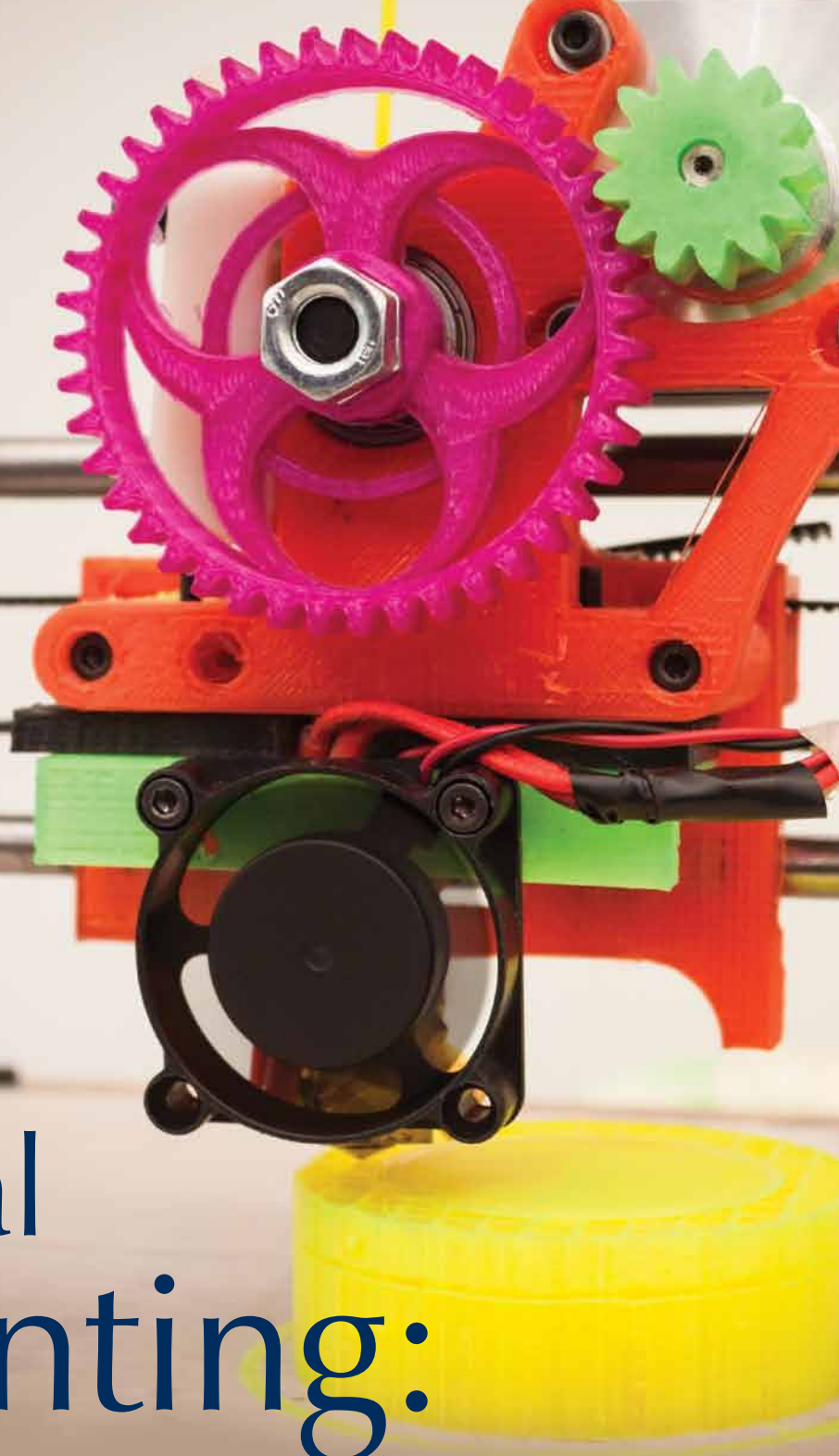
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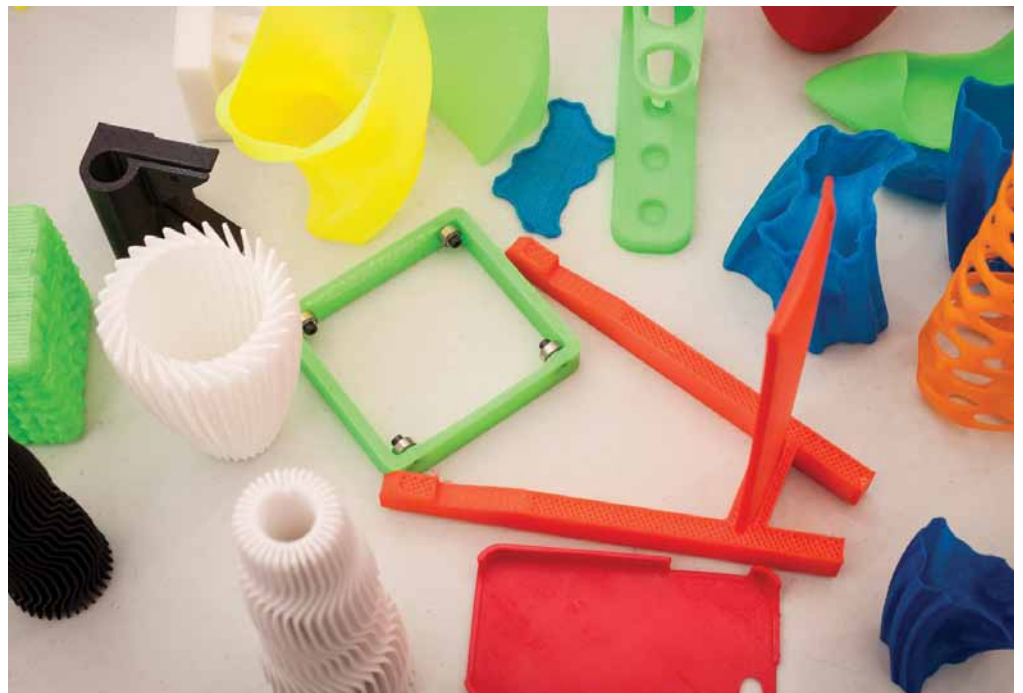




Personal 3D printing:

How can design owners protect themselves?

In recent years there has been much talk in both the media and the courts about the issue of illegal sharing of digital content such as music, film and video games. The owners of this content have been concerned about the infringement of their copyright, and have instigated an internet-wide crackdown on the file sharing sites, such as the infamous Pirate Bay, used to disseminate these infringing files, and prolific users of these sites. But what about industrial designs (i.e. designs intended for industrial exploitation), which, like music, film and video games, are capable of being represented digitally and distributed online?



It has never been easier to share computer aided design (CAD) files over the internet. There are now sharing sites, such as Thingiverse (www.thingiverse.com), specialising in the dissemination of such files. Moreover, there have never been more people with access to so-called 3D printers capable of reproducing the product encapsulated in a CAD file by additive layer manufacturing. With this technique, successive layers of a material (most commonly a plastic, though the technology is developing for metals) are generated until the product is complete. This combination of easy file sharing and access to personal manufacturing technology represents a potential future headache for owners of industrial designs.

To illustrate the problem, imagine that your company designs, manufactures and sells door handles in the UK. Now imagine that somebody makes a CAD file representing one of your products and uploads it to a file sharing website, from which anyone can download the CAD file and use a 3D printer to manufacture the product. You might not be too concerned if one or two individuals use the design to print replacement door handles for their own homes. You'd be more upset if someone started printing your handles and selling them to others, taking business away from you in the process. You need to find some way to stop this activity to protect your business.

So, how can the law help? The answer is unclear at the moment, as the current legal framework was not set up with this issue in mind, and the UK courts have not yet had a chance to consider it. However, there is certainly action that owners of commercially valuable industrial designs can take now in order to best protect themselves.

What legal rights do I have?

The legal situation for industrial designs is rather less clear cut than it is for other content such as music,

films or video games, which are all protectable by copyright. While a CAD file will be protected by copyright against direct copying, what if someone else creates their own CAD file which describes your design? In general terms, copyright is reserved for purely aesthetic or literary creations, and so generally does not protect industrial designs, which tend to have functional characteristics as well as aesthetic ones. The intention is that such industrial designs are protected in the UK and/or Europe by specific design protection in the form of Registered Designs and Unregistered Designs. However, while copyright legislation and case law has moved with the times to protect against internet piracy, the same cannot be said for design legislation.

Despite this lack of progress, design protection should provide its holders with the means to prevent unauthorised use of their designs.

Registered Designs

Probably the strongest right available to the owner of a new industrial design is a registered design, which will provide a monopoly for the shape and appearance of that design. A registered design covering the EU, called a Registered Community Design (RCD), can be obtained by applying to the Office for Harmonisation in the Internal Market (OHIM). Your patent or trade mark attorney can handle this on your behalf.

It is worth noting that many products that have potential for 3D printing will not be protectable by an RCD. To balance the need for protection of OEM designs with the requirement for a competitive market for spare parts, EU design legislation excludes from protection certain types of design. The exceptions relate generally to design features that are purely technical in nature (the "technical function" exclusion) and design features that are required in order to allow a product to fit together correctly with another product (the "must fit exclusion"). Also excluded are designs applied

to components of a complex product that are not visible during normal use. Many spare parts are likely to be non-visible components of a complex product or fall under the “technical function” or “must fit” exemptions. The latter also applies to the shape of accessories and customisation items such as covers for mobile phones (but not to copyright artwork decorating them). Furthermore, even if a spare part escapes these exclusions and is protected as a registered design, such protection is not infringed by its use for the repair of a complex product so as to restore its original appearance. This would cover the 3D printing of a part such as a car wing panel that was normally visible and not totally constrained in design by its function or fit, but which had to be replicated in order to maintain the vehicle’s original appearance.

For those designs that are not excluded from protection, an RCD provides its owner with the exclusive right to use the registered design and to prevent any third party not having his consent from using it for up to 25 years. However, an RCD owner is specifically excluded from preventing activity carried out privately and for non-commercial purposes.

So, in the scenario discussed in the introduction above, when a CAD file representing a design for a door handle that is protected by an RCD is shared via the internet and then used to generate a 3D representation of that design using a 3D printer, who is infringing your rights as the owner of the RCD? The person who uploaded the CAD file? The host of the file sharing site? The person who downloaded the file and then used it to manufacture a replacement handle for their home? The person who downloaded the file and started selling 3D prints of your product?

The CAD file uploader is probably an infringer, assuming that they acted without your permission. It is unlikely that they would be able to claim that the upload was an act “done privately and for non-commercial purposes”, since its purpose was to permit widespread access to the design and thus was not “private”. An interesting question concerns whether the act of uploading comprises “use” of the design within the meaning of the legislation; specific examples of such “use” given in the legislation include acts done in relation to “a product in which the design is incorporated”. In time the courts will have to decide whether a CAD file is such a “product”, or whether dissemination of a CAD file constitutes a “use” outside of the listed specific examples. Either way, it seems unlikely that a UK court would refuse to consider upload of a CAD file to a file sharing site as an infringing “use” of the RCD.

If the uploader is an infringer then the file sharing site is probably infringing also, perhaps unwittingly. Parallels can be drawn with copyright cases concerning the illegal sharing of music, film and video game files, where the file sharing site itself has been found liable.

The question of whether the final end-user in this process – the CAD file downloader who printed the design using a 3D printer – is an

infringer is probably the most interesting. In the case of the individual who has downloaded the file and manufactured the product for their own personal use, there is no infringement because of the exemption for such private and non-commercial acts. This is why it is so important for the owner of an RCD to be able to target the file uploader and file sharing site as infringers. If, on the other hand, the downloader is selling the products they have printed or using them in the course of their trade (e.g. as a locksmith), they will not be protected by the exemption, and will be an infringer.

This analysis assumes that the various potentially infringing acts are carried out in the EU, i.e. within the jurisdiction covered by an RCD. But what if the file sharing site is hosted outside of the EU and/or the CAD file uploader is not located in the EU? Ultimately, this is a question that the courts have yet to rule on. Patent and copyright case law in this area suggests that



The question of whether the final end-user in this process – the CAD file downloader who printed the design using a 3D printer – is an infringer is probably the most interesting...

if users of the file sharing website are able to download a shared CAD file within the EU then the CAD uploader and file sharing site have carried out infringing acts within the EU.

Unregistered Designs

The protection offered by unregistered designs is largely similar to that provided by registered designs. There are important distinctions though. For example copying of the design must be proven for infringement to have taken place. Also, the duration is much shorter, at 3 years for Unregistered Community Designs (UCD) covering the EU and a maximum of 15 years for UK Design Right (UDR), which is an additional protection covering the UK only.

For UCD, the comments above in relation to a Registered Community Design (RCD) are applicable, as long as it can be shown that the infringing CAD file was itself created by copying the original design. Of course the short 3 year term of a UCD limits its usefulness.

For UK Design Right, the legal provisions are worded rather differently to those for UCDs, and their effect is likely to be somewhat different. In particular, acts which are not done “for commercial purposes” do not infringe UK Design Right; there is no requirement at

present that such non-commercial acts are done “privately” (though there is a proposal to change the law in this area to introduce a “private acts” exception). While genuine infringing commercial use will still be caught, it is possible that simply uploading a CAD file representing a copy of the protected design to a file sharing site is covered by the exclusion. In other words, if the CAD file is shared so that it is available free-of-charge, and thus with no commercial element, it may not be possible to prevent its dissemination via the file sharing site using UK Design Right. It is of course possible that a UK court would find a way to demonstrate that the hosting of the shared file is a commercial infringing act, but it is by no means certain that this is the case.

The above discussion of the available unregistered design protection in Europe and the UK serves to demonstrate why it is important to obtain registered design protection wherever possible for commercially important designs where there is a perceived risk of copying by 3D printing.

What does the future hold?

Now that the personal 3D printing revolution has taken hold, many commentators expect that the next step will be the widespread availability of 3D scanners. Such scanners are able to scan an object and create a file which can be read by a 3D printer so that it can produce an exact (or tweaked) replica of that object. This next technology revolution could be the one to reveal the holes in the existing UK legal framework. This is particularly true as all the steps in the process – copying, transferring, and manufacturing – will be carried out by the end user, who, if he is only producing the goods for his own personal use, will most likely be exempt from being sued for infringement.

Returning to our door handle example, it seems that there will effectively be no legal framework in the UK to prevent a private individual from borrowing one of your door handles, scanning it, and printing any number of copies for his own personal use. If there are sufficient numbers of such individuals, your business could soon be in trouble.

It is likely to be several years before 3D scanning technology becomes accessible to the extent that 3D printers are today, and probably also several more years – maybe decades – until personal 3D printers are able to produce a finished product of sufficiently high quality to make such scenarios a serious business threat. However, in the meantime we must make sure our legislators are aware of the potential risks to trade.

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New legislation brings opportunities and challenges in design

Design has long been a key factor in the success of companies operating in industries such as fashion and luxury goods. It is also becoming ever more important in other sectors, as manufacturers of consumer products increasingly use design as a way of differentiating their products from those of competitors in crowded marketplaces.

Against this background, it may come as a surprise that design registrations are amongst the least used of all registered Intellectual Property rights. According to an independent review carried out by Professor Ian Hargreaves and published in 2011, “design constitutes the largest contribution to overall intangible investment in the UK economy”, with investment in design alone amounting to 1.6 per cent of the UK’s Gross Domestic Product (GDP) in 2008. However, the Hargreaves Review found that only 8,000 - 9,000 designs are registered each year. The low uptake of design registration may be attributed to a lack of understanding on the part of the intended users of the design registration system, and to a complex and unwieldy framework for the protection of designs.

New legislation aimed at addressing some of these issues is expected to come into force shortly, when the Intellectual Property Bill receives royal assent. The key changes for design protection are:

- A modification of the scope of protection for unregistered designs, such that unregistered design protection will apply to the whole or part of the design of a product, rather than to “any aspect” of the design of the whole or part of the product. This change is intended to make it

easier for third parties to assess what is or could be protected by unregistered design right.

- The introduction of provisions allowing private or experimental use of designs protected by unregistered design right.

- A change to the provisions regarding ownership of unregistered design right, such that the rights in commissioned designs belong to the designer rather than the commissioner. This change will be of particular importance to organisations that outsource design work, and will require new agreements to transfer the rights in commissioned designs to the commissioning organisation.

- The introduction of criminal penalties for copying registered designs, to deter flagrant copying.

- The introduction of a Designs Opinion Service, allowing rights holders and third parties to seek a low-cost non-binding opinion on issues of design infringement from the UK Intellectual Property Office, to help to resolve design disputes.

- Easier online access to detailed information about UK registered designs.

These changes will certainly benefit independent designers and owners of registered designs, but may also impose additional burdens on organisations that rely on outsourced design services.

Despite the new legislation, question marks remain over whether existing design law can cope with the challenges presented by the rapid evolution of technologies such as 3D printing. We have considered that issue in detail elsewhere in this edition.

Withers & Rogers is well placed to help our clients to negotiate the increasingly complex area of design protection. Our Designs Specialist Practice Group has extensive experience of obtaining registered design protection around the world, and of advising on registered and unregistered design validity and infringement. If you have any questions on any of the issues discussed in this edition of IP Review, please contact your usual attorney or a member of the Designs Group (see back page for full details).

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Trade marks v designs

Which right is best for you?



For most companies, the process of developing and launching a new product involves giving consideration to developing a brand for the product and protecting that brand and its “get up” via trade mark registration. However, in some instances, securing a design registration may complement any trade mark protection that is in place, especially when it comes to enforcement.

This article sets out some of the core differences between the two rights and gives examples of where one right may be preferred to the other.

Definitions

A trade mark is defined as any “sign” which can be represented graphically and is capable of indicating the commercial entity behind the goods or services to which it has been applied. The word “sign” is particularly broad, and therefore allows companies to register trade marks which consist of words, phrases, letters, numbers, colours, graphics, sounds, smells and even three-dimensional shapes.

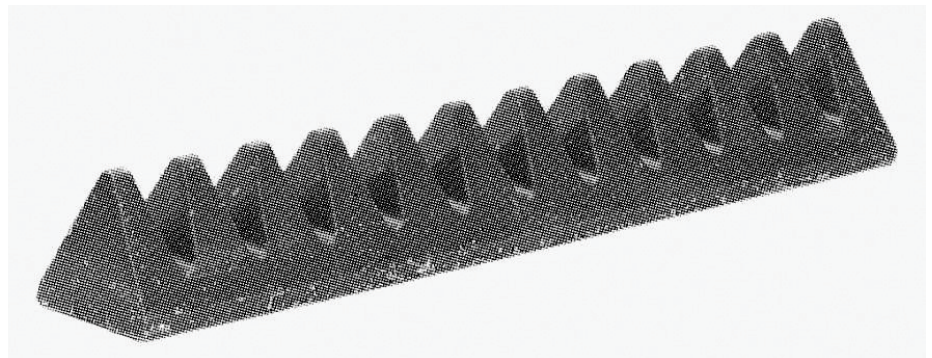
A design, on the other hand, refers to the appearance of the whole or part of a product, which can include lines, contours, colours, shape, texture and materials of the product, as well as its ornamentation. The word “product” encompasses a broad range of different things including industrial and handicraft goods, packaging, “get up”, graphic symbols and typefaces.

Whilst there is some overlap between the two rights (for example, both can protect 3D products), there are also some differences. Design registration cannot be used to protect sounds, smells or plain words/phrases, whereas trade marks would struggle to protect the overall “look” or “get up” of a product. For this reason, many companies opt for a combination of both rights to protect their products.

Taking a chocolate bar as an example, trade mark protection may be suitable for protecting the name of the product and the accompanying logo, whereas design protection may be suitable for protecting the look of the packaging or the shape of the chocolate itself.

In the case of Toblerone, the triangular shaped chocolate was registered as a 3D trade mark, shown in the column to the right, in April 1996. If the product were launched today, a design registration could also have been used to protect the shape of the chocolate bar.

Community Trade Mark Registration No. 31237.



Requirements for protection

In order for a trade mark to be capable of registration, it must not describe the product or its characteristics. 3D and shape trade marks often struggle to secure registration because they must not be typical of the shape of the goods in question, nor can they be functional or add value to the goods.

In such instances, it may be preferable to register 3D or shape trade marks as a design. However, design registrations come with their own limitations and requirements for registration.

For example, a registered design can only protect goods, as opposed to services. To be registerable, a design must be “novel” (no other identical design must exist) and must have “individual character” (it must produce a different overall impression to any other design which has been made available to the public), and an application to register the design must be filed within 12 months of the first disclosure of the design to the public. Additionally, features of a design that are solely dictated by their technical function (e.g. connecting parts that must take a certain form in order to fulfil their connecting function) and features of a design which “must fit” around or be connected to another product (e.g. spare parts for cars, such as doors or wing mirrors) are not eligible for registered design protection.

An advantage, however, of filing a registered design application over a trade mark application, is that in Europe a design application will not undergo examination, except for basic formalities. Whilst a trade mark may be refused on grounds of lack of distinctiveness or descriptiveness, a design application will not be refused, even if it does not meet the novelty and individual character requirements. This generally results in rapid registration of the design, but may result in the proprietor owning a design registration which is not strictly valid and may be subject to invalidation by third parties.

Enforcement

A trade mark must always be registered in relation to particular goods or services and the resulting scope of protection is limited to those goods or services. When it comes to enforcement, a trade mark can be only be enforced against a third party who is using the same or similar trade mark, in relation to the same or similar goods or services. Such use must be in the course of trade, and where the trade marks and goods are similar rather than identical, a likelihood of confusion on the part of the public must also be shown.

It is sometimes possible to enforce a trade mark against a third party who is using the same or similar trade mark in relation to different goods or services. However, this is only possible where the trade mark has

a reputation and the third party can be shown to have taken unfair advantage of or have caused damage to that reputation. Demonstrating this can be difficult, especially if the trade mark is new to the market and has not had time to acquire a reputation.

Therefore, it is sometimes preferable to register a design for the appearance of the product itself, its logo and even its packaging. Whilst filing a design application involves indicating the type of product contained within the application, the resulting protection is not limited to the type of product indicated. As such, a design registration for the shape of a chocolate bar could, in theory, be enforced against a third party manufacturing toys of the same or similar shape, so long as they create the same "overall impression" as the protected design. Equally, a registered design for product packaging could be enforced against third parties regardless of the type of product contained within the packaging.

A design registration can therefore be easier to enforce against a third party than a trade mark, since it is not necessary to show customer confusion or that the third party is using the design on the same goods/services to those of the proprietor.

Duration of protection

Once registered, a trade mark has an initial duration of 10 years from the date of filing. After this period, the trade mark registration can be renewed for further ten-year periods. There is no limit to the number of times that a trade mark can be renewed, meaning that a registered trade mark can have an indefinite duration. Having said that, a registered trade mark must be used in order to remain in force, and trade mark registrations become vulnerable to cancellation if they have not been used for any continuous period of five years after registration. This adds an extra burden to enforcement of a trade mark registration, as the owner will usually be required to prove use of their trade mark if they try to enforce it after its 5th anniversary of registration.

By comparison, a UK or Community Design Registration has an initial term of 5 years, which can be renewed for further five-year periods up to a maximum of 25 years. The duration of protection is considerably less than that for trade mark registrations, but there is no requirement to prove that the design has been used in order to enforce it. The rapid registration and absence of any requirement to prove use of the design makes design registrations a popular choice, especially in the luxury fashion, food and drinks packaging and furniture sectors.

Summary

Whilst trade mark registrations continue to be the first choice of protection for brand owners, design registrations can provide a fast, cost-effective and useful option for obtaining complementary protection. We therefore encourage brand owners to consider broadening their intellectual property rights by filing registered design applications to protect the appearance of their products, packaging and complex logos. In this way, brand owners can restrict competitors' options and ensure that they are able to prevent third parties from using their branding, regardless of whether or not the use is in the same commercial field.

If you would like to discuss complementary design protection for your brands, please contact your usual trade mark attorney at Withers & Rogers.

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Characteristic	Trade Mark	Design Registration
Filing requirements	Must not be descriptive or non-distinctive.	Must be "novel" and have "distinctive character".
Grace period	Can be filed at any time, even if the trade mark has been disclosed.	Must be filed within 12 months of disclosure to the public.
Types	Words, letters, logos, numbers, smells, sounds.	Look of the whole or part of a product inc. shape, contours, get up and ornamentation. Excludes words, phrases, numbers and letters.
Requirement to use	Yes - after 5 years, otherwise unenforceable.	No.
Limited to goods covered by the scope of the application	Yes (and similar goods).	No.
Applicable to services	Yes	No.
Examination	Yes - Absolute grounds (descriptiveness and distinctiveness).	Formalities only.
Timescale from filing through to registration	UK - 6 months. Community - 12 months.	UK - 1 month. Community - <1 month.
Duration	10 years, renewable indefinitely.	25 years maximum.
Rules for enforcement	Identical/similar trade mark + identical/similar goods + likelihood of confusion.	Same overall impression, regardless of the type of goods.

Are designs simple? You be the judge.

1

In this case the registered design was a bottle chiller (note the ice and water in the bag) for use as an ice bucket. The infringement was for the same purpose, held to be “virtually identical” to the registered design, and as such found to INFRINGE.

The prior art was simply a bottle bag, and was deemed too narrow and tall to be a chiller.

As such the design was held to be new and having a different overall impression to the prior art.

In short, the design was held VALID.¹

1: Gimex v Chill Bag

This case was heard in the Patents County Court in 2012. The interesting part of this case is that even though the bottle, water and ice in the design registration were “disclaimed” (and as such formed no part of the design in question), the use suggested by these features was key to the eventual decision. The use of the bag as a “bottle chiller” meant that the informed user could distinguish the Gimex bag over the prior art bottle carriers, which meant that although protection was narrow, the design was held to be valid. It followed that because the Chill Bag bag was almost identical to the design, there was also infringement.

The key lesson here is to really think about how the “informed user” will be influenced. If disclaimers are required to emphasise the otherwise unclear use or relative dimensions of the product, then they should be used to that effect.

2

There was NO INFRINGEMENT because the alleged infringement produced a different overall impression on the informed user. Amongst others, it is absent the flowing “bumper” of the design, it has a longer cylinder, and the hose emerges in a different place. According to the High Court judge: “The overall impression produced by the Registered Design is smooth, curving and elegant. The overall impression produced by the [alleged infringement] is rugged, angular and industrial, even somewhat brutal.”

The design was “strikingly different” to anything else at the time (1994), and as such it was held to be VALID, with a broad scope of protection.²

2: Dyson v Vax

Dyson had lost this case at the High Court in 2010, and were so strongly of the opinion that the Vax product infringed their design they appealed. Unfortunately for Dyson, the Court of Appeal agreed with the High Court’s decision.

The design was so revolutionary at the time that its scope of protection was deemed to be broad. Nevertheless, although the alleged infringement shared many of the general features of this revolutionary design, Vax had created something which was much more industrial and rugged than the softer, more curved Dyson product.

The main conclusion to draw is that even the scope of protection for the most revolutionary of designs is limited, and later products which are clearly inspired or influenced by the design in question are not necessarily infringements. What is important is the overall impression, not a comparison using a checklist of features.

3

There were held to be many differences between the design and the alleged infringement: “the design of the [alleged infringement] is softer and more rounded and evocative of... an animal with floppy ears. At both a general and a detailed level the [alleged infringement] conveys a very different impression”.

As such, there was NO INFRINGEMENT.

The prior art in this case was an earlier version of the registered design. The design was held to be VALID, as a slimmer, more sculpted, sophisticated and modern version of the prior art. It also looks more like a “horned animal”. Therefore it produced a different overall impression on the informed user.³

3: Magmatic v PSM

This is another case which was appealed, this time by the alleged infringer who lost at the High Court in 2013 and was held to have infringed. In this instance the Court of Appeal disagreed with the High Court, and found that the design was not infringed.

Traditionally, design practitioners use an absence of surface decoration to indicate that the product may or may not have such decoration - in other words that the design rests in the shape only. The usual way to approach this is to use line drawings without any shading whatsoever. Magmatic had used shaded drawings, and had even used different tones e.g. for the wheels and clasp. As such, the Court of Appeal concluded that the absence of surface decoration elsewhere on the design drawings was a positive feature - the design was to a case with an absence of decoration, broadly resembling a “horned animal”. As a result, the distinctive surface decoration on PSM’s products contributed significantly to the overall impression the informed user took, and meant that this was sufficiently different from the Magmatic “Trunki” case to escape infringement.

The conclusion? For broader protection, use line drawings when filing designs.

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1: Gimex v Chill Bag- find the full case by searching for “[2012] EWPC 31”

2: Dyson v Vax- find the full case by searching for “[2011] EWCA Civ 1206”

3: Magmatic v PSM- find the full case by searching for “[2014] EWCA Civ 181”

New ways to speed up processing of patent applications

Two new initiatives were launched at the beginning of this year to help applicants obtain patent protection for their inventions faster.

The 'Global Patent Prosecution Highway' and 'IP5 Patent Prosecution Highway' pilot programmes can be used to accelerate examination of UK and European patent applications, respectively.

As in previous Patent Prosecution Highway schemes, the programmes allow an applicant for a patent with claims that are considered allowable by one of the participating Intellectual Property Offices to request accelerated processing of related applications by other Intellectual Property Offices that are members of the programme.

The Intellectual Property Offices participating in the pilot programmes are shown in the table above.

Global Patent Prosecution Highway

Australia, Canada, Denmark, Finland, Hungary, Iceland, Israel, Japan, Korea, Norway, Portugal, Russia, Spain, Sweden, the United Kingdom and the United States of America

IP5 Patent Prosecution Highway

China, Europe, Japan, Korea and the United States of America

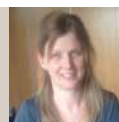
Participating offices can take advantage of examination work already carried out by the other offices, making the examination process faster and more efficient.

Patent applications filed with the participating offices, either from international (PCT) patent applications or directly, may be eligible for the programmes.

These pilot programmes are currently available until 5 January 2017. For more information about requesting participation in either programme please contact your usual patent attorney at Withers & Rogers.

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Meet our designs specialists

This edition of IP Review reflects the growing importance of designs and their protection to businesses.

At Withers & Rogers we recognise the importance of getting the right advice on design protection. Our Designs Specialist Practice Group, headed by Richard Worthington, has a wealth of experience across many different industries and territories, and is happy to assist with any design related questions you may have. The group members are:

Bristol



Richard Worthington



Nicole Giblin

London



Tania Clark



Russell Edson



Will Morgan

Midlands



Phil Sanger

Sheffield



David McWilliams

Full details of the Designs Specialist Practice Group can be found on our website at <http://www.withersrogers.com/expertise/specialist-practice-groups/designs-group>

STOP PRESS

As we were finalising this edition of IP review, the Intellectual Property Bill mentioned on page 11 received its royal assent. Read our full report at www.withersrogers.com/news/365/107/Intellectual_Property_Bill_receives_Royal_Assent

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