

REGISTERING DESIGNS - A BRIEF GUIDE

WHAT IS A DESIGN?

Legally a design is the outward appearance of a product or part of it, resulting from the lines, contours, patterns, colours, shape, texture, materials or its ornamentation.

WHY SHOULD I THINK ABOUT REGISTERING MY DESIGN?

Registering a design ensures that you have exclusive rights to the design. Designs make a product aesthetically appealing to the consumer eye and can be a key distinguishing feature in a competitive industry. A design can be a valuable commercial asset, increasing the marketability of your product and playing a key role in the success of your business.

WHAT CAN BE REGISTERED AS A DESIGN?

A design can be registered in respect of two-dimensional and three-dimensional products. A “product” can be any industrial or handicraft item, for example cars, jewellery and toys. It includes products that are composed of multiple components, which may be disassembled and reassembled. As a general rule, in order to be registrable, a design must be new and have individual character. This means that the design must have an appearance of originality. In addition, the design must relate to a part which, in normal use, is visible. A design must not relate to how the product functions.

WHAT WILL A REGISTERED DESIGN DO FOR ME?

Once registered, a design is a form of industrial property which can be assigned, transferred, licensed or used by the owner, just like any other piece of valuable property. An owner of a registered design has the exclusive right to use the design. This means that the owner can prevent use of the design on a product by a third party. Acts that could be affected are the making, marketing, importing, exporting, selling or use of a product incorporating a design. The owner can also exploit the registered design by licensing it to third parties. The design of a product can be associated with the image and branding of a company and can become an asset with monetary value that could increase. By registering your design, you are given an exclusive right to protect your design against unauthorised copying or use by third parties.

WHAT SHOULD I DO?

We recommend that before you make use of any design, you should investigate whether you can register the design. It is always advisable to undertake pre-application searches before applying to register a design. If someone else has already registered the design that you want to use, you could find yourself legally restrained from registering that design. Even if you do not want to register the design you should check to see if there is an existing registered design holder who might be able to prevent you using the design that you want to use.

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WHAT COULD HAPPEN IF I DO NOT REGISTER MY DESIGNS?

Without appropriate protection of your design, it could be copied or used by a third party including a competitor. Consequently you may lose business and goodwill. EU and Irish law provides that designs that are created after 6 March 2002 are protected as unregistered designs. This is a weaker form of legal protection, but unregistered design rights will subsist without the need to make an application or registration. However reliance on unregistered designs is not suitable for some businesses. The constantly increasing number of registered designs across Europe demonstrates that many businesses understand that registered designs are stronger and consequently more valuable.

HERE ARE SOME KEY DIFFERENCES BETWEEN UNREGISTERED DESIGN RIGHTS AND REGISTERED RIGHTS:

UNREGISTERED DESIGN RIGHTS	REGISTERED DESIGN RIGHTS
<ul style="list-style-type: none"> • The total term of protection is 3 years. • More difficult to prove infringement—need to prove that the design was copied. An ‘innocent’ user of the design who did not copy your product could not be prevented from using the design. • Must prove when the design was first made available to the public and that the design satisfies the relevant tests to prevent infringement. 	<ul style="list-style-type: none"> • The total term protection is 25 years renewable at 5 year intervals • No need to prove that the infringer copied the design to prevent use of the design by a third party. An ‘innocent’ user of the design can be prevented from using it. • Having a registered design is all that is required to be shown to prevent infringement.

WHERE SHOULD I REGISTER MY DESIGN?

- **Irish Protection**

You can register your design in Ireland with the Irish Patents Office. This will give you exclusive rights in Ireland.

- **European Union (EU) Protection**

You can register your design on a country by country basis, or you can register on an EU wide basis with the Office for Harmonisation in the Internal Market (OHIM). By registering your design with OHIM, you will gain the benefit of a single legal system, providing strong and uniform protection throughout the EU, and the area of protection increases each time the EU enlarges.

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- **Other International Systems**

Under the Hague Agreement Concerning the International Deposit of Industrial Designs, you can apply for registration in over forty countries by making a single application to the World Intellectual Property Organisation (WIPO) designating the countries of interest that subscribe to the system. An international registration produces the same effects in each of the designated countries as if the design had been registered there directly. This is a marvellous way to protect your design should you have, or intend to have, a wide international presence.

- **Other Jurisdictions**

If you intend to market your product in other jurisdictions, you should consider what national design rights are available in those countries. We have a network of high calibre agents around the world that will assist you in protecting your design in their jurisdiction.

CAN LK SHIELDS SOLICITORS HELP YOU?

We advise many of our clients on their design rights. We apply for registered designs on behalf of clients in all three systems of protection mentioned above (Irish, EU and International). We assist clients securing and exploiting their unregistered design rights and registered design rights to protect their products and competitive advantage by taking actions against those that use their designs.

To identify and discuss the designs that you may wish to register or for design advice in general, please contact us.

Deirdre Kilroy
dkilroy@lkshields.ie

Aine Matthews
amatthews@lkshields.ie