

LK SHIELDS
YOUR LEGAL COUNSEL



INTELLECTUAL PROPERTY

A Guide To Registering Designs

by **lk-shields**

A Guide To Registering Designs

21st February 2017 | by

Registered designs are increasingly used by businesses and designers when protecting their products and related market positions.

At an EU level nearly 85,000 Community Designs are registered each year. In 2014, the total number of Community Designs filed reached its highest level since 2003. Design registrations made in respect of Ireland alone have also continued to grow strongly.

For some products, a design registration is a more suitable, achievable and cheaper option than pursuing a patent; and a registered design has a longer protection period than a patent.

This guide gives some useful advice on what designs can be protected, what types of protections are available for designs and also how to protect your business against unauthorised copying or use of your designs.

Why Register a Design?

You can register the appearance of a product that you have designed to stop people copying or stealing it.

Registration of a design is a step many product and surface pattern designers take to protect the value of their designs. A registered design makes taking legal action against infringers easier. It also provides owners with a valuable intellectual property asset.

What Designs Can Be Protected?

The visual appearance of a product or part of it can be protected as part of a design right. Features of a product design that can be protected include physical shape, configuration, contours, patterns, colours, texture, materials and ornamentation.

A registered design is a form of intellectual property. Design protection is territorial and the rights in a registered design are limited to the jurisdiction in which it is registered. Design rights can be secured in Ireland, or other individual EU Member States, and also as a pan-European right. As a business asset it can be assigned, transferred, licensed or used by the registered owner as security for a loan.

Why Should You Think About Registering A Design?

Registering a design right ensures that you have exclusivity and control of the design of the product or ornamentation in the jurisdiction in which the design is registered. Product designs that have distinguishing features enhance their owner's image, reputation and increase the value of the product range, related brands and goodwill.

In the EU, some designs are automatically protected by unregistered design rights, but it is a longer, easier, cheaper and more reliable way to protect your design, if you register it. A registered design right

enables you to prevent others from copying or using the design in an unauthorised way. Once registered, you have exclusive rights to apply the design to various products, depending on the class or classes in the Locarno Classification system (the Locarno class) that the design is registered in. Once registered, you can display your design registration number on your products which use the design.

The number of product owners choosing to register designs across the EU is increasing every year. Registered designs are applied to a wide variety of products including medical devices, electrical goods, jewellery, clothing and textiles. Increasingly designs are secured for digital products such as graphical user interfaces and screen icons. While a registered design cannot protect the functionality of a product, it often makes commercial sense to register a design when you have plans to build a product range or business around a specific design.

What Can Be Registered As A Design?

You can register a design for any aspect of your design for both two-dimensional and three-dimensional products. For example, you may choose to register both a product's shape and decoration. Requirements for registering a design:

1. It must be novel, which means it must not be identical to an existing design that has already been made available to the public.
2. It must have individual character. A design has individual character if the overall impression it produces on informed users differs from the overall impression produced on similar users by an earlier design.

Where Can I Apply For A Registered Design?

Ireland	European Union	International
Irish designs are registered by the Irish Patents Office under the Industrial Designs Act 2001 (as amended).	A Registered Community Design (RCD) is a design right that is enforceable in the twenty-eight member states of the EU.	An industrial design may be registered in over forty countries by making a single application to the World Intellectual Property Organisation (WIPO) by means of a single application based on a RCD.
A maximum of 100 designs may be registered under one application.	An application for a RCD is made to the European Union Intellectual Property Office (EUIPO). You can file a multiple RCD application which allows you to file a limitless number of designs in one RCD application.	An international registration will result in design rights in each of the designated countries, as if the design had been registered there directly.

Owners of Irish registered designs and Registered Community Designs (RCDs) have exclusive rights in the designs for twenty-five years following registration. The initial period of protection is granted for five years and the design protection period can be renewed four times in five year increments.

Are Unregistered Design Rights Protected?

Ireland	European Union	International

There is no national unregistered design right in Irish law.	EU law provides that unregistered designs created after 6 March 2002 are protected as unregistered designs. Unregistered design rights last for just three years and come into being automatically, without the need to make an application for registration to the EUIPO.	There is no international system for the protection of unregistered design rights.
--	--	--

Some of the key differences between unregistered design rights and registered rights:

Unregistered Design Rights	Registered Design Rights
The total term of protection is three years.	The total term protection is twenty-five years renewable at five year intervals.
Determining whether an unregistered design right exists is often difficult and may be an expensive process.	A registered design grants exclusivity of use to the owner in the jurisdiction it is registered in.
It is more difficult to prove infringement as you must prove that the design was copied. An 'innocent' user of the design who did not copy your design could not be prevented from using the design.	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.
You must prove when the design was first made available to the public and that the design satisfies the relevant tests to prevent infringement.	Having a registered design is all that is required to be shown to prevent infringement.

About LK Shields Solicitors

We advise many of our clients on the protection and exploitation of 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 rights in unregistered designs including by taking actions against those that use their designs in an unauthorised way.

To identify and discuss any designs that you may wish to register or for design advice in general, please feel free to contact our Intellectual Property, Technology and Privacy team on +353 1 661 0866.

© Copyright LK Shields Solicitors, February 2017. All Rights Reserved.

About the Author