

CONTENTS

	Page
<i>Table of Cases</i>	xix
<i>Table of Council Decisions</i>	xxxiv
<i>Table of Statutes</i>	xxxv
<i>National Table of Statutes</i>	xlv
<i>Table of Statutory Instruments</i>	xlvi
<i>Table of Civil Procedure Rules</i>	lii
<i>Table of Practice Directions</i>	liii
<i>Table of European Agreements, Conventions and International Treaties</i>	liv
<i>Table of European Directives</i>	lvii
<i>Table of European Regulations</i>	lix
<i>Tables of Abbreviations</i>	lxiii

Chapter 1

Overview and Historical Introduction to Design Rights in the United Kingdom

	Para.
1. The Five Different Rights	
The five rights which protect industrial designs	1-001
Summary of the attributes of the five rights	1-005
2. Inter-relationships	
General picture as regards overlap of rights	1-006
Problems at the boundary between copyright and UK unregistered design right	
3. History of Copyright and Industrial Designs up to 1911	
Early Copyright Acts	1-012
Textiles: the start of industrial design protection	1-013
Sculptures	1-014
Extension of protection for textile designs	1-015
Extension of protection to articles of manufacture generally and introduction of registration	1-016
Substances	1-018
Registration of functional industrial designs	1-019
Overlapping protection for sculptures	1-020
Drawings, paintings and photographs	1-021
Designs transferred to Commissioners for Patents	1-023
The Patents and Designs Act 1907 and the Copyright Act 1911 ..	1-025
4. Historical Development of the Relationship between Copyright and Industrial Design Protection	
The relationship between artistic copyright and industrial designs	1-026
The effect of the Copyright Act 1911 on overlapping protection	1-027
Section 22 of the Copyright Act 1911	1-031

CONTENTS

Effects of section 22	1–034
Reform of provisions against overlap under Copyright Act 1956	1–042
The fatal flaw in the overlap provisions of the Copyright Act 1956	1–046
Overlapping protection permitted by the Design Copyright Act 1968	1–051
5. Amendments Made by EU Harmonisation Measures	1–053

Chapter 2

Community Designs and EU Harmonised UK Design

1. The European Harmonised System	
Harmonisation in the EC internal Market	2–001
The Directive and the Regulation	2–003
The Directive and national implementing measures	2–004
The effect of the Regulation	2–007
Interpretation of the new corpus of law	2–009
Relationship with other rights	2–012
Relationship with copyright protection	2–013
2. What is a Protectable Design?	
Requirements for protection	2–016
Definition of “design”: essence is the <i>appearance</i> of a product	2–017
What is a “product”?	2–020
Exclusion of features which are dictated by technical function	2–025
Design must be new	2–031
Differing only in “immaterial details”	2–033
“Individual character”	2–034
Assessing the difference in overall impression	2–038
Evidence relating to assessment of overall impression	2–041
The “informed user”	2–043
Public policy and morality as a ground for refusal or invalidation	2–045
Miscellaneous grounds for refusal: flags and emblems, etc.	2–046
Grounds for invalidation on objection by owner of conflicting rights	2–047
3. Partial Designs and Designs of Parts	
Designs need not relate to a whole product	2–048
Community unregistered design right and parts of products	2–050
Component parts and “complex products”	2–051
Designs of interconnections: the “must fit” exclusion	2–052
Modular products	2–054
4. Available Prior Art	
Date at which novelty and individual character are to be assessed	2–057
Claims to an earlier priority date	2–061
Conflicting registrations with earlier application or priority dates	2–064
Making a design available to the public	2–067
Need the disclosure of the design be in relation to a product? ...	2–071

CONTENTS

Geographical scope	2-072
How wide need publication be?	2-075
What is the "sector concerned"?	2-076
Confidential disclosures	2-078
Period of grace: disclosures by the proprietor with 12 months before filing	2-079
Publication in abuse of the designer's rights	2-082
5. Infringement of Registered UK and Community Designs and of Unregistered Community Designs	
Requirements for infringement	2-083
Acts which constitute infringement of designs	2-084
Limitations on infringement	2-087
Ships and aircraft from another country	2-088
Territorial scope of infringement of UK registrations	2-090
Territorial scope of Community design right	2-092
Temporal limits of infringement	2-093
Scope of protection	2-096
Copying in the case of unregistered Community design right ...	2-099
Spare parts	2-101
Right to continue prior use	2-102
6. Property Rights and Licensing	
UK registered designs and applications	2-104
Property law relating to Community designs and applications .	2-105
First ownership of a Community design right	2-106
Persons who commission the making of designs	2-109
Disputes over entitlement to a Community design	2-110
Recordal of interests in the register	2-111
Dealings with and transfers of Community design rights	2-113
Licensing of Community design rights	2-118
Law governing applications for registration as objects of property	2-120
7. Application Procedure	
Application for a UK registered design	2-121
The Designs Registry	2-122
Method of application	2-123
Representations or specimens of the design	2-126
Illegal or immoral, etc. designs	2-129
Examination of applications and Office objections	2-130
Hearing on the Registrar's objections	2-132
Appeal from the Registrar's decision	2-133
Further challenge to a decision of the RDAT	2-137
Grant of certificate and inspection of registration	2-139
Convention applications	2-141
Application for registration of a Community Design	2-143
Filing the application form	2-145
Multiple applications	2-147
Formal examination only	2-148
Registration	2-150
Appeals against decisions of OHIM	2-151
International applications under the Hague Agreement	2-152
8. Terms of Protection	
Registered rights	2-156
Unregistered Community rights	2-157

Chapter 3

Pre-2001 UK Registered Designs

1.	Application of the Old Law to Existing Registered Designs	3-001
2.	What was a "Design" Capable of Registration?	
	The nature of registered design protection	3-008
	Definition of "design" for purposes of registration	3-010
	Design must have had reference to some article	3-013
	Design may be two- or three-dimensional	3-017
	Designs combining two- and three-dimensional elements	3-020
	Directing registration to shape or to pattern	3-021
	What is an "article"?	3-025
	"Article of manufacture"	3-027
	Article must have purpose other than merely carrying the design	3-028
	Exclusion of designs for articles of a "primarily literary or artistic character": rule 26	3-033
	Buildings and structures	3-036
	Spare parts and parts of articles	3-038
	Parts of articles and the "must match" exclusion	3-041
	Application of the design "by an industrial process"	3-045
	Eye appeal	3-047
	Eye appeal is not the same as artistic merit	3-051
	Features dictated by function	3-054
	"Eye appeal" and articles which are partly functional	3-061
	Design features which also achieve functional purpose	3-067
	Historical development of the exclusion of functional shapes	3-071
	Designs where the appearance is not material	3-075
	Exclusion of "method or principal of construction"	3-077
	Letters and numerals	3-084
	Checks or stripes	3-085
	Colour	3-086
3.	Novelty and Prior Art	
	Novelty a requirement for registration	3-089
	Date at which novelty is to be assessed	3-091
	Conflicting registrations with earlier application dates	3-094
	What constitutes prior publication	3-097
	Publication by prior use	3-100
	Re-registration of the same design for different articles, or a similar design for same or different articles	3-105
	Publication in documents	3-108
	When does a document count as published?	3-112
	Does the document disclose a design applied to an article? ...	3-118
	What design is disclosed by a prior published document?	3-121
	Proprietor who exploits copyright in an artistic work	3-125
	Disclosure to a single person is enough for publication	3-129
	Confidential disclosures	3-131
	Disclosure of a proprietor's design in breach of good faith	3-135
	Disclosure to a government department	3-139
	Display of designs at exhibitions	3-140
	Prior publication must be within the United Kingdom	3-142
	Assessing the novelty of a design against a prior design	3-145

CONTENTS

The whole of the design need not be new	3-148
Differing in "immaterial details": the eye is the judge	3-151
Variants commonly used in the trade	3-154
Distinction between "new" and "original"	3-160
The position before RDA 1949: novelty as to class of articles ..	3-162
4. Pre-2001 Infringement of Registered Designs	
Requirements for infringement of a registered design	3-164
Acts of primary infringement of a registered design	3-168
Making of moulds and tools, etc.	3-170
Kits of parts	3-173
Territorial limits of infringement	3-177
Temporal limits of infringement	3-180
The article for which the design is registered	3-181
Degree of resemblance for infringement of registered design ..	3-184
How does one look for infringing resemblance?	3-188
What needs to be compared	3-189
Isolating the features which constitute the "design"	3-191
No infringement if difference is in essential features	3-194
Essential features may be identified by reference to prior art ..	3-196
Design based on a very well known subject	3-203
Whether differences are substantial	3-206
Designs must be compared as a whole	3-211
Impact of the statement of novelty	3-214
5. Property Rights and Licensing	
Persons who may apply to register a UK design	3-216
Author as proprietor of registered design right	3-219
Joint authorship of registered designs	3-220
Designs created pursuant to a commission	3-222
Designs created in the course of employment	3-224
Assignee or transferee of the right to register	3-225
Registering a design copied from abroad	3-230
Assignments of registered designs	3-231
Assignments to be together with unregistered design right ..	3-234
Licences under registered designs	3-238
Exclusive licences under registered designs	3-244
Registration of licences and other interests	3-246
6. Term of Protection	
Term of registered design	3-248
Special cases where term is not reckoned from date of application	3-249
Special cases in which term is curtailed for some pre-2001 designs	3-251
7. The Pre-2001 Statement of Novelty	
Basis of the statement of novelty	3-253
Impact of the statement of novelty on what is "substantial" ..	3-258
Statement of novelty in general terms	3-261
Statement of novelty identifying a special feature or features ..	3-264
Formulating a statement of novelty	3-266
Two or more features independently novel	3-268
8. Transitional Provisions Applying to Pre-CDPA 1988 Registration	
Pre- and post 1988 Act registered designs	3-270
Definition of "design" and registrability	3-271
Infringement of pre-1988 Act registered designs	3-274
Maximum term was limited to 15 years	3-275

CONTENTS

Chapter 4

UK National Unregistered Design Right

1.	Nature of Unregistered Design Right	
	Nature of unregistered design right	4-001
	Definition of "design" for unregistered design right	4-003
	What is an "article"?	4-007
	Exclusion from scope of design right	4-010
	Method or principle of construction	4-011
	The "must fit" exclusion from design right	4-015
	The "must match" exclusion	4-026
	Unregistered design right does not cover surface decoration ..	4-029
	What is a "surface feature"?	4-034
	Unregistered design right and kits of parts	4-040
2.	Originality and Qualification for Subsistence	
	Originality of a design	4-042
	Exclusion from protection of "commonplace" designs	4-045
	Prerequisites for subsistence of design right	4-051
	Nationality of designer, employer or commissioner	4-055
	Qualification in the case of computer generated designs	4-058
	Joint designers, employers or commissioners	4-059
	Qualifying countries and qualifying persons	4-061
	Qualification for subsistence of design right by first marketing	4-065
3.	Infringement of Unregistered Design Right	
	Infringement of unregistered design right	4-068
	Acts of primary infringement	4-070
	Authorising acts of primary infringement	4-075
	Secondary infringement of design right	4-077
	What is an "infringing article"?	4-079
	Dealings in articles after expiry of design right	4-082
	Infringing act must be done for commercial purposes	4-084
	Territorial scope of infringement	4-086
	Overlap with infringement of copyright	4-088
	What amounts to an infringing design	4-090
	The concept of reproduction	4-093
	Exact or substantial reproduction	4-095
	Does design right subsist in the features which have been copied?	4-098
	Approach to the question of substantiality	4-101
4.	Property Rights and Licensing	
	First ownership of design right by designer	4-104
	Joint designers	4-107
	Designs created pursuant to a commission	4-109
	Designs created in the course of employment	4-112
	Special rule of ownership where right subsists by virtue of first marketing	4-115
	Prospective ownership of future design rights	4-116
	Special jurisdiction of the IP Office over first ownership, subsistence and term of design right	4-118
	Nature of property in design right	4-122

CONTENTS

Assignment of unregistered right in conjunction with registered design	4–125
Joint ownership of design right	4–126
Licensing of a design right	4–127
Exclusive licences of design right	4–128
5. Term of Protection	
Duration of design right	4–130
Availability of licences of right during the last five years of the term	4–132

Chapter 5

Copyright Protection for Industrial Designs

1. Copyright in Artistic Works Relevant to Industrial Designs	
Scope of copyright protection for industrial designs	5–001
Categories of artistic work	5–004
Graphic works	5–006
Drawing, diagram, map, chart or plan	5–008
Paintings	5–012
Photographs	5–013
Engravings, etchings, lithographs, etc.	5–016
Sculptures	5–019
Works of artistic craftsmanship	5–022
Works of architecture	5–029
Literary copyrights and industrial designs	5–033
2. Originality and Other Requirements for Subsistence	
The concept of originality	5–037
Quantum of originality required for derivative works	5–040
Derivative work of a new kind	5–043
Simplicity of work and originality	5–044
Physical existence of artistic work	5–045
Qualification for subsistence of copyright	5–047
3. When Copyright can Protect the Shape of Three-Dimensional Articles	
Artistic copyright and three-dimensional articles	5–049
Development of the doctrine of three-dimensional reproduction of copyright drawings	5–053
Decision of the House of Lords in the <i>British Leyland</i> case	5–057
Exclusion of industrial designs from scope of artistic copyright	5–059
Whether design purpose need be present	5–064
Other acts excluded from infringing copyright	5–066
Scope of "design" for the purposes of section 51(1)	5–068
Section 51 and surface patterns or decorations	5–073
Restriction of copyright term where articles are made by an industrial process	5–075
Industrial articles which are themselves sculptures	5–079
Wall plaques and medallions	5–083
4. Copyright as a Protection for Surface Patterns	
Artistic copyright and surface patterns	5–084

CONTENTS

Cases where elements of two- and three-dimensional designs are inter-linked	5–086
Restriction of copyright term where the design is applied industrially	5–088
Scope of restriction on copyright	5–092
Articles of a primarily literary or artistic character, and films	5–094
Scope of section 52 limited to “articles”	5–097
Making articles by an industrial process	5–099
5. Acts Amounting to Infringement of Copyright	
Acts of primary infringement	5–101
Copying by reproducing the work in any material form	5–102
Primary infringement by issuing copies to the public	5–105
Authorising acts of primary infringement	5–107
Secondary infringements of copyright	5–109
What is an “infringing copy”?	5–111
Dealings in articles after the expiry of copyright	5–114
Territorial scope of infringement	5–116
6. What Amounts to Reproduction	
What amounts to an infringing reproduction	5–118
Direct or indirect copying	5–121
Visual significance of features which are copied	5–123
Significance of written matter in graphic works	5–127
Copying of ideas and principles	5–130
Degree of similarity needed to count as reproduction	5–133
Degree of resemblance with simple works	5–135
The right to repair and spare parts	5–136
Fair dealing and related defences	5–139
7. Property Rights and Licensing	
Authorship and first ownership of copyright	5–141
Joint authors	5–143
Works created pursuant to a commission	5–146
Copyright works created in the course of employment	5–149
Prospective ownership of future copyright	5–153
Nature of copyright as a property right	5–156
Copyright in an unpublished work which is left by a will	5–158
Joint ownership of copyright	5–159
Licensing of copyright	5–160
Exclusive licenses of copyright	5–161
8. Term of Protection and 1988 Transitional Provisions	
Term of copyright	5–163
Restriction of copyright protection when an artistic work is exploited as an industrial design	5–169
Transitional enforcement of artistic copyright in respect of three-dimensional articles	5–171

Chapter 6

Infringement and Validity Disputes: Remedies and Procedures

1. Courts in which Proceedings may be brought	
Courts in which civil proceedings may be brought	6–001
The Patents County Court	6–006

CONTENTS

	Appellate Courts	6-008
2.	Parties	
	Action by a proprietor of unregistered rights	6-010
	Action by a proprietor of registered design	6-012
	Actions by exclusive and certain non-exclusive licensees	6-015
	Equitable owners and licensees	6-018
	Who may be sued for infringement	6-021
	Liability for "authorising" restricted acts	6-023
3.	Invalidity of UK Registered Designs	
	Mode of challenging validity of rights relied upon	6-025
	Who may challenge validity	6-028
	Grounds of challenge to validity	6-030
	Effect of order for rectification	6-034
4.	Invalidity of Community Designs	6-035
5.	Remedies in Civil Proceedings	
	Nature of remedies that can be claimed	6-043
	Disclosure and pre-action disclosure	6-044A
	Injunctions	6-045
	Effect of "Licenses of Right" on relief	6-047
	Damages	6-048
	Innocence defences	6-052
	Additional damages	6-057
	Account of profits	6-061
	Delivery up of infringing articles, moulds, etc.	6-065
6.	Criminal Proceedings	
	Criminal proceedings for the infringement of copyright	6-070
	Criminal proceedings relating to registered designs	6-074
7.	Other Miscellaneous Remedies	
	Self-help remedy	6-076

Chapter 7

Actions for Threats of Proceedings for Infringement

1.	Statutory Action for Threats	
	Threats of proceedings	7-001
	Statutory action for unjustified registered design threats	7-003
	Statutory threats action: who may sue?	7-006
	Who may be sued for making threats?	7-008
	Solicitors, patent attorneys and other agents	7-009
	Manner in which the threat is communicated	7-011
	Threat made to one person to sue another	7-013
	Mere general warning distinguished from specific threat	7-014
	Threat need not identify a particular design right or product	7-019
	What amounts to a threat of proceedings	7-021
2.	Exceptions and Justification	
	Exception for threats in respect of making or importation	7-030
	Notification of existence of design right	7-034
	Justification of threats	7-036

CONTENTS

3.	Relief Granted for Threats	
	Remedies in a threats action	7–039
	Interim injunctions to restrain threats	7–041
4.	Common Law Proceedings for Threats	
	Common law remedies for threats of proceedings	7–043
	Malice	7–046
	Actions for defamation	7–049
	Position where litigation is pending	7–050

Chapter 8

Compulsory Licensing and Crown User

1.	Compulsory Licensing of Registered Designs	
	Compulsory licensing of registered designs	8–001
2.	Licences of Right for Unregistered Designs	
	Licences of right for UK unregistered designs	8–002
	Procedure for grant of licences of right	8–003
	Terms and effect of licence of right	8–005
3.	Crown User and Emergency Powers	
	Secrecy of registered designs for defence purposes	8–010
	Crown use of registered and unregistered designs	8–014
	Compensation for Crown user	8–018

Chapter 9

European Community Law and Competition

1.	EU Law on the Free Movement of Goods and Parallel Imports	
	Free movement of goods under European Union law	9–001
	Statutory enactment of EU free movement rules	9–004
	Imports from outside the EEA	9–007
	Parallel imports and unregistered design right	9–009
	Alternative approaches to the hypothetical making in the United Kingdom	9–011
	Examples of the application of the <i>Charmdale</i> approach	9–014
	Parallel imports and copyright infringement: the “distribution right”	9–015
2.	Competition Law Affecting Designs	
	Competition law and designs	9–019
	Licences of right imposed in monopolies cases	9–020

Chapter 10

Protection of Semiconductor Topographies

1.	Protection of Semiconductor Topographies	
	The protection of semiconductor topographies	10–001

CONTENTS

Principal features of the semiconductor topography right	10–003
Definition of semiconductor topography design	10–004
A pattern “in or upon” a semiconductor layer	10–006
Other aspects of the definitions	10–008
Special rules for qualification	10–010
First ownership of design right	10–011
Duration of design right in semiconductors	10–012
Special rules applying to infringement of semiconductor designs	10–015

Chapter 11

Countries with Historical Connections with UK Registered Designs

1. Australia	
Historical	11–002
Definition of design	11–006
Validity over prior art	11–008
Test of infringement	11–010
Other features	11–011
2. Hong Kong	11–013
3. India	
History	11–016
Definition of “design” and conditions for registrability	11–017
Infringement	11–021
4. Ireland	11–022
5. New Zealand	11–024

Appendices

Appendix A: UK Registered Designs

A1. Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs	A1–001
A2. The Registered Designs Act 1949 (current version, EU harmonised law)	A2–001
A3. The Registered Designs Regulations 2001 (SI 2001/3949)	A3–001
A4. The Registered Designs Regulations 2003 (SI 2003/550)	A4–001
A5. The Registered Designs Act 1949 (version applying to pre-1986–2001 registrations)	A5–001
A6. Section 266 of the Copyright, Designs and Patents Act 1988 (transitional provisions relating to designs applied for between January 12, 1988 and August 1, 1989)	A6–001
A7. The Patents and Designs Acts 1907 and 1919 (consolidated—extracts)	A7–001
A8. The Patents, Designs and Trade Marks Act 1883 (c.57)	A8–001
A9. The Regulatory Reform (Registered Designs) Order 2006 (SI 2006/1974)	A9–001
A10. The Registered Designs Rules 2006 (SI 2006/1975)	A10–001
A11. The Designs (Convention Countries) Order 2007 (SI 2007/277) ...	A11–001

CONTENTS

Appendix B: Community Designs

B1.	Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs	B1–001
B2.	Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community Designs	B2–001
B3.	Commission Regulation (EC) No.2246/2002 of 16 December 2002 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registration of Community Designs	B3–001
B4.	Council Regulation (EC) No 1891/2006 of 18 December 2006 amending Regulations (EC) No 6/2002 and (EC) No 40/94 to give effect to the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs	B4–001
B5.	The Community Design Regulations 2005 (SI 2005/2339)	B5–001

Appendix C: UK Unregistered Design Right

C1.	The Copyright, Designs and Patents Act 1988 (c.48) Part III (as amended)	C1–001
C2.	Council Decision of 22 December 1994 on the Extension of the Legal Protection of Topographies of Semiconductor Products to Persons from a Member of the World Trade Organization (94/824/EC)	C2–001
C3.	The Design Right (Proceedings before Comptroller) Rules 1989 (SI 1989/1130)	C3–001
C4.	Council Directive of 16 December 1986 on the Legal Protection of Topographies of Semiconductor Products (87/54/EEC)	C4–001
C5.	The Design Right (Reciprocal Protection) (No.2) Order 1989 (SI 1989/1294)	C5–001
C6.	The Design Right (Semiconductor Topographies) Regulations 1989 (SI 1989/1100)	C6–001

Appendix D: Copyright

D1.	The Copyright, Designs and Patents Act 1988 (c.48) (extracts relating to copyright)	D1–001
D2.	Copyright Act 1956 (c.74) (extracts—as amended)	D2–001
D3.	Copyright Act 1911 (extracts)	D3–001
D4.	The Copyright and Performances (Application to Other Countries) Order 2008 (SI 2008/677)	D4–001
D5.	The Copyright (Industrial Process and Excluded Articles) (No.2) Order 1989 (SI 1989/1070)	D5–001
D6.	The Copyright (Industrial Designs) Rules 1957 (SI 1957/867)	D6–001

CONTENTS

Appendix E: Court, Tribunal and Procedural Rules

E1.	CPR Part 63—Patents and Other Intellectual Property Claims	E1–001
E2.	Practice Direction 63—Intellectual Property Claims (supplementing CPR Pt 63)	E2–001
E3.	The Patents County Court (Designation and Jurisdiction) Order 1994 (SI 1994/1609)	E3–001
E4.	The Community Designs (Designation of Community Design Courts) Regulations (SI 2005/696)	E4–001
E5.	The Registered Designs Appeal Tribunal Rules (SI 1950/430) (as amended)	E5–001
E6.	Commission Regulation (EC) No.216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs)	E6–001
E7.	Rules of Procedure of the General Court of the European Union (as amended on March 26, 2010—extracts)	E7–001

Appendix F: International Materials

F1.	Paris Convention for the Protection of Industrial Property of 20 March 1883 (as amended on October 2, 1979)	F1–001
F2.	Agreement on Trade Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods (extracts)	F2–001
F3.	Washington Treaty on Intellectual Property in Respect of Integrated Circuits (of May 26, 1989)	F3–001
F4.	Locarno Agreement Establishing an International Classification for Industrial Designs (signed at Locarno on October 8, 1968 and as amended on September 28, 1979)	F4–001
F5.	Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (adopted by the Diplomatic Conference on July 2, 1999)	F5–001