



# Protecting your designs

# About Mathys & Squire

***Dedicated to protecting and defending your future.***

We are an IP powerhouse that puts our specialist knowledge to work for you, to strengthen and secure what most modern businesses today treat as one of their most valuable strategic assets. Our agile team of attorneys, scientists and strategists are steeped in experience, working with IP-rich and high-growth industries leveraging complex technologies and sophisticated commercial models.

A full-service IP firm with unrivalled expertise in patents, trade marks, design protection and litigation, Mathys & Squire is highly ranked in leading legal and IP directories, including *The Legal 500*, *Chambers and Partners*, *IAM Patent 1000* and *World Trademark Review 1000*.

Founded in 1910, we have over 110 years of experience in the protection and commercialisation of IP rights.

With over 65 qualified attorneys and a dedicated IP consulting team across offices in London, Birmingham, Cambridge, Manchester, Newcastle, Oxford, York, Luxembourg, Munich and Paris, as well as teams based in Belfast, China and Japan, our specialists cover a wide range of technical fields and industry sectors. Our attorneys and trainees have a mix of scientific degrees extending from chemistry, biochemistry, pharmacology, genetics, microbiology, plant sciences and zoology through to physics, electronics, telecommunications and engineering.

***We protect, so that you can invent the future.***

# Introduction to design protection

Whether it is the protection of the shape, colour or other features of a product, our designs team will work with you to protect the aesthetics of your designs. We work with our clients to advise them on all aspects of design law, from securing design protection to understanding and mitigating design infringement risk.

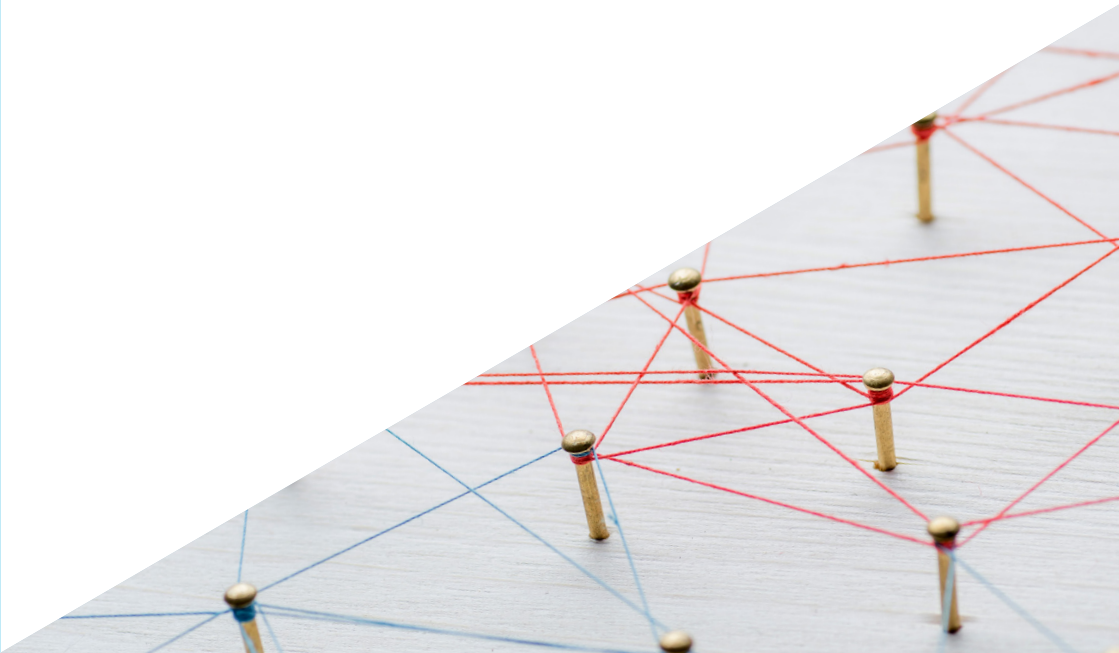
We have a large and well established designs practice which has helped numerous household names secure strategic protection for their designs internationally.

We have particular expertise in obtaining broad design protection for features that pervade product lines. In particular, we also have significant experience in obtaining design protection for user interfaces.

## Protecting your design - top tips

### **Keep it confidential!**

Registered designs should always be sought before the design is publicly disclosed; otherwise this can preclude the opportunity to seek registered design protection. However, under certain circumstances, a 12 month self-discourse grace period exists in the UK and Europe, which means that a prior self-disclosure of a design can be disregarded.



## Protecting your design - top tips

### **Economies of scale**

Under both the UK and European registered design systems it is possible to file simultaneously several designs within a 'multi-part' application. In doing so, the cost per design within the 'multi-part' application reduces with the number of designs. Applicants looking to cascade protection for their designs, using multiple registered designs, may do so in a cost-efficient manner compared to other jurisdictions.

### **A registered design right is not a right to use a design**

A valid registered design right allows you to stop an infringer from using your design; it does not grant you a right to use a design simply because it is registered. This is an important distinction because your own design may well infringe a third party intellectual property (IP) right.



# What is a registered design?

**Registered designs are used to protect the aesthetics of a product design, and are obtainable by filing an application at an intellectual property office.**

Registered designs are a monopolistic right, meaning that they can be used to prevent others from using the same, or similar, design – even if they did not copy it. Registering a design in Europe and the UK is relatively simple, inexpensive and quick compared to other forms of intellectual property.

There are two types of registered design rights available in the UK:

- European (Community); and
- UK registered designs.

There is very little in the way of designs that cannot be protected by means of registered designs. In fact, registered designs can be used to protect at least:

- articles (big e.g. entire buildings, to small e.g. pen lids);
- logos;
- patterns;
- colour schemes and other surface finishes;
- typefaces; and
- graphical user interfaces.

A crucial aspect of filing registered designs are the designs or photographs filed as part of your product, which are ultimately – and almost exclusively – used to determine the scope of protection. As a result, getting your representations right is key, and we have significant experience in tailoring representations – often quite creatively – to suit the scope of protection sought.

## Protecting your design - top tips

### Ownership – it starts with the designer(s)

The first owner(s) of the intellectual property in a design is the original deviser(s) of that design. Accordingly, it is important to assign ownership of the design from the designer(s) to the applicant seeking to register the design, with which we can help.

# What is the process for obtaining registered design protection in the UK and Europe?

We can assist you in seeking registered design protection – from preparing an application through to grant, to maintaining your rights. The key steps to seeking and maintaining registered design protection in the UK and Europe are outlined below:

## 1. **Preparing representations:**

Representations, in the form of designs or photographs, should be prepared carefully to ensure that the design, once registered, covers the intended scope.

## 2. **Filing:** The application is filed at the UK Intellectual Property Office and/or European Union Intellectual Property Office. The filing date of a registered design is of **key importance**.

## 3. **Examination:** Designs are examined only on formal grounds, and no searches against prior designs are carried out. In the normal course of events, registered design applications typically proceed to registration within a matter of days of being filed.

## 4. **Publication:** Designs will be published upon registration. However, there is also the option of deferring publication until sometime after filing so as to keep a design secret.

## 5. **Maintenance:** To remain in force, UK and European registered designs must be renewed **every five years** after the filing date. The maximum term of such registered designs is 25 years from filing.

### Protecting your design - top tips

#### Registered design rights are territorial

The vast majority of territories in the world have some form of legal protection for designs. However, registered design applications will generally need to be sought in each territory of interest to ensure effective coverage, and we have significant experience in seeking overseas design protection.

# What are ‘multi-part’ registered design applications?

**Advantageously, with both UK and European registered design applications it is possible simultaneously to file an unlimited number of different designs within a ‘multi-part’ application, and the cost per design within a ‘multi-part’ application reduces slightly as the number of designs increases.**

In Europe the official filing costs for the second to tenth designs within a ‘multi-part’ design application are half that of the first. Likewise, the official filing cost for every design after the tenth is a quarter of the first.

In this way, applicants are not penalised for filing large volumes of registered design applications in the UK and Europe. Quite contrarily, in this way, applicants looking to cascade protection for their designs may do so in a cost-efficient manner compared to other jurisdictions in which costs scale directly with the number of designs filed.

## Graphical User Interfaces (GUIs)

Registered designs can be used easily and cost effectively to protect aesthetic aspects of digital products, such as icons and aspects of graphical user interfaces (GUIs), and not just the external physical appearance of a product.

Registered designs may offer a valuable level of protection for digital products that may be difficult to protect using other means, such as patents. Notably, in the UK and Europe registered designs can be used to protect a GUI itself, without reference to the device on which the GUI is provided, allowing a GUI to be protected no matter the device incorporating the GUI. In addition, dynamic or animated GUIs can also be protected via registered designs, allowing important user interactions to be protected.

## Protecting your design - top tips

### Use registered designs creatively

Generally speaking, there is very little that is inherently excluded from protection in the UK and Europe as a registered design. As a result, registered designs can be used to protect all manner of subject matter, including: physical articles; graphic user interfaces; logos; icons; typefaces; and even buildings and interiors.



## Protecting your design - top tips

### **Third party rights**

When commercialising a design, it is important to conduct due diligence as to whether your design may be at risk of infringing third party IP rights. Searches can be conducted in this regard to help identify potential risks, with which we can help.

### **Use registered designs as part of a holistic IP strategy**

Registered and unregistered designs are an effective tool for protecting the aesthetics of a design. However, such rights should ideally be used as part of a suite of IP rights, including trade marks and patents as appropriate. As a full service intellectual property firm, we understand the interplay between such various IP rights, and can advise our clients accordingly to obtain rounded IP protection.

# What is an unregistered design?

**Unregistered design rights generally arise automatically, so there is no need for registration or application.**

Like copyrights, unregistered design rights enable a designer to prevent the copying of their design. However, they are not monopolistic which means that, unlike registered designs, if another person came up with the same design independently, they cannot be stopped.

There are currently three types of unregistered design rights available in the UK:

- Unregistered design right
- Supplementary unregistered designs
- Continuing unregistered designs (which correspond to pre-existing European unregistered designs that covered the UK prior to 1 January 2021)

Each of these have slightly different characteristics, covering different aspects of a design and having different durations. Therefore, there are complementary rights that can be enforced, both registered and unregistered. We can advise clients – whether seeking to enforce rights or against whom rights are being enforced – in relation to these various aspects of design law.



# Overview of our designs services

**We have a large and well established designs practice assisting numerous entities – from startups to established household names – secure strategic protection for their designs internationally.**

## **Fixed price registered designs filings**

We can adapt our fees to suit your needs. For example, if appropriate, we can offer fixed price registered design filings (subject to drawings being supplied in the required format). We can also offer concessions and discounts depending on volumes.

## **International expertise**

We have built up a number of significant international design portfolios covering a wide range of jurisdictions, and have therefore acquired an intimate knowledge of the unique variations in local practice. Owing to our expertise in international design protection, we are often instructed by large multinational companies specifically to handle large overseas design filing programmes. With our familiarity of international design practice, we can act as the point of contact for an entire design portfolio. We also have significant experience in directly handling international Hague design filings.

## **Integrating design protection into the product development cycle**

We can integrate design protection into the product development cycle to reduce costs and management time associated with seeking design protection. This would involve us providing guidance and/or in-house training so that drawings can be provided in the required format, but without disrupting the product design process. In particular, we can assist in setting up a workflow in which drawings in a ready-to-file or near ready-to-file state are provided by our clients, allowing us to file new design applications quickly and cheaply. We have experience in putting such systems in place with several of our larger clients, and can tailor workflows to suit clients' needs.

## **Using the registered design system to maximise protection for key design aspects**

We work closely with our clients to cover key design aspects of their products and product lines, covering where appropriate overall shape, texture and/or surface finish. We have particular expertise in obtaining broad design protection for features that pervade product lines. We also have significant experience in obtaining design protection for user interfaces. We use the flexibility of the European registered design system in order to achieve commercially useful results for our clients.

## Our team



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**Dani Kramer**  
Partner (CPA, EPA)

Dani has worked for a number of large corporations, growing and managing their international design portfolios.

He has worked very closely with a number of clients to integrate the process of securing design protection into their product development cycle, to reduce costs and maximise protection.

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**Max Thoma**  
Partner (CPA, EPA)

Max is a specialist in registered design law. He works with a variety of organisations (from startups to large corporations) to prepare, file and prosecute registered designs in Europe and in many other jurisdictions. He has particular experience in registered designs directed to GUIs.

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**Helen Springbett**  
Associate (CPA, EPA)

Helen specialises in all aspects of design work, and has experience working on a wide range of applications from household items to graphical user interfaces.

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