



Fact Sheet

Registered Design Procedures & Costs



What is a Registered Design?

A registered design protects the outward appearance of an article. Registration of the design gives the owner the right to take legal action to stop others from making, selling, keeping, importing, hiring or using any product to which the design (or one not substantially different) has been applied.

Registered designs are territorial in nature. The following details relate to UK and EU-wide designs. Similar procedures exist to protect designs in other countries, and we can provide details on request.

What designs can be protected?

Registered design protection can be obtained for the lines, contours, colours, shapes, textures, materials or ornamentation of the whole or a part of a product which is an industrial or handicraft item. This includes complex products (which are made of multiple parts), packaging, get up, graphic symbols or icons. A registered design does not validly protect features of the design which are dictated solely by its function or which are required to fit to other parts.

To be valid, the design features must be “new” and have “individual character” at the date of filing the application to register the design.

A design is considered to be new if it has not already been made publicly available anywhere in the world. However, earlier use or publication of a design which would not reasonably have been known in Europe, or any publication of the same design (such as by marketing of the product) by the applicant in the twelve months before filing the application will be ignored, when considering whether the design is new. It is important to file an application to register a design as soon as possible, to obtain an early filing date, and within twelve months of the first sale of the product incorporating the design.

In order to have “individual character”, the design must create a different overall impression to earlier designs. In assessing whether a design has individual character, the amount of design freedom that the designer had when creating the design will be taken into account.

What is involved in applying for a UK Registered Design?

If design protection is required in the UK only, then an application for registration is filed at the UK Designs Registry, which is a section of the UK Intellectual Property Office. An applicant can file an application covering a single design, or a “multiple” application covering a number of different designs.

The application includes a number of views (called representations) of a product incorporating each design. These representations can be photographs or drawings, and must show all the features of the design which are to be protected. If photographs are used, then these should show the article photographed against a plain, contrasting background, and should not include any extraneous details, which do not form part of the design. The photographs should be black and white, unless colour forms part of the design.

The UK Designs Registry does not carry out a search to determine whether the design is new (unless specifically requested to do so), but can raise objections if the application does not comply with the formality requirements. If objections are raised, then you will have an opportunity to respond.

If the application is accepted, then details of the application are published in an official journal, and a certificate of registration is issued. It is possible to request that publication of the design is delayed for up to 12 months. This increases the cost of the application, but may be useful if it is important to keep the design confidential (for example, if a corresponding patent application has yet to be filed or to prevent competitors becoming aware of the design before the product is launched).

What is a Registered Community Design?

If a design is to be protected in the European Union, then an application for a Registered Community Design (RCD) can be filed at the Office for the Harmonization of the Internal Market (Trade Marks & Designs), known as "OHIM".

A RCD provides protection for a design in all EU countries (Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and United Kingdom) in a single application. The geographical scope of the RCD extends as and when the EU enlarges.

A RCD is an alternative to filing a number of national applications in each European country in which protection is required. This simplifies procedures, and provides very cost effective protection.

What is involved in applying for a Registered Community Design?

As in the UK, the application is filed with representations of the design to be protected. A multiple design application is also possible *provided that* all the products to which the design is applied are of the same type, according to an internationally recognised classification system. A maximum of seven views of the design can be filed for each product

covered by the application. The application should also identify the designer of each design.

Once filed, OHIM will check that the application complies with formal requirements, and if everything is in order, will pass the application for publication in an official journal. It is possible to request that publication is delayed for up to 30 months. Once published, you will be sent a registration certificate, which is generally received a few months after filing the application.

Validity

As neither UK registered designs or RCDs undergo an examination for registrability, registration of a design does not provide no legal presumption of validity. Therefore, once registered a third party may seek to challenge the registration on the grounds that the design protected lacks novelty or individual character.

Duration and Renewals

A UK registered design or a RCD remains in force for five years from the date of filing the application. This initial period can be extended for four further periods of five years, if renewal fees are paid. Therefore, the maximum period of protection for the registered design is twenty five years.

Renewals may be handled by Computer Patent Annuities Limited (CPA), a company which specializes in renewal matters, or by ourselves.

Unregistered Design Protection

The protection provided by a registered design supplements any design right or copyright protection which exists automatically.

You should not forget that a new design also enjoys a protection from copying, even if the design has not been registered. In the UK, unregistered design right can protect most designs for up to fifteen years from the design's creation. EU-wide protection for unregistered designs lasts for three years from the date on which the design was first made available to the public in the EU.

Costs

United Kingdom

- Filing a UK registered design application for a single design, including publication - £310
- Cost of each additional design filed at the same time - £240
- Registration - £125
- European Community
- Filing a RCD for a single design, including publication - around £750
- Each additional design up to ten covered by the same application - around £250 per design
- Each design over ten covered by the same application - around £150 per design
- Publication and registration formalities - £200.

All amounts indicated are in Pounds Sterling and include any official fees payable. The amounts are exclusive of VAT, which is usually recoverable if you are VAT registered. Costs are approximate, and will vary depending upon the complexity of the case and exchange rate fluctuations.

Our Services

Services are provided to you by Urquhart-Dykes & Lord LLP, and the contract under which those services are provided is with Urquhart-Dykes & Lord LLP and not with any individual member, employee or agent of Urquhart-Dykes & Lord LLP. Acceptance of our commencement of the provision of services to you shall be deemed to be acceptance of our Terms of Engagement (a copy of which can be provided on request, or can be viewed on our website at www.udl.co.uk).

During our work for you we may need to instruct third parties (for example, patent and trade mark attorneys in other countries, or searchers) to act on your behalf. We might instruct such parties directly on your behalf. Alternatively you might need to sign a power of attorney or similar appointment to engage such third party. Any such party is not part of Urquhart-Dykes & Lord LLP. While we shall endeavour to select third parties of appropriate good standing, we shall not be responsible for any default or negligence by such third parties.

Our charges are based principally on the amount of our professional time spent on the matter. Our hourly rates are determined with reference to the seniority and experience of the professional staff involved. These rates are reviewed periodically. Charges are calculated at hourly rates which apply when the work is carried out. There may be additional charges where a matter is complex or urgent or is one for which highly specialised knowledge is required. We might apply tariff charges to specific tasks such as the filing of a patent or trade mark application.

In appointing us to act on your behalf, you are also authorising us to incur such expenses as we consider necessary to carry out your instructions properly and agreeing that you will reimburse us in respect of those expenses. Examples of such expenses are Patent Office fees, fees of Counsel and other experts, Court fees, and the costs of third parties (for example patent attorneys in other countries, experts, searchers and translators) who we instruct on your behalf. They might also include such items as photocopying costs, courier charges, travel, accommodation and meeting expenses, telephone and fax charges. While our fixed charges and hourly rates are predictable, you should appreciate that many expenses are outside our control since they might be changed without notice and (in the case of foreign matters) vary with exchange rate fluctuations.

Any estimate of likely costs we provide (whether included in this sheet or in response to a request) is given only as a guide to assist you in budgeting, and should not be regarded as a firm quotation or a fixed or capped fee unless otherwise agreed in writing. Any costs given by us are net of VAT which will be charged as applicable on our fees and those expenses that are liable for VAT.

These notes are provided for guidance only, and do not deal with specific problems. For further information, please visit our website at www.udl.co.uk or contact one of our offices :

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