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PATENTS • TRADEMARKS • DESIGNS • COPYRIGHT

UK and EU Designs – an update

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FICPI-ABC, New Orleans
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FICPI-UK

The British Association of The International
Federation of Intellectual Property Attorneys

Robert Watson

Robert joined Mewburn Ellis in 1995 with first class degree in Chemistry from The University of Oxford. He qualified as a UK and European Patent Attorney in 1999, and became a partner in 2001.

The majority of his work is in the chemical field, with specialities in pharmaceuticals, polymers and electrochemistry. He advises a range of clients from multinationals to start-ups and public sector organisations.

He has developed a great deal of experience of invention capture and licensing negotiations in his practice, and works closely with a number of clients in these areas.

He also has a significant practice in design protection, advising and filing both in the EU and worldwide.

He has been President of FICPI-UK since 2010, and in this role has attended numerous meetings at all levels of the UK IPO on a variety of topics, representing the views of private practice attorneys. He has also met with two of the last three Ministers for IP.

He is also Chair of the FICPI CET group on Designs (Group 2), and has represented FICPI and both WIPO and OHIM.

Robert is the author of a chapter in the Community Designs Handbook on Unregistered Community Designs, and a member of the CIPA Designs and Copyright committee.

Outside work, Robert's main interests are his family and singing. These come together in his local church choir, where he, his wife and children sing.

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Mewburn Ellis LLP is one of the UK's largest firms of European Patent Attorneys, European Trade Mark Attorneys and European Design Attorneys, with offices in London, Bristol, Manchester and Cambridge. Our work covers a wide range of technologies and we offer our clients unrivalled expertise and outstanding service, whether they are an independent inventor or a large multinational.

We work closely with our clients to file and prosecute patent, trade mark and design applications and to handle contentious matters, including oppositions and strive to treat our clients' intellectual property rights not in isolation, but as part of their legal, commercial and industrial environment.

Overview

- UK Design Law
 - What can be changed?
 - Why change?
 - What are the proposals?
- EU Design Law
 - Representations
 - Excluded Features
 - Informed User
 - Overall Impression

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UK DESIGN LAW

Surely it's harmonised?

- UK Registered Design Law has to comply with EU Designs Directive
 - This harmonises the substantive requirements, but leaves open registration procedures and some enforcement
- UK Unregistered Design Right is not an EU harmonised right
 - There is considerable freedom to amend the legislation
- Copyright
 - Many aspects are not harmonised

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Hargreaves' Review

- A review commissioned by David Cameron
 - Report published in May 2011
- "design has an important contribution to make to growth"
- "Knowledge of the relationship between design rights, and innovation and growth, is inadequate to draw wider conclusions about the implications of these difficulties for growth or for improvements in design rights and enforcement"

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Call for Evidence

- IPO launched a call for evidence in response to Hargreaves' Review
- IPO also commissioned independent research
 - In 2008, £33.5 bn design spending
 - Evidence of 17% performance premium associated with design registration
 - 15% of companies surveyed had registered design, but but much lower ownership in high tech companies
 - Issues with complexity of the system
 - Problems associated with enforcement
 - Especially in comparison with Germany

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Consultation on Design Law

- IPO launched in September 2011
- UK Unregistered Design Right
 - What to do with it?
 - Different requirements for protection
 - Scope of protection
 - Qualification requirements
- Enforcement
- Other related issues
 - Deferment of publication, Hague, Opinions.

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Proposals for change

- Introduction of a criminal offence if ...
 - In the course of business, the person copies a registered design so as to make a product exactly or substantially to that design, and
 - The person does so
 - Knowing, or having reason to believe, that the design is a registered design, and
 - Without the consent of the proprietor
 - Also for "putting on the market, imports, exports, uses, stocks for one of these purposes" a product as above

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Proposals for change

- Defences
 - Reasonable belief the design was invalid
 - Non-infringement
 - Includes Registered Community Design
- Penalty
 - Up to 10 years in prison
 - Fine
- Most controversial of the proposals
 - Strong positions on both sides
 - Expect intense lobbying of Parliament

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Proposals for change

- Unregistered Design Right
 - "design" means the design of **any aspect of** the shape or configuration (whether internal or external) of the whole or part of an article
 - To limit scope of right & prevent 'cropping'
 - Change to originality requirement (to limit/broaden it?)
 - Ownership of commissioned designs to remain with author
 - Qualification rules relaxed slightly – still require reciprocity
 - Exempted uses added (as in Registered Designs)

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Proposals for change

- Others
 - Defence of prior use for Registered Designs
 - Option of Appointed Person to hear IPO appeals
 - Design Opinion Service to be introduced
 - Joining Hague Agreement

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Representations

- What are the rules?
 - Maximum 7 views
 - Sizing
- So what about dotted lines?
 - Exam guidelines:

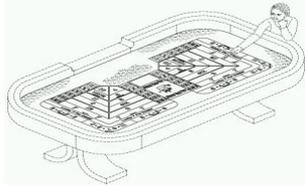
"Dotted lines may be used in a view either to indicate the elements for which no protection is sought or to indicate portions of the design which are not visible in that particular view, i.e. non-visible lines. Therefore, dotted lines identify elements which are not part of the view in which they are used."

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Representations (cont.)



RCD 30606-0005

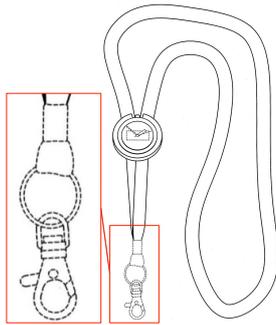


RCD 1938002-0001

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Representations

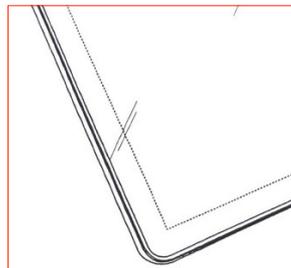
- General Court T 68/10
 - the attachment clip of the contested design, ... do not form part of the elements that are protected by the contested design" and hence must be ignored when assessing the overall impression produced by the RCD.



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Representations

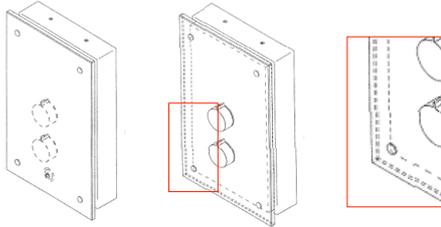
- Samsung vs. Apple (UK High Court)
 - Apple argued these showed a border around the screen under the glass
 - Judge Birss agreed, as did Dutch second instance court



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Representations

Kohler Mira Ltd v Bristan Group Ltd [2013] EWPC 2



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Representations

- In my judgment the dashed lines indicate that design RCD 0002 has a transparent or translucent front face. They show what is visible when looking at the article. The edges of the recess are visible through the front face. The rear chamfered edge of the front face is visible through the face from the front. The axles of the knobs (etc.) are visible through the front face material when viewed from the side. The axles are not visible inside the rear housing and that is why those dashed lines stop when they reach the rear unit.
 - HHJ Colin Birss, January 2013

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Excluded Features

- Recital 10 – Technological innovation should not be hampered by granting design protection to features dictated solely by a technical function. It is understood that this does not entail that a design must have an aesthetic quality.
- Article 8(1) - A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.

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Excluded Features

- R 690/2007-3 Linder Recyclingtech v Franssons



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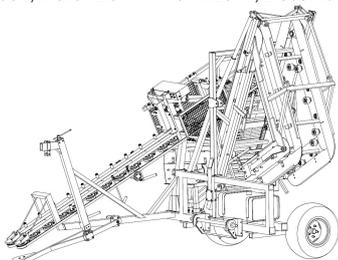
Excluded Features

- Board of Appeal denied protection as all features were solely dictated by function
- Seemed to apply a test from Trade Mark Law, importing the requirement that all the "essential" features of the design had not to be solely dictated by function
- Rejected the "multiplicity of forms test"
 - Can the technical function be achieved by another configuration?

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Excluded Features

ICD 7081, March 2011 - R 971/2011, December 2012



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Excluded Features

- Invalidity Division invalidated the entire design for the combine harvester, as all the essential features were chosen with a view to achieving the best technical performance.
- Overturned decision on a technicality – no objection on absolute grounds (including Article 8) was raised in the invalidation request!
 - However, rest of decision makes it clear that only certain features are excluded from protection and thus consideration

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Informed User – who are they?

- They are:
 - The person who judges overall impression in the tests for individual character and scope of protection
 - Aware of the design corpus
 - Aware of the industrial sector to which the product belongs
 - Aware of the degree of freedom of the designer developing the design

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Informed User – who are they?

- PepsiCo Inc. v Grupo Promer Mon Graphic
 - C-281/10 [2012] FSR 5
- Not the average consumer of TM law or the skilled person of patent law
- Particularly observant
- In this case (for 'pogs'):
 - Child in the age range of between 5 and 10; or
 - Marketing manager in a company that uses pogs as promotional items

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Informed User – who are they?

- Neuman v. José Manuel Baena Grupo, SA
 - C-101/11 P and C-102/11 P
 - Followed previous decision
- In particular, made it clear the informed would carry out a side-by-side comparison of the designs in question
 - Unlikely that the TM test of 'imperfect recollection' appropriate, unless special circumstances apply

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Overall Impression

- This is the key test in determining the individual character and scope of protection of designs
 - Judged by the Informed User
- No clear authority of how to judge this yet
 - But General Court have set out some observations

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Overall Impression

- Not necessary to describe in words
- Less importance in assessment of similarity
 - Features common to the design for the product
 - Similar features where there were design constraints
 - Features not easily perceived by informed user
- More importance in assessment of similarity
 - Similar features where there was design freedom
 - Especially when most visible to informed user

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Summary

- Some clarity is being provided by case law, but there is a long way to go.
- More cases will need to go to the Court of Justice to provide binding precedent on the lower courts

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Any questions?



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