

COPYRIGHT AND DESIGNS

Copyright

Copyright is a legal right, owned by the creator of an original work, to prevent that work being copied by others without permission. Works protected by copyright include drawings, photographs, written works, computer programs, sculptures, music and films.

Copyright does not protect the underlying idea behind the work, only the particular form in which the idea is expressed. Patent protection may be available for the idea if it is technical and sufficiently inventive. Single words and short phrases do not usually involve sufficient creative effort to qualify for copyright protection but it may be possible to register them as trade marks for specific goods or services. Designs for the shapes of three-dimensional products are generally protected not by copyright but by design right, discussed below.

Copyright is infringed by a person who reproduces a “substantial part” of the work so making minor changes will not be sufficient to avoid infringement. Copyright is also infringed by a person who knowingly imports, keeps or sells an infringing copy. However, someone who can prove that he has created a similar work independently, without copying, does not infringe copyright. Action can be taken against infringers in the High Court or in the County Courts. Remedies include an injunction to prevent further infringement, destruction of infringing copies, compensatory damages and recovery of legal costs. Criminal proceedings may also be brought against counterfeiters.

The copyright in a work created by an employee belongs to the employer. However, the copyright in commissioned works usually belongs initially to the creator of the work, and must be specifically assigned in writing if it is to pass to the commissioner. In general, copyright lasts for 70 years from the death of its creator. However, for designs that have been applied industrially, the term of protection is limited to 25 years.

Copyright comes into existence automatically when a suitable work is created and there is no copyright registration system in the United Kingdom. Therefore it is important to keep good records in case it should ever be necessary to prove ownership of the copyright. It is good practice to preserve the original work (including any early drafts) and to mark it with the copyright symbol ©, the date and the name of the copyright owner.

The UK belongs to international treaties that provide automatic protection for UK copyright in most other countries, according to their local laws. The copyrights of those countries are similarly given automatic protection here, according to UK law.

Design Right

Original designs for the shapes of three-dimensional products are protected under UK law not by copyright but by design right (often referred to as unregistered design right, to contrast it with the registered designs discussed below). Design right does not protect surface decoration, principles of construction, or features necessary for one product to fit to or match another one, for example some spare parts.

Infringement of design right is similar to infringement of copyright: it is necessary to show that copying has taken place. The procedures and remedies are also similar. If you believe somebody may be infringing your design right, it is important to seek advice before approaching them. This is because there are provisions whereby you can be sued if you make unjustified threats of legal proceedings.

As with copyright, design right comes into existence automatically when a design document or model is created. There is no registration of design right so it is again important to keep good records. The design right in a work created during employment belongs to the employer. Unlike copyright, the design right in a commissioned work belongs to the person who commissioned it.

A significant difference from copyright is the short term of design right. Protection lasts for only 15 years from the end of the year in which the design was created or 10 years from the end of the year in which the article was first marketed, whichever is the shorter. Moreover, for the last 5 years of protection, competitors are entitled to a licence on reasonable terms. If the terms cannot be agreed, they may be settled by the UK Intellectual Property Office.

Registered Designs

The design of a product (or part of a product) can be registered in the United Kingdom if the design is new and it gives a different overall impression from known designs. It is not necessary for a registered design to have any aesthetic quality, so even functional products can be registered, provided the design is not dictated entirely by the function of the product.

However, the product must be visible in normal use. Examples of registrable designs are the patterns of fabrics and the shapes of garments, toys, household or industrial articles.

The remedies for infringement of a registered design are similar to those for copyright and design right but the registered design is a true monopoly: anyone who makes, imports, sells or uses a product with a similar design infringes the registration, whether they have copied the design or created it independently. Again, you should seek advice before issuing threats against infringers.

An application for a UK registered design must be filed at the UK Intellectual Property Office with a corresponding fee. The fee is reduced for multiple designs in a single application. If you file the application before the design has been made public, you can choose to defer the official publication of the details for up to a year. Alternatively, a valid application may still be filed within a one year “grace period” after the design has been made public. Many countries outside Europe do not allow such a grace period so if you are contemplating foreign design protection, we strongly advise you to consult us while the design remains confidential.

The UK Intellectual Property Office no longer carries out a search for similar earlier designs so the registration procedure may take as little as one month. The registered design can be renewed at five year intervals for up to 25 years in total.

Registered Community Designs

The European Union also provides a registration system for designs. A registered Community design extends throughout the EU and it is not possible to select protection in only certain countries. The laws regarding qualification for protection, the grace period and infringement are essentially the same as for UK registered designs, discussed above.

Applications for registered Community designs must be filed at the Office for Harmonization in the Internal Market (OHIM) in Alicante, which also handles Community trade mark applications. A single application can include more than one design, provided that the products to which the designs are applied are of the same general type (determined by whether they fall in the same one of the 32 classes in the Locarno Classification). This can result in considerable savings if several products are to be protected at the same time.

Unregistered Community Designs

Even without registration, the EU gives automatic, short-term protection to designs that would qualify for registration. The protection lasts for three years from the date on which the design is first made available to the public. The unregistered Community design is therefore particularly suitable for fashion items that have a limited commercial lifespan.

Unlike the registered Community design, in order to succeed in an action taken against an infringer, it is necessary to show that actual copying has taken place. As there is no registration procedure for the unregistered Community design, it is important to keep good records of when a design was created and when it was first made available to the public.

We hope that you will find this general information helpful but this is a complex area of law and we strongly recommend that you seek our advice in relation to any particular case.