

NEW REGISTERED DESIGN LAW COMES INTO EFFECT FROM 28 OCTOBER 2001

Although the UK government has not yet implemented the Directive, it is expected that there will only be a short delay if it has not done so by 28 October 2001.

Main changes

Several changes have been made and most of these make registered designs more attractive for the protection of designs. The main changes are summarised below:

Extended Protection

Under the new law, it is the design itself, which is protected not the article to which the design is applied. Thus under the new law, there will be infringement of the registration if a competitor applies the design to *any* article; this is significantly different to the old law where infringement only occurs if the design is applied to the article defined in the registration.

It is now possible to register designs which were not previously registrable

Under the old law, the design had to be 'industrially applied'. This requirement was introduced in order to exclude from registration works of art such as sculptures and paintings, which were intended as 'one-offs'.

This requirement no longer applies and so designs based upon an artistic work, such as a sculpture or painting, can now be registered. This has important implications for designers wishing to commercially exploit their designs by way of merchandising or limited editions, as it enables a registration to be obtained for licensing.

It also means that designs not usually associated with registered design protection may now be protected, for example, an icon used on a computer screen, or a company logo.

Under the old law, the registration was limited to an entire article; it was not possible to protect only a part of an article. This no longer applies under the new law. It will now be possible to protect a component part of an article. This is important in situations where the component can be used in a variety of articles or where the novelty of the design resides in that component part.

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Market first; register later?

Under the new law it is possible to openly show or sell the design to others to gauge commercial interest before filing the application for registration. The registration will be valid provided that the application is filed within one year of the first open disclosure of the design. This period is commonly referred to as the 'grace period'.

We strongly advise applicants not to rely upon this grace period as a matter of policy and that the current practice of filing an application before openly disclosing the design should still be followed.

This is because other countries may not recognise the grace period and so registered designs filed abroad may be rendered invalid by disclosure during the grace period. Also, if the design is shown to others and they in turn openly disclose the same or a similar design, then their disclosure could prejudice obtaining a valid registration.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

Please note that all our Newsletters can be found on our website at www.eric-potter.com.

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