



Myerson Intellectual Property

Defendant's guide to
design disputes

0161 941 4000
myerson.co.uk
lawyers@myerson.co.uk



myerson

Welcome

Design rights protect the appearance, shape and configuration of a product. Design rights can be registered or unregistered, providing different levels of protection. Design right disputes can happen due to numerous different reasons. However, the fundamental issue in design right infringement cases is whether the original design attracts design right protection and whether other designs are breaching that protection due to them being identical or similar.

Why Myerson?

At Myerson, our expert design right infringement solicitors are here to listen and help you. We have years of experience in dealing with complex design right cases. Due to the complex and technical nature of design right claims, we always review any case on first instruction and provide you with an overview of all potential options available. Our team will make sure you are kept informed and confident about the advice we are giving and you can be certain that we will provide you with the best possible outcome.

Through our many years of service, we have developed close working relationships with trademark and patent attorneys and regularly liaise and work with them on a wide range of intellectual property issues such as design rights and when disputes arise in relation to design rights. These working relationships are a key element and benefit of the service we offer to our clients.

We are proud to be ranked as **'Top Tier'** in the prestigious international directory **The Legal 500** and commended by The Times **'Best Law Firms 2019'**. So, you can be certain that you will be receiving the highest quality legal advice and that we can advise you on complex design disputes.

Myerson is also the Manchester and Cheshire law firm member for the **MSI Global Alliance**, a top 20 ranked, leading, international association of independent professional firms. As the design right matters we deal with often involve an international element, we can call upon the expertise and knowledge of our fellow MSI members to ensure that our client's global interests are protected.

How We Work.

Every client and case is different, and we are here to support you every step of the way.

Personal, Partner-Led Service. Our experienced solicitors get to know you and your business inside out, so we can best advise you. We know that dealing with litigation can be stressful and we aim to take that stress away from you. We strive to become your trusted advisers, providing value and most of all a genuine, personal service.

The Highest Level of Expertise. Combining commerciality, practicality and legal expertise enables us to deal with your design right disputes in the most effective way.

Trust. You are in safe hands. We help clients nationwide with complex design right cases, acting for businesses who are both bringing and defending design right claims. You can rest assured that our expert team knows its stuff!



Your Solicitors



Tim Norman

Senior Partner
Commercial Litigation

0161 941 4000
tim.norman@myerson.co.uk



Vicky Biggs

Senior Associate
Commercial Litigation

0161 941 4000
vicky.biggs@myerson.co.uk



Robert Brothers

Associate
Commercial Litigation

0161 941 4000
robert.brothers@myerson.co.uk

The solicitors that will be working with you are specialists.

All of the solicitors in our Intellectual Property Disputes Team are specialists and have a detailed understanding of design rights and how to handle business disputes involving design rights. Your matter will be handled discreetly and efficiently and overseen by Tim Norman, a Senior Partner in the Commercial Litigation team.

Your team of solicitors will provide practical advice and work with you in order to deal with your design right dispute in the best way possible. This means you can concentrate on what's important, running your business.

You can find out more about our **Intellectual Property Disputes Team by clicking [here](#).**

0161 941 4000
myerson.co.uk
lawyers@myerson.co.uk



Design Right Disputes

What are design rights?

Design rights protect the appearance, shape and configuration of a product and can be registered or unregistered. Design owners can apply for a UK Registered Design mark or a Community Registered Design mark.

A registered design must meet certain criteria and must be:

- Novel;
- Of individual character; and
- Not excluded by statute.

Protection lasts up to 25 years and the rights are renewed every five years. Registering a design is relatively low-cost and is appropriate for industries such as fashion where design is fundamental in recognising and selling the product.

If a design is registered, subject to meeting the criteria, it will have a right against copying. Protection is given at both the UK and EU level. The EU right is much broader but only lasts for three years. The UK right gives ten years' worth of protection from when the product was first marketed.

We always recommend that if you want to register a design right, you seek the assistance of a trademark and patent attorney who can help you with the registration process.

Types of design right infringement.

Design rights give the designer the exclusive right to reproduce the product and to record the design of the product with the purpose of reproducing it. There will be primary infringement of a design right if the designer's design is reproduced or recorded without the designer's permission.

Defences available in a design right infringement claim.

There are certain defences available if you find yourself accused of design right infringement as follows:

- A possible limitation defence exists which means the Court can reject claims in certain circumstances as follows. Design rights last for the lesser of:
 - Either 15 years from the end of the calendar year when the design was first recorded in a design document or when an article was first made to the design; or
 - 10 years from the end of the calendar year when articles made to the design were first made available for sale or hire.
- The Copyright, Designs and Patents Act 1988 (CDPA) provides for any person to be entitled to a licence in the last 5 years of the term of the design right to do anything as regards the design right which would otherwise be an infringement of the right.
- The Crown has certain rights to exploit articles without the licence of the owner of the design right for purposes relating to specified services of the Crown (national or foreign defence or health services), subject to agreed compensation or, failing agreement, as determined by the Court.
- Designs can only be protected as long as they are not commonplace at the time of creation or excluded by any other provision of the CDPA.
- Designs must be original in order to qualify for protection. Although a design could be original in its combination of shape and surface decoration, it could nonetheless fail to attract protection because the CDPA treats the separate aspects of shape and decoration differently, because the former is subject to design right law and the latter is subject to copyright law.
- Design rights cannot subsist until either the design has been recorded in a design document or an article has been made to the design. Ideas which have not been recorded in this way will not (until such time as a record is made) be protected by design right and may only be capable of protection as know-how or trade secrets under the law of confidence.

- Design rights only protect the design as shown rather than the method of achieving it. If the method concerned is an invention, it may well qualify for patent protection. This exclusion is designed to ensure there is no overlap between the scope of design rights and patents.
- Design rights do not subsist in the features of shape or configuration which:
 - Enable the article to fit with another article so that either article can perform its intended function (this is known as the “must fit” exception); or
 - Are dependent on the appearance of another article which forms an integral part (this is known as the “must match” exception).
- Design rights do not subsist in mere surface decoration. Surface patterns which are decorative can be protected by copyright or as registered designs.
- A third-party may challenge the subsistence, the term or the identity of the first owner of a design right.

What happens if you breach design right law?

There are various remedies available to design right holders where design right infringement is proven including:

- Basic or additional damages;
- An injunction to prevent further infringement of the design right;
- An order for delivery up or destruction of the infringing goods; and
- Recovery of costs incurred in bringing the claim.



Don't just take our word for it...

"Myerson Solicitors LLP has a really strong IP team which is growing."

"The Intellectual Property Disputes Team has a lot of experience of litigating unregistered IP rights. They are very strategic and extremely thorough. The team routinely advises on a broad range of disputes relating to trademarks, copyright, patents, confidential information and data protection. They are also skilled at advising on design rights and reputation management issues and are regularly instructed by clients from the arts, media, textile and clothing sectors in the UK and internationally. They are attracting work from a broad range of clients"

"The team represents International Pastry Concepts LLC (a New York based pastry house which invented the Cronuts products that are sold worldwide) on various matters such as enforcing international trademarks"

"The team has always been exceptional in answering all my questions and help to determine what legal counsel is needed, as well as the appropriate steps to solve the issue at hand. I trust their knowledge and abilities to take care of my issues. They are easy to work with and prompt in their responses, which is important in today's fast-paced society. I would highly recommend Myerson Solicitors to anyone seeking legal counsel. I am confident in their legal expertise and the services they provide"

"The team has an excellent way of dealing with clients and managing cases generally, as well as good judgment – they know when to push, and when to take the victory"

To view more Myerson reviews visit our Review Solicitors page by [clicking here](#).

You're in safe hands!

If you would like further information about how we can help you with your design dispute, or if you have any questions, please do not hesitate to contact a member of our Commercial Litigation Team today.

Call: 0161 941 4000

Click: myerson.co.uk

Email: lawyers@myerson.co.uk



 SCAN ME



Because
life is rarely
black and
white.



myerson

THE  TIMES
**Best Law
Firms 2019**

In co-operation with 

**ML
AWARDS
2021**
WINNER

**The
LEGAL
500**
UNITED KINGDOM
TOP TIER

Myerson Solicitors LLP

Grosvenor House, 20 Barrington Road, Altrincham WA14 1HB

Tel: 0161 941 4000 | Fax: 0161 941 4411 |

lawyers@myerson.co.uk | www.myerson.co.uk |  @myersonllp

Myerson is the trading style of Myerson Solicitors LLP, a limited liability partnership registered in England & Wales number OC347078, whose registered office is as above. This firm is authorised and regulated by the Solicitors Regulation Authority number 515754. VAT Registration number 380 4208 70. Any reference to a partner means a member of Myerson Solicitors LLP. A list of members is available for inspection at our registered office.