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# Myerson **Business**

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**Defendant's guide to design disputes**

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# 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.

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 2023**'. So, you can be certain that you will be receiving the highest quality legal advice and that we can advise you on complex copyright issues.

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.



# Design Right Disputes

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## 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 (CPDA) 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 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.



# You're in safe hands!

If you would like further information about how we can help you with **Design Right Disputes**, or if you have any questions, please don't hesitate to contact a member of our **Commercial Litigation Team** today.

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