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Myerson **Business**

Claimant's guide to design right disputes

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Welcome

Copyright protects against the copying and unauthorised use of another's work. It is important to understand what rights you have when you create original work and how you can stop this from being exploited without your consent. Copyright disputes can happen due to numerous different reasons. However, the fundamental issue of copyright infringement is whether the work being disputed was protected and whether the new work is breaching any protection due to similarity.

Why Myerson?

Our expert copyright infringement solicitors are here to listen and advise you, we have years of experience in dealing with complex copyright cases. After we have reviewed your matter, we will provide you with all the potential options available. There are many remedies available, all of which will be discussed with you so you can make an informed decision. Throughout the process, we will stand by your side, making sure that you are effectively protected and fighting for the right 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 copyright 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. You can **find out more about our Intellectual Property Team by clicking here.**



Our guide to 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 specific 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 5 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 10 years' worth of protection from when the product was first marketed.

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.



How to bring a design right infringement claim

Specialist advisers

Design right infringement claims can be extremely technical and complex meaning they are often dealt with by specialist courts in both England and Wales.

For this reason, we always recommend that claimants in design right infringement proceedings instruct specialist intellectual property solicitors. It is also quite common for a specialist intellectual property barrister to be instructed as well, to represent claimants in court.

Letters of claim

If infringement proceedings are contemplated, a claimant should first write a letter of claim to the potential defendant(s).

This letter of claim should put the defendant(s) on notice of a claim and give the defendant(s) a reasonable amount of time (generally between 14 and 28 days but could be up to 3 months in complex cases) to respond to the claims made against them.

The letter of claim must sufficiently identify the design right(s) relied upon to enable the defendant(s) to evaluate them and formulate a view on infringement. The best way to do this is to provide a copy of the design document, or a photograph of the design, and compare this to the infringing design.

All parties involved in design right infringement claims are expected to act reasonably in exchanging information and evidence, prior to court proceedings being issued.



Court proceedings

If the claim cannot be resolved, then it is likely court proceedings will need to be issued. High-value claims for design right infringement are brought in the High Court, specifically in the Intellectual Property List of the Business and Property Courts. Lower value claims are brought in the specialist Intellectual Property Enterprise Court (IPEC) where capped costs operate.

IPEC also has its own small claims track which deals with design right infringement cases which are worth less than £10,000.

Only the owner of the design right can bring infringement proceedings. If the design rights in the relevant design are jointly owned, any of the joint owners can issue a claim.

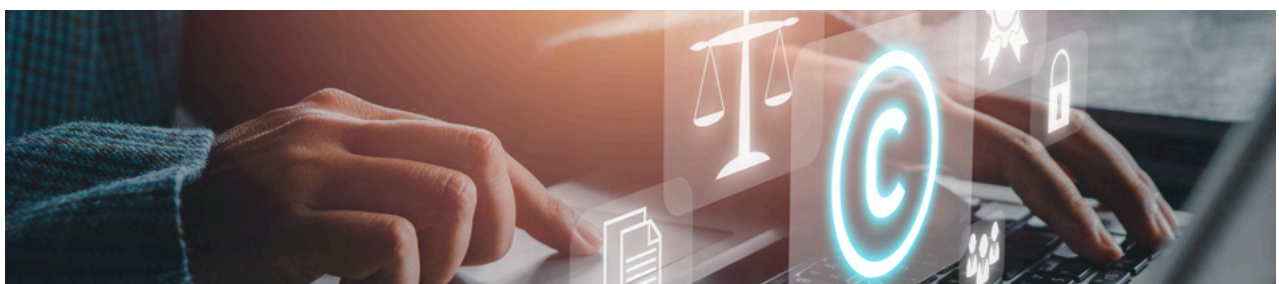
To issue court proceedings, specific court documents will need to be drafted. These are a claim form and particulars of claim.

There will also be a court fee payable to issue court proceedings which depend on the value of the claim and the relief sought. We always recommend that a barrister drafts these documents with assistance from a solicitor, to ensure they comply with the court rules.

These documents will identify the parties, state the cause(s) of action and the remedies sought.

The defendant(s) will then be given an opportunity to file and serve a defence to the claim (generally within 28 days of the court proceedings being issued but extensions of time can be agreed).

After that, the court is likely to order the parties to take the following steps to prepare the case for trial: disclosure of documents, witness statements and experts reports. It is our experience however, that most design right infringement cases settle without the need for there to be a trial.



Remedies for successful claims

The remedies for design right infringement are very similar to the remedies available in other intellectual property infringement claims and include:

- 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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