

# Myerson Intellectual Property

Claimant's guide to  
design right disputes

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# Welcome

We understand the complexities of modern life and the importance of taking care of your business interests. So it's a deep source of satisfaction that so many businesses choose Myerson as their trusted adviser.

## Why Myerson?

At Myerson, our expert design right infringement solicitors are here to listen, help you and 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.

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'**. This means you can be certain that you will be receiving the highest quality legal advice and that we can advise you on complex design right issues.

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 of the service we offer to our clients and which benefits our clients.



# 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 design right disputes in the most effective way.

We are also a member of the Intellectual Property Lawyers Association (IPLA), which is an association of law firms with an established IP department. Our membership provides both us, and our clients, with access to a wealth of knowledge and expertise relating to intellectual property.



# Your Solicitors



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### 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, whilst 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 Team by clicking [here](#).

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# 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.



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

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

*"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 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".*

*"The firm has a huge range of satisfied clients from all over the country, despite not being the most high profile of firms, so they must be doing something right".*

*"The team are phenomenally hard workers who produce first-class written work, even from difficult clients".*

*"Fantastic service and excellent communication throughout the process. I would highly recommend and use their service again".*

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 right dispute, or if you have any questions, please do not hesitate to contact a member of our Intellectual Property Disputes Team today.

**Call: 0161 941 4000**

**Click: [myerson.co.uk](http://myerson.co.uk)**

**Email: [lawyers@myerson.co.uk](mailto:lawyers@myerson.co.uk)**



Because  
life is rarely  
**black** and  
**white.**



myerson



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