



Maximising your unregistered design rights

The end of the Brexit transition period is approaching making it a good time to review your approach for obtaining unregistered design rights in the UK and the EU

Unregistered design rights provide a flexible and accessible approach for protecting the appearance of products. They can come into existence automatically and can be used to stop others from copying your designs. However, the requirements for obtaining unregistered protection in the UK and the European Union (EU) is going to change from 1st January 2021 when the transition period for the UK leaving the EU has come to an end. In light of this, it is worthwhile assessing your approach to unregistered design rights to ensure you are making the most of these useful forms of protection. In relation to registered rights, please see our recent [article](#) for some key considerations.

Effect on existing unregistered Community designs

At present unregistered design protection can be obtained throughout the EU and UK as part of a single right known as an unregistered Community design. This protection lasts three years from the date on which the design was first disclosed. It has previously been held by Germany's Federal Supreme Court that this first disclosure must occur within an EU territory¹. This reference to EU territories encompasses disclosures within the UK during the transition period.

At the end of the Brexit transition period, existing unregistered Community designs will cease to have effect in the UK. Reassuringly, the UK is providing a "continuing unregistered design" right that will automatically come into existence and protect these unregistered Community designs in the UK for the remainder of their three year term. Hence, nothing has to be done to maintain protection in both the UK and the EU for existing unregistered Community designs.

What about future unregistered Community designs?

However, from 1st January 2021, unregistered Community designs may only come into existence when the first disclosure is within the EU (although ambiguity remains about this as discussed below). This will exclude the possibility of benefiting from an unregistered Community design when the first disclosure occurs in the UK.

The UK intends to mirror this stance with its newly-created equivalent UK right known as a supplementary unregistered design. The apparent [intention](#) is that this will require the first disclosure to occur in the UK. It will not be available when the first disclosure occurs in the EU.

[1] Case I ZR 126/06



The upshot is that disclosing your design first in the EU could gain you unregistered Community design rights but stop you from benefiting from the UK's supplementary unregistered design, and *vice versa*. Thus, a choice may have to be made regarding which one you would like to obtain and thus where you will need to disclose the design first.

It could be possible that a simultaneous disclosure in both the UK and the EU, such as via a website directed to consumers in both regions, would allow you to benefit from the unregistered protection in both the UK and the EU. While this seems like a reasonable approach, we will have to wait for further clarification to confirm whether this approach will allow designers to validly take advantage of both forms of unregistered design protection.

Are the disclosure requirements really that strict?

The Court of Justice of the European Union (CJEU) has not had the opportunity to confirm whether unregistered Community designs require first disclosure to occur within the EU.

Ambiguity stems from Article 11 of the Community Design Regulation. This Article provides that unregistered Community designs come into existence when the design becomes known to those in the relevant sector in the EU.

This arguably allows the initial disclosure to occur outside of the EU as long as it leads to knowledge of the design within the EU. This ambiguity was addressed to a certain extent by the introduction of Article 110a that states "*Pursuant to Article 11, a design which has not been made public within the territory of the [EU] shall not enjoy protection as an unregistered Community design*".

Despite the presence of Article 110a, the UK's Intellectual Property Enterprise Court considered there to be enough ambiguity about the geographic aspect of the disclosure requirement to refer a question on this to the CJEU².

This referral was withdrawn following settlement of the underlying case so no ruling was issued on this point but it demonstrates a perceived lack of certainty in relation to the disclosure requirement.

For the UK's new supplementary unregistered design, the uncertainty regarding whether a first disclosure in the UK is actually required is arguably even greater. The relevant UK legislation³ currently has a corresponding provision to Article 11 but lacks a clarifying provision corresponding to Article 110a.

Further clarification on this would be welcome. For now, it is prudent to proceed on the basis that the first disclosure requirements are strict and will require a first disclosure in the UK if UK-based protection is desired, or a first disclosure in the EU if EU-based protection is preferred.

Complementary design rights

In all of the excitement of the changes to unregistered rights mentioned above, it should be remembered that registered protection can be used to complement any unregistered rights. Also, the traditional form of UK unregistered design protection, the Design Right, which protects the shape or configuration of a product is still a possibility. Design Right is available when the designer is resident in the UK or the employer of the designer is a UK company, as well as applying to designers and employers from a limited number of other countries, which will not include the EU member states following the end of the transition period. In light of all of this, taking the time to plan the right strategy will help you achieve the best protection in your countries of interest.

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[2] Beverly Hills Teddy Bear Company v PMS

[3] Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019



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