

## Chapter 2

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# UK national unregistered design right

### Background

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**2.01** Unregistered design right or 'design right' as it is more commonly known, was introduced in the Copyright, Designs and Patents Act 1988 (CDPA 1988) as a means of providing residual protection for functional designs that would not qualify for protection under the RDA 1949. The scope of design right, however, is sufficiently wide so as to encompass designs that might also be registered under the RDA.

**2.02** The right is something of a hybrid, incorporating elements from copyright, registered design and patent law. Overall, the monopoly protection given by a registered design creates a stronger right. The main differences between registered design protection under the RDA and unregistered design protection are as follows:

<b>Registered design</b>	<b>Unregistered design right</b>
1. Subject to official examination at Designs Registry.	Arises automatically subject to qualification.
2. Registrable at Designs Registry.	Not registrable.
3. Must be novel.	Need not be novel but a requirement of 'original' creation; must be created independently and not be 'commonplace'.
4. Infringement does not require copying.	Infringement requires copying.
5. Maximum term 25 years.	Maximum term 15 years.
6. Governed by RDA 1949 as amended.	Governed by Part III of CDPA 1988.
7. In general the rights granted can overlap with unregistered rights.	

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**2.03** The introduction of design right was also intended to represent a commercial compromise from the prior law of design copyright, which reached its apotheosis in *LB (Plastics) Ltd v Swish Products Ltd*<sup>1</sup> with the unnecessarily long 50 year plus life term of protection for purely functional designs and the then 15 years from the date of first marketing term of protection for aesthetic designs capable of registration under the RDA. The intention behind the new right was threefold: to provide a relatively easy means of design protection; to provide for a term of protection not exceeding 15 years from the date of first marketing; and to reach a compromise in respect of the protection of spare parts following *British Leyland Motor Corpn Ltd v Armstrong Patents Co Ltd*.<sup>2</sup>

#### Definition of design right

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**2.04** Section 213 of the CDPA 1988 provides as follows:

- (1) Design right is a property right which subsists in accordance with this Part in an original design.
- (2) In this Part “design” means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article.
- (3) Design right does not subsist in—
- (a) a method or principle of construction,
  - (b) features of shape or configuration of an article which—
    - (i) enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function, or
    - (ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part, or
  - (c) surface decoration.
- (4) A design is not “original” for the purposes of this Part if it is commonplace in the design field in question at the time of its creation.
- (5) Design right subsists in a design only if the design qualifies for design right protection by reference to—

1 [1979] RPC 511.

2 [1986] AC 577, [1986] RPC 279.

- (a) the designer or the person by whom the design was commissioned or the designer employed (see sections 218 and 219), or
- (b) the person by whom and country in which articles made to the design were first marketed (see section 220),

or in accordance with any Order under section 221 (power to make further provision with respect to qualification).

(6) Design right does not subsist unless and until the design has been recorded in a design document or an article has been made to the design.

(7) Design right does not subsist in a design which was so recorded, or to which an article was made, before the commencement of this Part.'

**2.05** It should be noted that 'design right' is merely described as 'a property right which subsists in accordance with this Part in an original design'. It should also be noted that in order to qualify for protection, the design right subsists:

- (1) only if the design qualifies for design right protection by reference to the designer or the person by whom the design was commissioned or the designer employed; or of the person by whom and the country in which articles made to the design were first marketed; or in accordance with any order under s 221 (power to make further provision with respect to qualification);<sup>3</sup>
- (2) unless and until the design has been recorded in a design document, or an article has been made to the design;<sup>4</sup>
- (3) the design was so recorded or an article was made to the design, before the commencement of this Part, ie 1 August 1989<sup>5</sup>

### **Definition of 'design' and infringement**

**2.06** CDPA 1988 s 213(2) states that 'design' means 'the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article'. Helpful interpretation of the meaning of this section is given by Mann J in *Rolawn Ltd v Turfmech Machinery*<sup>6</sup> who pointed out that the right cannot exist until there is an embodiment of the design in an article or in a design document.

**2.07** This definition has given considerable difficulty in practice. This is because the proprietor of the design can choose to assert design right

<sup>3</sup> CDPA 1988 s 213(5).

<sup>4</sup> CDPA s 213(6).

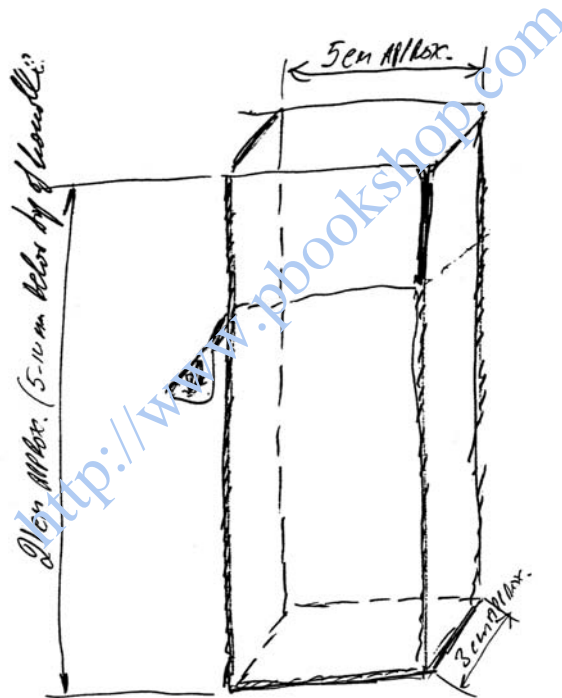
<sup>5</sup> CDPA s 213(7).

<sup>6</sup> [2008] RPC 27.

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in 'the whole or in any part of his product'. Thus in *Baby Dan AS v Brevi SRL*,<sup>7</sup> Jacob J referred to the analogy of a teapot so that the right vests in the teapot as a whole as well as in parts such as the spout, handle, or lid or even part of the lid. It was argued that even if the part in relation to which protection was claimed lacked 'visual significance' it would still be protected.

**2.08** An unfortunate side effect of the definition, which was surprisingly approved by the Court of Appeal in *A Fulton Co Ltd v Totes Isotoner (UK) Ltd*<sup>8</sup> is that infringement may be established in part only of the design, even though the infringing article, when looked at as a whole, could not be regarded as a reproduction of the protected design. That case related to the design of a fabric umbrella case with a slit at the top of one corner of the case.



7 [1999] FSR 377.

8 [2003] EWCA Civ 1514, [2004] RPC 16.



**2.09** The Court of Appeal approved the concept of infringement of part only of the design even though, at first instance, Judge Fysh in the Patents county court had found that the infringing umbrella case, when taken as a whole, did not infringe the claimant's registered design of the whole umbrella case.

**2.10** The practice had grown up (following Laddie J in *Ocular Sciences v Aspect Vision Care*<sup>9</sup>) of pleading unregistered design infringement, not merely in the design as a whole but in 'cropped' or 'trimmed' parts of the design. This, undoubtedly, had the unjust effect of a defendant not being able to evaluate the merits of the claim against it nor of establishing whether the defendant's design infringes until the claim against it is fully pleaded or at the least fully set out in an initial demand letter.

<sup>9</sup> [1997] RPC 289 at 422.

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**2.11** The point was considered again by the Court of Appeal in *Dyson Ltd v Qualtex (UK) Ltd*<sup>10</sup> where the court followed *A Fulton v Totes Isotoner (UK) Ltd* but stressed there must be a ‘limit.’

**2.12** Jacob LJ gave the leading judgment in both appeals and stated in *Dyson*:

‘So I turn to the individual points argued, of which this was the first. UDR can subsist in the “design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article”. This is extremely wide – it means that a particular article may and generally will embody a multitude of “designs” – as many aspects of the whole or part of the article as can be. What the point was of defining “design” in this way, I do not know. The same approach is not adopted for ordinary copyright where the work is treated as a whole. But even if with this wide definition, there is a limit: there must be an “aspect” of at least a part of the article. What are the limits of that? I put it this way in *Fulton v Totes* (2004) RPC 16:

“The notion conveyed by ‘aspect’ in the composite phrase ... is ‘discernible’ or ‘recognisable’.”

**2.13** In response to counsel’s argument that the limit was more extensive, and following a reference to the unreported case of *Volumatic Ltd v Myriad Ltd*<sup>11</sup> where the judge adopted a copyright type case of ‘visual significance’, Jacob LJ continued:

‘That is alright for features of shape provided one remembers that UDR can subsist in an aspect of part of an article. The test does not mean that one can simply forget an aspect of the design or the whole article on the grounds that it is a visually insignificant feature of the design of the whole article. If one focuses on that aspect consisting of the alleged “twiddle” alone, it is difficult to see how it can be visually insignificant. That is why I prefer my formulation.’

**2.14** Jacob LJ also recognised that design right can subsist in aspects of detail because they are ‘aspects of part of an article’ and so qualify within CDPA 1988 s 213(2). He justified that view by saying that it ‘hardly lies in the mouth of an exact copyist to say that the exactitude with which he has copied does not matter visually’. With respect that may be the position with regard to ‘exact copies’ but arguably does not justify the position when a particular ‘aspect’ of an article only has been taken.

<sup>10</sup> [2006] EWCA Civ 166, [2006] RPC 31.

<sup>11</sup> Sir John Vinelott, 10 April 1995.

### Exceptions to design right

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**2.15** Unregistered design right does not subsist in the following.

*A method or principle of construction*<sup>12</sup>

**2.16** This was considered in *A Fulton Co Ltd v Grant Barnett Ltd*<sup>13</sup> where Park J considered that the design (of an umbrella case) was based on the shape or configuration produced by methods of construction of the design. Park J (whose remarks were approved by the Court of Appeal in *Landor & Hawa International Ltd v Azure Designs Ltd*<sup>14</sup>) stated:

‘The fact that a special method or principle of construction may have been used in order to create an article with a particular shape or configuration, does not mean that there is no design right in the shape or configuration. The law of design right will not prevent competitors using that method or principle of construction to create competing designs ... as long as the competing designs do not have the same shape or configuration as the design right owner’s design has.’

**2.17** Behind the Court of Appeal’s reasoning in *Landor & Hawa* was the view that CDPA 1988 s 213(3)(a) should be construed narrowly and that it did not apply merely because a design served a functional purpose. It would not apply unless it could be shown that the functional purpose could not be achieved by any other means.

**2.18** In giving the leading judgment, Neuberger LJ stated:

‘In my opinion, the Judge’s interpretation of section 213(3)(a) is correct. First the section does not, as a matter of ordinary language, preclude a design being protected merely because it has a functional purpose. The language is perhaps a little opaque, but the words “method or principle” are important, and serve, in my view, to emphasize that mere functionality is quite insufficient to exclude a design from protection. Tempting though it may be to seek to redefine or expand on those words, I think it would normally be unhelpful in practice, and arguably wrong in principle, to do so, save to explain in a particular case why they do or do not apply.’

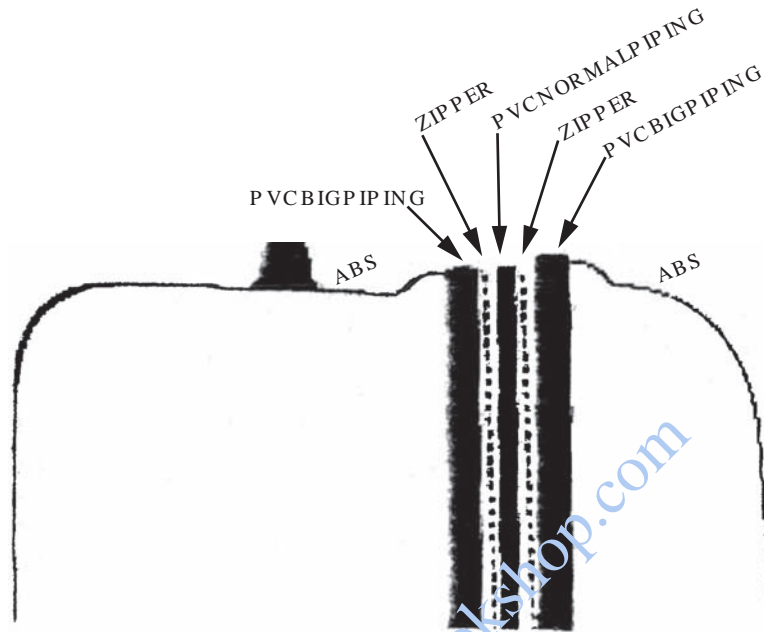
**2.19** That case arose as a result of a dispute about the design of a type of suitcase having an ‘expander’ section. The main issue was whether design right protection was excluded because the expander section constituted ‘a method or principle of construction’.

<sup>12</sup> CDPA 1988 s 213(3)(a).

<sup>13</sup> [2001] RPC 16, (2001) 24(1) IPD 24003.

<sup>14</sup> [2006] EWCA Civ 1285, [2007] FSR 9.

**2.20** UK national unregistered design right



*The 'must fit' and 'must match' exceptions*

**2.20** Features of the shape or configuration of an article that enable the article to be connected to or placed in, around or against another article so that either article may perform its function, or which are dependent upon the appearance of another article of which the article is intended by the design to form an integral part, constitute the so-called well-known 'must fit' and 'must match' exceptions.<sup>15</sup>

**2.21** Features of articles that are dictated by the need to fit or interface with each other so that the two together can perform their intended function, eg car mechanical parts such as an exhaust pipe, or which are dictated by the appearance of another part with which it is required to form an integral whole, such as car body parts, are excluded from design right protection. These exceptions were influenced by the 'spare parts exception' as expounded by the House of Lords in *British Leyland Motor Corp'n Ltd v Armstrong Patents Co Ltd*<sup>16</sup> and in an attempt to reach a compromise in respect of spare part protection with the new right, the unregistered design right.

<sup>15</sup> CDPA 1988 s 213(3).

<sup>16</sup> [1986] AC 577, [1986] RPC 279.



THE 'MUST FIT' EXCEPTION<sup>17</sup>

**2.22** CDPA 1988 s 213(3)(b)(i) provides that:

'Design right does not subsist in—

- (b) features of shape or configuration of an article which—
  - (i) enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function, ...'

**2.23** This subsection sets out the so-called 'must fit' exception even though the section does not specifically refer to a concept of 'must fit'.

**2.24** The leading authority is the Court of Appeal decision in *Dyson Ltd v Qualtex (UK) Ltd*.<sup>18</sup> The Court of Appeal accepted propositions set out in the judgment of the trial judge, Mann J.<sup>19</sup> These are as follows:

- (1) It does not matter if there are two ways of achieving the necessary fit or connection between the subject article and the article to which it fits or with which it interfaces. If the design chosen by the design right owner is a way of achieving that fit or interface, then it does not attract design right no matter how many alternative ways of achieving the same 'fit' might be available. The article with which the subject article is interfacing can be part of the human body.

In that case, triggers and a catch were designed to interface with the human finger or thumb. (The judge relied upon the earlier decision of Laddie LJ in *Ocular Sciences Ltd v Aspect Vision Care Ltd*<sup>20</sup> who had held that the design of contact lenses was excluded from protection because they were designed to fit with the eyeball which was an 'article', albeit living.)

- (2) The exception excludes design right even if the relevant part of the design performs some function other than the function described in CDPA 1998 s 213(3)(b)(i).

The subject matter of *Dyson v Qualtex* were spare parts for Dyson vacuum cleaners and in particular spare parts known as 'pattern parts'. These are replicas of the original parts made deliberately so to look as close as possible to the original parts.

<sup>17</sup> CDPA 1988 s 213(3)(b)(i).

<sup>18</sup> [2006] EWCA Civ 166, [2006] RPC 31.

<sup>19</sup> [2004] EWHC 2981 (Ch), [2005] RPC 19.

<sup>20</sup> [1997] RPC 289, (1997) 20(3) IPD 20022.