

Guidance on answering the discussion questions in the book

Para 8.29

To what extent does the definition of ‘product’ mean that there are overlaps between registered design and copyright subject matter?

Remind yourself of the definition of ‘product’ at para 8.25. The subsequent discussion is meant to show how many things that we have already discussed as copyright subject-matter – graphic art, typefaces, three-dimensional artistic works – are also now protectable as registered designs. So there is considerable although not total overlap.

Para 8.44

In what circumstances is the test of novelty likely to dispose of an invalidity challenge?

Why is the test of individual character likely to be more important in practice?

The test of novelty will dispose of an invalidity action when the prior design relied upon is identical to the contested design or so nearly identical that any differences can be said to be ‘immaterial’. This is likely to be relatively rare – although it could arise, for example, if the design rightholder has inadvertently launched his design onto the market to a timeframe which falls outside the 12-month pre-filing ‘grace period’ (see paras 8.75-8.76). The test of individual character is likely to be more important in practice because it will need to be met even if a contested design survives a novelty challenge. A design challenged for lack of individual character will be vulnerable to a much wider and broader pool of earlier designs.

Para 8.66

Now that you have considered the leading case law as well as the legislative wording, what factors do you think are to be taken into account in assessing a design's 'individual character'?

- The appearance of the product and the overall impression it creates on the informed user, especially (although not exclusively) when in use.
- Design freedom – what are the constraints on the designer given the nature of the product and other relevant factors identified in the case law?
- Relation to the existing design corpus – to compare overall impression with prior designs and to give context to the evaluation of the nature of the product, design freedom and the impact of similarities/differences on the informed user. This may include consideration of the 'saturation' of the state of the art – that is, the argument that the informed user will be more attentive to differences in detail if the relevant design field is a crowded one, with the result that smaller design differences may create a different overall impression.

Para 8.71

Who is being 'safeguarded' by this rule?

In a nutshell, designers based in Europe.

Para 8.78

Once a design has been disclosed, whether with or without the consent of the designer, what advice would you give the designer with regard to the registration of that design?

To register within 12 months of the date of disclosure if the designer wants to have the benefit of the monopoly right conferred by registered design protection. If a registered design is applied for *after* the 12 month grace period has expired, the novelty and individual character of the design is most likely to have been lost and the design will not be registrable.

The advice should also explain that, separately from any questions over registered design protection, there may be Community unregistered design right protection in the design (see Chapter 9 generally for the rules governing when Community unregistered design right will subsist). The protection conferred by Community unregistered design right is narrower than that conferred by a design registration in that it protects against copying only and lasts for the much shorter period of only three years. The client would need to consider whether this form of protection was sufficient for their purposes.

Para 8.90

Can you think of any immoral designs, or designs contrary to public policy?

There is no definition of ‘public policy’ or ‘morality’ in the Directive or Regulation. The EUIPO’s Guidelines for the examination of applications for registered Community designs gives designs that portray or promote violence or discrimination based on sex, racial or ethnic origin, religion or belief, disability, age or sexual orientation as examples which would be contrary to public policy, and designs which reach a certain level of obscenity or

offensiveness as examples which may be immoral. However, the EUIPO's Guidelines emphasise that 'bad taste' is not a ground for non-registrability. See section 4.2 of the Guidelines currently available at:

<https://euipo01app.sdlproducts.com/1004805/904210/designs-guidelines/4-2-public-policy-and-morality>.

Para 8.92

Can you give any other examples of complex products?

There are lots of other examples, from all sorts of different design fields: computers, printers, household and office furniture, cars, bicycles, household appliances, industrial equipment and so on.