

HISTORY OF REGISTERED DESIGN LAW IN THE UK TO 1988

8.10 Design law was invented in the UK and traces its origins back to the Calico Printers Act 1789. That Act gave two months' protection against imitation to persons producing 'any new and original pattern . . . for printing linens, cottons, calicos and muslins'. At this stage, there was no need for registration, and the focus was merely on the two-dimensional and the textile industry. Fifty years later, however, inspired by a desire to improve the competitiveness of British industry in general by the adoption of better and more effective product design, the scope of the 1787 Act was extended to include patterns on other forms of fabric (Copyright of Designs Act 1839). At almost the same time another Act created the first register of designs, in which not only fabric patterns, but also the three-dimensional shape and configuration of any article of manufacture, could be registered for a period of protection lasting between one and three years (Design Registration Act 1839).

8.11 In the 1840s further statutes extended the range of designs that could be registered for protection, but also created a distinction between designs which were 'ornamental' and those which were of 'utility' (or non-ornamental) (Ornamental Designs Act 1842; Utility Designs Act 1843). The 1842 Act sought to confine registration to ornamental designs, that is, those which added something to the product over and above the performance of its function; while the 1843 Act allowed a special form of registration for utilitarian designs, from which ornamental designs were excluded.¹

Question:

What distinction between designs was introduced into the law by the Acts of 1842 and 1843, and what was its purpose?

¹ See on this history, Bently and Sherman, Part 2.

8.12 As the law and practice developed through the remainder of the 19th century and into the early years of the 20th, however, the approach of allowing registration of both ornamental and utilitarian designs was reversed. In 1919 the Patents and Designs Act provided that registration would be granted to new and original designs for the pattern, ornament, shape and configuration of articles of manufacture if the designs were for features which in the finished article ‘appeal[ed] to and [were] judged solely by the eye’. The Act also excluded from the definition of design ‘any mode or principle of construction, or anything which is in substance a mere mechanical device’. The utilitarian was therefore clearly on its way out of the scope of protection.

Registered Designs Act 1949

8.13 The process of excluding the utilitarian or functional design from registration was completed by the Registered Designs Act 1949, which recast the exclusion of the 1919 Act (above) so that features of the design ‘dictated solely by the function’ to be performed by the article to be made in that shape or configuration were not designs and not registrable.

Question:

How were designs distinguished by the 1949 Act, and to what effect?

8.14 The result of UK developments in the 20th century, therefore, was that to be registrable, industrial designs had to have ‘eye appeal’, while designs that were ‘functional’ were excluded from registration. The distinction thus made seems to cut across what product designers were coming to see as valuable in a design. Their view was increasingly that ornament, pattern and design not associated with function were to be abjured; the object of good design was to produce articles fit for their purposes. Art and utility were not in conflict; art lay in finding the form and materials appropriate to the function the object was to perform.

In the meantime, however, designs legislation was laying increasing emphasis on protecting only the non-functional elements in a design.

8.15 Other important elements of the law under the Registered Designs Act 1949 were:

- The designs had to be new and original. While ‘original’ here had probably the same meaning as in copyright law (that is, independently produced, not copied), the additional requirement of ‘new-ness’ or ‘novelty’ added several possible shades of meaning:

‘A design may be new in an absolute sense in that the shape or pattern has never been seen before; or it may be new in the limited sense that the shape or pattern is already known, but only in a context different from that now contemplated. Also, a design may be new in that it differs from known designs, but in a more restricted sense it may lack novelty because the difference is of an inconsequential nature.’²

Novelty was however generally a more restrictive requirement than the traditional copyright test of originality, inasmuch as with the latter something may be original if it is produced by independent skill and labour, even though the end result is similar to an existing work. The requirement also meant that the owner of the design could not test the market for products made to the design in advance of registration, because publication in this way would deprive it of novelty.

- The designs had to be *applied industrially*, meaning ‘applied to more than fifty articles’ (Copyright (Industrial Process and Excluded Articles) (No 2) Order, SI 1989/1070).
- Registration gave the owner of the design an *exclusive right for up to three successive periods of five years from the date of registration*. The maximum period of protection was thus *15 years*, but the registration lapsed if it was not renewed at the end of any five-year period during which it had subsisted.

² AI Morris and B Quest, *Design: The Modern Law and Practice* (1987), 108.

- The exclusive right given by registration was to sell, make and import articles to which the design has been applied; that is, it was a monopoly right in the design, and it was not necessary to prove copying of the design for there to be infringement.

8.16 The distinction between eye appeal and functionality gave rise to much complex and, on occasion, entertaining litigation. The most diverting cases were those about the designs for chocolate eggs and digital watch faces, in both of which the design in question was normally invisible. For the egg it was the design of inner and outer layers of the egg shell in contrasting tones of brown and white; for the watch it was the design of the liquid crystal display. It was argued that neither could ‘appeal to the eye’ as a result of their invisibility; it was held that the appeal to the eye had to be tested when the article was in use: with the egg, when it was being eaten, with the watch, when the display was lit up.³

8.17 The leading cases on eye appeal and functionality were *Amp v Utilux*,⁴ decided by the House of Lords, and *Interlego v Tyco Industries*,⁵ a ruling of the Privy Council on an appeal from Hong Kong. Where *Amp* was primarily about functionality, *Interlego* concentrated on eye appeal.

³ See *Ferrero and CSPA’s Application* [1978] RPC 473; *KK Suwa Seikosha’s Application* [1982] RPC 168.

⁴ [1972] RPC 103.

⁵ [1989] AC 219.

Amp v Utilux [1972] RPC 103

The issue in *Amp* was the registrability of a design for electrical terminals used in washing machines. The terminals were shaped to enable them to hold electric leads.⁶ It was held that the design was dictated solely by function, even though it was possible to design the terminal in other ways in which it would still carry out its function. Accordingly it was not registrable. ‘Dictated solely by function’ did not mean that a design was unregistrable only if it was the one possible design, which had been the previous understanding of the law; it meant simply that the features of the design were there for the purpose of function alone. The features of the terminal were dictated solely by function in this sense. The test thus stated changed the law; as a result, many designs hitherto regarded as registrable ceased to be so.

Further it was held that the design had no eye appeal; none of its features were there to attract the attention of the customer. True, the functionality of the design might appeal to customers considering the utility of the article but, in the view of the majority in the House of Lords, this was not how the test of eye appeal should be applied. Eye appeal meant that to be registrable the design should have features going beyond functionality and there to catch the eye of the customer. *Amp* established that the eye in question is that of the customer and that the appeal has to be through features calculated to attract custom. A design will be registrable when only some of its features are functional and others have eye appeal – the exclusion only operates when a design is wholly functional. A design will be taken as dictated solely by function even if the function could equally well be performed by an article in different shape.

⁶ The designs and photos of the terminals are available at [1970] RPC at pp 399–401.

Interlego v Tyco Industries [1989] AC 217

The problem which the court had to overcome to reach this conclusion was encapsulated thus by Lord Oliver:⁷

‘Inevitably a designer who sets out to make a model brick is going to end up by producing a design, in essence brick shaped . . . There is clearly scope in the instant case for the argument that what gives the Lego brick its individuality and the originality without which it would fail for want of novelty as a registrable design is the presence of features which serve only the functional purpose of enabling it to interlock effectively with the adjoining bricks above and below.’

At the same time, however, the design clearly had eye appeal and Lord Oliver was able to hold that this was not by chance, the evidence led in the case showing that attraction of the customer had been a factor in the mind of the designer. The conclusion of the court was that if all the features of a design were dictated by function and eye appeal was fortuitous, there could be no registration. In considering the fortuitousness or otherwise of the eye appeal, the intention of the designer was relevant, although not conclusive.

1988 amendments to the Registered Designs Act 1949

8.18 The Copyright, Designs and Patents Act 1988 made several significant amendments to the Registered Designs Act 1949, with a view to making registration of designs more attractive to users. To be registrable a design still had to have eye appeal and not be functional. The *Amp* decision, that the eye in question was the eye of the customer, was

⁷ [1989] AC 217 at 248.

reinforced by a further test for registration, namely, whether the article to which the design was to be applied was one where appearance was not material. Appearance was not material ‘if aesthetic considerations are not normally taken into account to a material extent by persons acquiring or using articles of that description and would not be so taken into account if the design were to be applied to the article’.⁸ This would plainly have applied to exclude the design for a terminal in a washing machine, whereas an application for a Lego or other toy brick would not be rejected on this ground.

8.19 The 1988 amendments also included an extension to the maximum period for which registered designs could be protected: from three to five five-year periods, that is, to a possible 25 years in total.

Question:

What were the main changes to the 1949 Act made by the 1988 Act?

8.21 Two cases in 1988 further demonstrated the problems caused by varying national laws on designs. *Consorzio Italiano della Componentistica di Ricambio per Autoveicoli v Regie Nationale des Usines Renault*⁹ and *AB Volvo v Erik Veng (UK) Ltd*¹⁰ both concerned design rights in spare parts for cars (a subject matter to which we will return later: below, paras 8.60–8.80). The Renault case came from Italy, the Volvo one from the UK. In Renault the French car company held design patents under Italian law which it was using to prevent Italian motor vehicle spare parts suppliers manufacturing and selling parts for Renault cars. In Volvo the subject matter of the dispute was a registered design for the front wings of Volvo series 200 cars. Volvo were using UK registered designs for these parts to prevent Veng from

⁸ RDA 1949, s 1(3), added by CDPA 1988, s 265.

⁹ Case 53/87, [1988] ECR 6039.

¹⁰ Case 238/87, [1988] ECR 6211.

importing panels from Italy into the UK.¹¹ In both cases the European Court of Justice reaffirmed the earlier decision that it was not infringement of Community rules on free movement of goods to use the rights conferred by design registration to prevent the manufacture, sale and import of protected products by unauthorised third parties. The Court also held that there was no abuse of a dominant position in the right holders' refusal to grant licences to third parties.

Question:

What was the effect of the decisions in the *Renault* and *Volvo* cases?

¹¹ Some panels manufactured in Taiwan were also imported into the UK from Denmark.