

REGISTERED DESIGNS: THE NEW LAW

A design registration protects the appearance of a product, states ownership and gives the owner the right to take action against anyone making, using or selling the design without permission. Significant amendments have been made to the scheme of registered design protection under the Registered Designs Act 1949 as a result of the Registered Designs Regulations 2001 which came into force on 9 December 2001.

- A design is now defined as "the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation". Practical examples of designs which could be registered under the new law include patterns, shapes of goods and visual features such as computer icons.
- The new law will also permit the registration of the appearance of a component part of a product provided that the component is visible during normal use.
- The scope of protection given by the new law is for the design itself and not for the application of that design to a particular product. It will no longer be necessary to complete a separate application for each product to which a design (e.g. a pattern) is applied.
- The definition of product has been extended to include handicraft items. "One-off" items can, therefore, now be registered as well as articles made by an industrial process.
- There is no longer a requirement that the design be aesthetically pleasing but the design must have "individual character". A design will have individual character "if the overall impression it produces on the informed user differs from the overall impression on such a user by any design which has been made available to the public before the relevant date".
- It should be noted that registered design rights will not subsist in features of appearance of a product which are dictated solely by the product's technical function or in mechanical interface features.
- A design must pass a novelty threshold before it will be registered. Unless the disclosure could not have reasonably been known in the normal course of business to persons specialised in the sector concerned and operating within the EEA, disclosure will count against registration.
- However, there will be a twelve month grace period for disclosure made by the designer prior to filing an application for a design allowing designers to test public reaction and seek funding without fear of losing novelty. The twelve month grace period is retrospective and will apply to designs which were published within the twelve months preceding 9 December 2001.



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IN THIS ISSUE

REGISTERED DESIGNS : THE NEW LAW



TRADE MARK REGISTRY RELAXES
PRACTICE RULES



SALE OF GOODS LEGISLATION
TO BE AMENDED



TRADE MARK REGISTRY RELAXES PRACTICE RULES

The United Kingdom Trade Marks Registry has announced that it is to relax its practice rules on "descriptive marks" following a decision of the European Court of Justice in late 2001.

The Office for Harmonisation in the Internal Market or "OHIM" is the body responsible for Community Trade Marks and, historically, has applied a liberal approach when examining a trade mark application for distinctiveness. More recently and, as a result of some criticism, OHIM has followed the practice of the United Kingdom Trade Marks Registry and applied a stricter test in assessing whether a proposed trade mark should be refused registration on grounds that it is lacking distinctiveness.

A judgment of the ECJ in late 2001 has endorsed the more liberal approach first taken by OHIM. The Procter & Gamble Company filed a CTM application for the mark "BABY-DRY" for nappies and disposable diapers. OHIM refused the application on grounds that the term BABY-DRY was non-distinctive and descriptive of nappies and diapers that kept babies dry.

Procter & Gamble appealed. The ECJ decided that whilst the mark BABY-DRY did allude to characteristics of Procter & Gamble's goods it was not directly descriptive of the goods. The test applied by the ECJ was whether the combination of words comprising the trade mark could be viewed as a "normal way of referring to the goods or of representing their essential characteristics in common parlance". The purpose of refusing a trade mark on grounds that it was descriptive or non-distinctive was to prevent registration of a term which was the usual or a common way of designating those goods or services or their characteristics. An application for "ABSORBENT NAPPIES" would be an obvious example of an application that would be properly refused. The trade mark BABY-DRY, however, was considered to be an unusual juxtaposition and not a recognised expression in the English language and was accordingly allowed to proceed to registration.

The effect of this decision of the ECJ and announcement of change in practice of the United Kingdom Trade Marks Registry will make it easier to register as trade marks terms which allude to characteristics of the goods or services applied for but which are not directly descriptive of those goods or services.

SALE OF GOODS LEGISLATION TO BE AMENDED

The law governing the sale of goods to consumers is set to change.

In May 1999 the European Commission approved a Directive that confers a minimum level of consumer protection rights on all European citizens. Consumers in the United Kingdom already benefit from rights granted under the Sale of Goods Act 1979 and associated legislation which exceed many of the requirements of the Directive, but changes to consumer protection legislation in the United Kingdom will nevertheless be required. The key changes are:

- for the first six months after a consumer has bought a product, the burden of proof will be reversed if the product turns out to be faulty so that the seller will have to show that the product was as described in the contract at the time it was sold;
- any guarantees offered by manufacturers and/or retailers will be legally binding, must be in plain English and must be provided in writing on request;
- remedies which have been available in practice for some time will become enshrined in statute - consumers will have the right to insist that goods are repaired or replaced or, if a repair or replacement is not economical or practical, that the purchase price is reduced. The right to reject goods which are not of satisfactory quality will remain; and
- retailers will be liable for statements made by manufacturers in their advertising and labelling unless the retailer can show that it was not aware of or had corrected the statement or that the consumer's decision to buy was not influenced by the statement.

Member States were due to have amended their national laws by 1 January 2002. The UK Government missed this deadline and is carrying out a second round of consultation. It is expected that the necessary changes to our law will be implemented later this year.



INFORMATION

**If you have any queries on commercial law please contact:
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This bulletin is for the use of clients and will be supplied to others on request. It is for general guidance only, and provides useful information in a concise form.

Action should not be taken without obtaining specific advice.

We hope you have found this bulletin useful. If, however, you do not wish to receive further mailings from us, please write to Mrs. Pat Coyle, Rollits, Wilberforce Court, High Street, Hull, HU1 1YJ.

**The law is stated as at 1 May 2002
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