

Broader Design Protection in UK

From 9th December 2001, the protection available to designs in the United Kingdom has increased, following implementation of the EU Designs Directive. This additional protection will be of interest to all trade mark owners whose marks contain prominent design features such as patterns or ornament or consist of 3-D designs such as shapes.

Moreover design registrations will now be granted for the design itself rather than as applied to a particular named object or item. The scope for protection is thus considerably enhanced.

What is registrable?

In summary, a registrable design now includes all two or three-dimensional features of the appearance of the whole or part of a product, including its shape, colour, texture or ornamentation. Practical examples of designs which could be registered include patterns applied to clothing or fashion accessories, colouring applied to packaging, shapes of goods and visual features such as computer icons.

Although the design should have "individual character" in order to qualify for protection and to distinguish it from any prior registered design there is no longer a requirement that it should be aesthetically appealing. Accordingly functional designs may also be registered.

Prior disclosure

In the past, if the design had been disclosed to the public before protection was filed, the application was invalid; the new law provides for a 12 month grace period during which disclosure to the public will not deny the designer the opportunity of protecting it. This provision is clearly useful in the

case where the designer wants to test public reaction to the design or obtain funding from potential investors before committing to a design filing. The grace period comes into effect from 9th

December 2001 and any disclosures made in the previous 12 months will therefore not invalidate design filings on or after that date.

Procedures

The procedure for registering designs in the United Kingdom is inexpensive and straightforward; the basic filing fee is £60 and there are no conflict searches by the Designs Registry before registration is granted. If the design satisfies the registrability criteria, proprietors can expect to secure registration within three to six weeks.

Comment

Registered design protection is likely to be of particular interest where the trade mark owner has adopted a mark with design features of a type unlikely to be acceptable to the UK Trade Mark Registry without evidence of prior use. In future, interim protection can be obtained by filing for a registered design, leaving the trade mark owner the option to consider trade mark protection further down the line, when evidence of secondary meaning and reputation has been acquired.



Revocation – the defence under Section 46(2)

When a registered trade mark is challenged for non-use, the proprietor may argue that he has used an equivalent or variant mark which, despite not being exactly in the form as registered, should be treated as not substantially different. The statutory test is that the use should be of a mark "in a form differing in elements which *do not alter the distinctive character* of the mark in the form in which it is registered". This point was recently considered by the High Court in revocation proceedings by Anheuser-Busch, Inc. against a registration of the BUDWEISER BUDBRAU device mark shown below (fig.1):



Although the registered proprietor, Budejovicky Budvar, Narodni Podnik, admitted that they had never used the mark, they filed evidence of use of a different mark, which had been registered separately. A representation of the second mark is shown overleaf (fig.2).

The Registry Hearing Officer considered that the proprietor's use of the second mark was use of a variant within the provisions of Section 46(2). He also accepted use of the mark

BUDWEISER BUDBRAU in upper case (block type) as within the section. Anheuser-Busch appealed this decision to the Appointed Person who referred the matter to the High Court as involving a point of general legal importance, namely the proper construction of Section 46(2).



In construing the test of whether an alteration affected the mark's distinctive character, Simon Thorley QC, sitting as deputy High Court Judge concluded that the alteration need not

registered proprietor as an immaterial variant did not include two out of the four elements which he had identified as contributing to the distinctive character of the first registered mark. As such he had no hesitation in holding that use of the second device mark did not satisfy the test under Section 46(2).

Similarly, in the case of the proprietor's further claim that use of the words BUDWEISER BUDBRAU in upper case script was sufficient, the absence of the further distinctive elements identified by the judge as forming part of the registered mark led him to conclude that the test in Section 46(2) had not been satisfied.

Comment

This case provides the first clear guidance from the courts on how to interpret Section 46(2) in cases where the registered mark features graphic elements and the use relied on is for the mark in a different version, or in plain block type. The narrow construction of the defence to non-use adopted by the judge is in line with the "use it or lose it" mentality which prevails at Community level.

In practical terms, trade mark proprietors should always ensure that they use the mark *in the form as registered*, to avoid non-use challenges from third parties. If they have altered the registered mark, and no longer use that form, then steps should be taken to refile and register the revised form of mark currently in use.

be "substantial" before it had this result; he thus placed a narrow construction on the statutory wording.

The judge considered how the court should set about the task of assessing what the distinctive character of the mark is; he concluded that it was not possible to state in general terms what it is that gives any particular mark its distinctive character and that the elements of any such mark must be assessed separately.

However in the case of a mark which has graphic or design features (such as that under consideration) it was appropriate to regard the stylised elements as being there for a purpose, namely to enhance the distinctiveness of the mark.

Having decided on a narrow construction the judge identified four elements in the registered mark in issue and concluded that they all contributed to the overall distinctive character. He concluded that the second device mark relied on by the

UK Registry Practice – Extensions of Time in Oppositions

Responding to concerns expressed by users about their handling of extension of time requests, particularly in opposition proceedings, the Trade Mark Registry have issued a new Practice Note. This emphasises the need to provide full and detailed reasons for any request for extension of the statutory periods provided for conduct of opposition proceedings. If the request is refused by the Registry, and a Hearing appointed to discuss this refusal, the person making the request will not be permitted to enlarge on the reasons given in the original request at the Hearing.

Where the parties are seeking to negotiate a settlement, the Registry may consider a request for a stay of the opposition proceedings, provided that they consider this to be in the public interest. Such a stay may be for a lengthy period. e.g. 12 months, although if the parties fail to conclude a negotiated settlement within that time, the subsequent timetable for conduct of the opposition will be applied rigorously.

The Registry have reiterated that they try to be flexible when considering extension of time requests, and have urged parties to take advantage of the statutory "cooling-off" period set out in the new opposition procedure to try and settle any conflicts at an early stage. However, if parties fail to prosecute their case in a timely manner, or provide insufficiently detailed reasons or justifications for why extensions of time are necessary, the Registry cannot be expected to view such requests with a sympathetic eye.



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Website: www.dyoung.com
Email: mail@dyoung.co.uk

21 New Fetter Lane, London EC4A 1DA Tel: +44 (0) 20 7353 4343 Fax: +44 (0) 20 7353 7777

Briton House, Briton Street, Southampton, SO14 3EB Tel: +44 (0) 23 8071 9500 Fax: +44 (0) 23 8071 9800