

Guidance on answering the discussion questions in the book

Para 9.31

Refer to the discussion above about electronic circuit diagrams, then consider how such diagrams differ from the designs of child safety barriers as revealed in the *Baby Dan* case. Why are the relative locations of the component parts of the latter not ‘configuration’ when electronic circuit diagrams apparently are? Can this outcome be justified?

It is hard to avoid the conclusion that one or other of *Mackie* and *Baby Dan* must be wrongly decided. It is suggested here that *Mackie* is wrong – in particular, because ‘configuration’ must be concerned with an actual, specific design rather than a more abstract ‘arrangement’ capable of various different physical embodiments. See also the criticism of *Mackie* by Jacob LJ noted at para 9.31, footnote 30.

Para 9.34

What is the difference between ‘shape or configuration’ and ‘surface decoration’?

On the basis of the case law discussed in the preceding paragraphs, very little. It is not merely a matter of whether the relevant design feature is in three or two dimensions. The most important consideration to emerge from the case law is the question of whether the design feature has a functional aspect: it is more likely to be mere surface decoration if it does not (see *Dyson v Qualtex*, para 9.33).

Para 9.43

What if any parts of an artificial human limb or joint (e.g. artificial knee), or of a heart pacemaker might be considered as protectable by UK UDR? Are there any other examples of such products?

Depending on the designs, there could potentially be UK UDR protection for those features of the products mentioned which are not ‘must fit’ in character, i.e. which enable it to be connected to or placed in, around or against another article (i.e. the immediately adjacent parts of the human body) so that either article may perform its function. Other examples of such products might include prostheses used by athletes and braces or supports for persons with a physical disability.

Para 9.49

How do the UK UDR ‘must fit/must match’ exceptions differ from those applying to registered designs (see Chapter 8)?

The ‘must fit’ exceptions are pretty similar –

Must fit in registered design law:

Features of *appearance* which must necessarily be reproduced in their exact form and dimensions so as to permit the product in which the design is incorporated or to which it is applied *to be mechanically connected to, or placed in, around or against, another product so that either product may perform its function.*

Must fit in UK UDR:

Features of *shape or configuration* which enable the article to be *connected to or placed in, around or against another article so that either article may perform its function.*

The main difference is the reference in registered designs law to the necessary reproduction of exact form and dimensions, which may be more limiting than the ‘must fit’ provision in UK UDR.

In relation to the ‘must match’ exclusion, however, there are more significant differences –

Must match (= repair right in Community and UK registered design protection):

No Community or UK registered design protection for a design constituting a component of a complex product *used for the purpose of the repair of that complex product* so as to restore its original appearance. As discussed in Chapter 8 (see para 8.102), this is a defence to an infringement action, not an exclusion from protection – the design in question is still protected, but is not enforceable against ‘repair’ use.

Must match in UK UDR:

Exclusion from protection of features of shape or configuration of an article dependent upon the appearance of another article of which the article is intended by the designer to form an integral part. Unlike the ‘repair defence’ in Community and UK registered design protection (above), for UK UDR this is a complete exclusion from protection.

Para 9.52

What is the difference between ‘original’ and ‘not commonplace’?

Originality in the copyright sense looks, according to the classic UK law approach, to whether the design is the product of independent skill and labour and not copied (it remains to be seen whether EU influences on copyright ‘originality’ will carry across into UK UDR). For UK UDR, the additional ‘not commonplace’ test looks at the design field in question and the relationship of the design in which UK UDR is claimed to the body of other designs in that field, to assess whether the designer (irrespective of the level of effort on his part) has ended up with a design that is commonplace when compared to those other designs. Being ‘not commonplace’ is not the same thing as being ‘new’ or having ‘individual character’ in registered design law – see Chapter 8).

Para 9.66

In the light of the two decisions just described, what would your advice be to a party sued for infringement of a UK UDR who wished to dispute the existence of the right, its scope in relation to his or her product, and that there had been infringement; and therefore to fight the action in all respects and continue his or her trading activities?

To give serious consideration to the possibility of taking a licence of right. This would entail checking whether or not the UK UDR was in the last five years of its term, and whether any of the alleged infringements had occurred before that five-year period began (these being liabilities that could not be affected by taking the licence of right). A licence of right can be taken if the five-year period has begun, without any admission of liability. This would

prevent the claimant getting injunctions to stop our party producing, or orders for delivery up, while also restricting the amount of damages should the infringement claims be made out in relation to the period for which a licence of right was available.

Para 9.85

Why do designs for artistic works retain full copyright?

In copyright, policy is to support the creativity of the artist by providing a long-term reward potential, encouraging not only the artist but also the investor in that artist's work. In contrast, in UK UDR where the implicit emphasis is on commercially exploited designs, an argument is that a shorter period of protection will be sufficient to allow designers of commercially exploited designs to recoup their personal investment in their work and still to incentivise the production of more designs.

Para 9.105

- **What is the purpose of Community UDR?**
- **To what products will the Community UDR typically apply?**
- **How do the main features of Community UDR (protected designs, duration, rights, defences) compare, contrast, and interact with registered design protection?**
- **Likewise, how does Community UDR contrast with the UK UDR?**
- **Why was UK UDR kept in force, despite the introduction of Community UDR?**

What is the purpose of Community UDR?

The protection of designs on their way to registration, and of designs the commercial life of which will be too short to justify even one term of registered design protection.

To what products will the Community UDR typically apply?

All those to which registered design protection can apply. The classic example of the short-life design which is potentially well-suited to Community UDR is the fashion garment.

How do the main features of Community UDR (protected designs, duration, rights, defences) compare, contrast, and interact with Registered Design protection?

Protected designs – the rules are the same.

Duration – Community UDR is shorter (3 years) than even one instalment of the 5 x 5 years of the Community registered design.

Rights – Community registered design protection confers a full monopoly against even independent creation of a conflicting design, while Community UDR protects against infringement resulting from copying only.

Defences – the same.

Likewise, how does Community UDR contrast with the UK UDR?

Applicable designs – UK UDR is more protective than Community UDR, in so far as it can protect designs which are purely functional; on the other hand, Community UDR will protect two-dimensional designs whereas UK UDR will only protect ‘shape and configuration’

excluding 'surface decoration'. There are also other differences between the two, particularly as regards exclusions.

Duration – UK UDR is longer than Community UDR, although by how much will vary from case to case depending on the application of the UK UDR duration rules.

Rights – both are protections dependent on copying.

Defences – UK UDR has many fewer explicit defences than Community UDR. The UK UDR is also subject to a licence of right in its last five years.

Why was UK UDR kept in force, despite the introduction of Community UDR?

In short, essentially because UK UDR and Community UDR protect different things, for different periods of time.