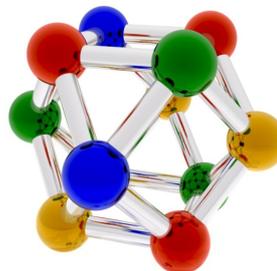


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*The shape of things to come:  
Predicting the trajectory of design  
protection of product shapes: Industry  
perspective*

David Stone, Partner

UCL Institute of Brand and Innovation Law, 14 February 2018

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## Court of Appeal: Is it RCD unfriendly?

	Valid registered design	Broad scope of protection	Infringed?
<i>P&amp;G v Reckitt Benckiser</i>	✓	✓	✗ Not close enough
<i>Dyson v Vax</i>	✓	✓	✗ Not close enough
<i>Samsung v Apple</i>	✓	✗ Within a family of prior art	✗
<i>Trunki</i>	✓	✓	✗ Not close enough

Designs need to be very similar to infringe

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## Practical lessons learned from the Supreme Court in *Trunki*

**Monochrome CAD = a shape in 2 contrasting colours**

- 01** File early – avoid a “squeeze”
- 02** File more than 1 design
  - Colour photo of Trunki
  - B&W photo of Trunki
  - Monochrome CAD with tonal contrasts
  - Monochrome CAD without tonal contrasts
  - Line drawing
- 03** Show surface decoration in dotted lines to indicate it is not claimed
- 04** File for variations – there are no non-use requirements for designs
- 05** File for innovative parts

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## The future of design filings? The EU Design Review (2016)



- E-filing of design applications and invalidity proceedings**
- Further use of Hague System**
- Further international harmonisation – use same set of design representations around the world**
- Reduce renewal fees at EUIPO**

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## The future of design filings (2): The EU Design Review (2016)

- Harmonised approach to dotted/broken lines
- Increased number of representations (up to 12 now allowed by UKIPO instead of 7)
- 3D animated representations
- Mandatory admin/ office proceedings for invalidity (similar to EUTMS)
- Mandatory availability of DNIs

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## Graphical User Interfaces

- Visual elements of a computer display that allow users to interact e.g. icons/ or screen layouts/ transitions
- Should be protectable bearing in mind marketing value of design
- One design, multiple products
- Should protect animated designs as no need for a design to be in permanent/ material form – but need the technical means to represent them

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## 3D Printing



Manufacture of product incorporating a design is an infringement if done for commercial purposes (not individual users for private use)

Intermediaries (e.g. making/ hosting files or operating the printer) raise indirect infringement arguments

EU Design Review – consider a provision for 3D printing from unlawful sources

INTA Designs Committee – possible best practices toolbox – tips on securing 3D TM and designs for the external appearance of products/ packaging

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## Virtual/ Dynamic/ Experiential designs



Overall user experience and method of consumer interaction. For example:

- the look and feel of a Starbucks® coffee shop
- the Disneyland® atmosphere

Designs projected/ applied onto different mediums e.g. fluid or space (e.g. virtual keyboard)

- Intangible/ uncertain - Can it retain the same design features irrespective of the medium?
- Representation?

Better suited to TMs or passing off?

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