Patents, trade marks, copyright and designs in UK (England and Wales): overview

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PATENTS

1. What are the legal requirements to obtain a patent?

In order to patent an invention it must:
- Be novel.
- Involve an inventive step.
- Be capable of industrial application.
- Be properly specified in the patent.
- Not fall within a statutory exclusion.

2. What categories are excluded from patent protection?

The following categories are excluded from patent protection:
- Scientific or mathematical discoveries, theories or methods.
- Literary, dramatic, musical or artistic works.
- Ways of conducting certain acts, like playing a game or doing business.
- The design or presentation of information.
- Inventions contrary to public policy or morality.
- Plant and animal varieties.
- Methods for medical treatment or diagnosis.

3. Which authority registers patents? Does its website provide guidance on the application procedure?

The UK Intellectual Property Office (UK-IPO) is the government authority that registers UK patents. The UK-IPO’s website provides guidance on the patent application procedure at: www.gov.uk/government/organisations/intellectual-property-office.

4. On what grounds and when can third parties oppose a patent application or challenge an issued patent?

Third parties can not oppose the grant of a patent, but may file observations at the UK-IPO for the Examiner to take into account.

5. When does patent protection start and how long does it last?

Patent protection starts on publication of grant of the patent, but damages for infringement may be recoverable for infringements that happened from publication of the patent application.

Protection lasts for 20 years from the filing date. That period can be extended by up to five years for medicinal, plant protection and veterinary products.

6. On what grounds can a patent infringement action be brought?

Where the patent is a product, the patent can be infringed if a person:
- Makes the product.
- Disposes, or offers to dispose, of the product.
- Uses the product.
- Imports the product.
- Keeps the product (for disposal or otherwise).

Where the patent is a process, the patent can be infringed if a person:
- Uses the process.
- Offers the process for use in the UK, where that person knew, or it was obvious to a reasonable person in the circumstances, that the use of the process in the UK without the proprietor's consent would infringe the patent.

A person may also infringe a patent indirectly when all of the following apply:
- Supplying, or offering to supply, a person in the UK with any means relating to an essential element of the invention for putting the invention into effect.
- Either knowingly, or where it is obvious to a reasonable person, that the means are suitable for putting, and are intended to put, the invention into effect.
- The person being supplied, or receiving the offer of supply, is not a licensee of the patent or other person permitted to work with the patent.
7. Which courts deal with patent infringement actions?

The following deal with patent infringement actions:
- The High Court (Patents Court).
- Intellectual Property Enterprise Court.

8. What are the defences to patent infringement actions?

Typically defendants argue that the patent is invalid and/or that the patent is not infringed. Other defences include acts:
- That constitute continuation use or effective preparations to use which began before the priority date of the patent.
- That are private and done for non-commercial purposes.
- That are for experimental purposes.
- That consist of extemporaneous preparation in a pharmacy of a medicine for a person following a prescription of a medical or dental practitioner, or acts consisting of dealing such medicine.

9. What are the remedies in patent infringement actions?

Remedies include:
- Injunctions to stop further infringements.
- Damages or an account of profits.
- Delivery up or destruction of infringing products.
- Costs.

10. Is there a fast-track and/or a small-claims procedure for patent infringement actions?

There is no fast track or small claims procedure for patent infringement claims in the High Court (Patents Court) or Intellectual Property Enterprise Court (IPEC). All such claims are allocated to the multi-track.

The procedure in IPEC is generally quicker than the High Court (Patents Court).

IPEC does have a small claims procedure, but it does not apply to claims relating to patents, registered designs or plant varieties.

TRADE MARKS

11. What are the legal requirements to obtain a trade mark?

To be registrable a trade mark must:
- Be capable of graphical representation.
- Not be devoid of distinctive character or descriptive of the goods or services for which protection is sought (unless it has acquired distinctiveness through use).
- Not have become customary in the trade or generic.
- Not be morally objectionable.
- Not fall within a number of specifically excluded trade marks (for example, the Royal arms).
- Not conflict with earlier rights owned by third parties. The UK-IPO and the EU IPO will not examine applications on relative grounds, but applications can be opposed by third parties.

12. Is it necessary or advisable to register trade marks?

There is no legal requirement to register a trade mark, but it is generally advisable to do so because the trade mark owner obtains a monopoly, that is the exclusive right to use the mark for the goods/services registered. Other advantages to registration are that:
- Trade marks are easier and more cost effective to enforce than relying on unregistered rights.
- Registrations can deter would-be infringers.
- Recovering goods at customs is generally made easier by registered trade marks.
- Registered trade marks are commercially exploitable assets.

Unregistered protection in the UK is available under the law of passing off. Passing off requires evidence from the claimant establishing:
- That the unregistered trade mark has acquired goodwill.
- That the defendant's activities constitute a misrepresentation that has or is likely to deceive consumers.
- That the claimant suffers or is likely to suffer damage as a result of the misrepresentation.

13. Which authority registers trade marks? Does its website provide guidance on the application procedure?

UK registered trade marks


EU trade marks

There is a single application which covers 28 member states of the European Union and any additional member states that subsequently join the EU. The authority responsible for registering EU trade marks is the EU Intellectual Property Office (EUIPO) based in Alicante, Spain. Its website (https://oami.europa.eu/ohimp/en/) provides guidance on the trade mark application procedure.

International trade marks

Finally, protection in the UK can be obtained by filing an International Registration (IR) designating the UK and/or the EU can be filed before the World Intellectual Property Organization (WIPO). WIPO’s website is accessible at: www.wipo.int.
14. On what grounds can the regulatory authority refuse to register a trade mark?

Known as the “absolute grounds”, the UK-IPO and EUIPO can refuse registration of a trade mark during the Examination Stage of the trade mark application if the mark:

- Is not capable of graphical representation.
- Is devoid of distinctive character or descriptive of the goods or services for which protection is sought (unless the applicant can show that the mark has acquired distinctiveness through its use).

Trade mark applications can be refused by the UK-IPO and EUIPO if the mark is:

- Morally objectionable.
- Falls within a number of specifically excluded trade marks (for example, the Royal arms).
- Deceptive.
- Prohibited for use in the UK or EU.
- Applied for in bad faith (applied to UK marks only).

15. On what grounds and when can third parties oppose a trade mark application or cancel a registration?

**Opposition actions**

Third parties can apply to oppose the registration of a trade mark during the publication period based on the “relative grounds” where:

- The mark applied for is identical to the earlier mark and has been applied for identical goods or services as that earlier mark.
- The mark applied for is identical or similar to the earlier mark and has been filed for identical or similar goods or services as the earlier mark, and there is a likelihood of confusion on the part of the public, which includes a likelihood of association.
- The earlier mark (which is similar or identical to the mark applied for) has a reputation in the applicable jurisdiction, where the use of the mark applied for being without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
- The use of the mark applied for can be prevented by virtue of any rule of law (in the UK, the law of passing off in particular) or because of an earlier right (copyright, design right or registered design).

**Cancellation actions**

A registered trade mark can be declared invalid if it was filed contrary to the absolute and/or relative grounds. This includes applications filed in bad faith (applicable to UK and EU trade marks).

A registered trade mark may be revoked where:

- It has not been put to genuine use within five years of registration, or for any subsequent continuous five-year period, and there are no proper reasons for non-use.
- As a consequence of the actions or omissions of the trade mark owner, the trade mark has become the common name in the trade for a product or service for which it is registered.

- As a consequence of the proprietor or its licensees the trade mark is liable to mislead the public.

16. When does trade mark protection start and how long does it last?

Trade marks last for ten years from the filing date, and can be renewed for further ten-year periods. Provided the renewals are made, the trade mark can last indefinitely if it is not successfully cancelled (see Question 15, Cancellation action).

17. On what grounds can a trade mark infringement action be brought?

Where a person without the consent of the trade mark owner, uses in the course of trade:

- A sign that is identical to an earlier registered trade mark in relation to identical goods or services.
- A sign that is identical or similar to an earlier registered trade mark in relation to identical or similar goods or services, such that there is a likelihood of confusion, which includes a likelihood of association.
- A sign that is identical or similar to an earlier registered trade mark, where that earlier mark has a reputation in the relevant territory, such that use of the mark being without due course takes unfair advantage of, or is detrimental to, the distinctive character or repute of the earlier registered trade mark.

In all cases use of the mark must affect the functions of the earlier trade mark, such as its ability to operate as an indicator of origin.

18. Which courts deal with trade mark infringement actions?

The following courts deal with infringement proceedings in the UK:

- High Court (Chancery Division).
- Intellectual Property Enterprise Court.
- County Courts with Chancery District Registries.

19. What are the defences to trade mark infringement actions?

Typically defendants will seek to argue that the trade mark is invalid. Other defences include:

- Defendant is using own UK registered trade mark. This is a defence to infringement of a UK trade mark and does not apply as a defence to infringement of an EUTM. Typically claimants will apply to cancel UK trade marks in anticipation of this defence.
- Defendant is using its own name. Recent changes in the law mean that this defence is only available to real people using their own given names not to company names.
- Defendant is using a sign indicating the kind, quality, quantity, intended purpose, value, geographic origin, the time of production of goods or of rendering services, provided such use is in accordance with honest practices in industrial or commercial matters.
• Defendant’s use is a permitted comparative advertisement.
• Defendant is using a right in a particular locality that is protected by particularly passing off.
• Trade mark exhaustion (that is, the goods sold by the defendant bearing the infringing sign had been put on the market by the trade mark proprietor or with his consent).

20. What are the remedies in trade mark infringement actions?

Remedies include:
• Injunction.
• Damages or account of profits.
• Destruction or delivery up of infringing goods.
• Costs.

21. Is there a fast-track and/or a small-claims procedure for trade mark infringement actions?

There is a small claims track available for trade mark infringement actions (as well as passing off actions) in the Intellectual Property Enterprise Court. Such actions are for simple, low value claims (not exceeding GBE10,000).

COPYRIGHT

22. What are the legal requirements to obtain copyright protection?

Works that qualify for copyright protection must be:
• Recorded.
• Compliant with the requirements of nationality/domicile of the author and/or country of first publication or broadcast.
• Original.

23. Can copyright be registered? If so, is registration required?

Copyright is not registrable in the UK.

24. When does copyright protection start and how long does it last?

Copyright protection in work starts once it is recorded and lasts:
• 70 years from the end of the calendar year in which the author (or last of the specified persons in the case of films) dies (applicable to literary, dramatic, musical, artistic works, films and sound recordings).
• 50 years from the end of the calendar year in which the work is made (applicable to computer-generated literary, dramatic, musical, artistic works and broadcasts).
• 25 years from the end of the calendar year in which the edition was first published (applicable to typographical arrangements of published editions).

25. On what grounds can a copyright infringement action be brought?

Grounds include:
• Primary infringement: copying the work, issuing copies of the work to the public, communicating the work to the public.
• Secondary infringement: importation of infringing copies or providing the means for making copies of the work.

26. Which courts deal with copyright infringement actions?

The following courts deal with copyright infringement actions:
• High Court (Chancery Division).
• Intellectual Property Enterprise Court.
• County Court with Chancery District Registries.

27. What are the defences to copyright infringement actions?

Apart from arguing that the work does not comply with the requirements of copyright protection, the defences include:
• Making certain temporary copies of the work.
• Research and private study.
• Criticism, review and news reporting.
• Parody.
• Quotations used in a certain manner.

28. What are the remedies in copyright infringement actions?

Remedies include:
• Injunction.
• Damages or account of profits.
• Delivery up or destruction of infringing items.
• Costs.

29. Is there a fast-track and/or a small-claims procedure for copyright infringement actions?

There is a small claims track available for copyright infringement actions in the Intellectual Property Enterprise Court. Such actions are for simple, low value claims (not exceeding GBE10,000).

REGISTERED DESIGNS

30. What are the legal conditions to obtain a registered design right?

Two registered design rights are enforceable in the UK:
• A UK registered design (applying to the UK only).
• A Community registered design (applying to the EU).
The design must:
- Be novel/new.
- Have individual character.
- Not be excluded. Examples include that the design must not be:
  - solely dictated by technical function;
  - contrary to public policy or morality.

31. Which authority registers designs?

UK registered designs
The UK Intellectual Property Office (UK-IPO) registers designs, whose website provides guidance on the design application procedure at: www.gov.uk/government/organisations/intellectual-property-office.

EU Community designs
There is a single application which covers 28 member states of the European Union and any additional member states that subsequently join the EU. The authority responsible for registering Community designs is the EUIPO based in Alicante, Spain. Its website (https://oami.europa.eu/ohimportal/en) provides guidance on the design application procedure.

International designs
Finally, protection in the UK can be obtained by filing an International Registration (IR) designating the EU (which includes the UK) before the World Intellectual Property Organization (WIPO). WIPO’s website is accessible at: www.wipo.int.

32. On what grounds and when can third parties oppose a registered design application?

No procedure exists before EU IPO or the UK-IPO in which third parties may oppose the registration of designs.

Design registrations may be invalidated (post registration) for ground including:
- Design does not comply with statutory requirements, such as the definition of a design, or it is dictated solely by technical function.
- Design lacks novelty and/or individual character (for example, there is a prior design).
- Design includes an earlier trade mark, passes off, or includes a work protected by copyright.
- Design is contrary to public policy or morality.

33. When does registered design protection start and how long does it last?

UK registered designs are protected for five years from the filing date, and can be renewed after each subsequent five-year period up to a maximum total of 25 years. The same applies to Community registered designs.

34. On what grounds can a registered design infringement action be brought?

The scope of protection of a registered design right includes any design which does not produce on the informed user a different overall impression.

The right granted by a registered design is an exclusive right to use and prevent other from using the design. Use in this context means making, offering, putting on the market, importing, exporting, or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

35. Which courts deal with registered design infringement actions?

The following courts deal with infringement proceedings:
- High Court (Patents Court).
- Intellectual Property Enterprise Court.

36. What are the defences to registered design infringement actions?

Other than arguing that the design is invalid, defences include:
- Acts done privately not for commercial purposes.
- Acts done for experimental purposes.
- Use of equipment on ships or aircraft which are registered in another country but which are temporarily in the UK.
- Importing spare parts or accessories in the UK for the purposes or repairing such ships or aircraft.
- Repairs of such ships or aircraft.
- Reproducing for teaching purposes or for the purposes of making citations provided the act of reproduction is compatible with fair trade practice and does not unduly prejudice the normal exploitation of the designs and mention is made of the source.

37. What are the remedies in registered design infringement actions?

Remedies include:
- Injunctions.
- Damages or account of profits.
- Delivery up or destruction of infringing goods.
- Costs.

38. Is there a fast-track and/or a small-claims procedure for registered design infringement actions?

There is no small claims track for registered design claims in the UK.

The Intellectual Property Enterprise Court’s procedure is generally quicker than the High Court (Patents Court).
UNREGISTERED DESIGNS

39. What are the legal conditions for unregistered design rights to arise?

There are two types of unregistered designs applicable in the UK:

- UK unregistered designs (applying to the UK).
- Community unregistered designs (applying to the EU).

UK unregistered design rights arise automatically in designs that are:

- Original.
- The shape or configuration (whether internal or external) of the whole or the part of an article.
- Recorded in a design document or an article made to the design.
- Designed by a designer who complies with the qualification/nationality criteria.
- Not commonplace.
- Not a method or principle of construction.
- Not a feature of a shape or configuration of an article which enables the article to be connected to, or placed in, around or against, another article so that either article may perform its function.
- Not a feature of a shape or configuration of an article which is dependent on the appearance of another article of which the article is intended by the design to form an integral part.
- Not surface decoration.

Community unregistered designs arise automatically when first disclosed in the territory of the EU. Community unregistered designs must meet the same conditions as Community registered designs (see Question 30).

40. When does unregistered design protection start and how long does it last?

UK unregistered design protection starts from when it is recorded in a design document or an article is made, and ends on the lesser of:

- 15 years from the end of the calendar year in which the design was recorded in a design document or an article first made to the design (whichever is first).
- If articles to the design are first made available for sale or hire within five years from the end of that calendar year, ten years from the end of the calendar year in which that first occurred.

Community unregistered design rights last for three years from the date of first disclosure in the territory of the EU.

41. On what grounds can an unregistered design infringement action be brought?

UK unregistered design right

On the grounds of primary and/or secondary infringement:

- Primary infringement: reproducing articles exactly or substantially to the design, or making a design document for the purposes of enabling such articles to be made.
- Secondary infringement: without the design owner's consent, importing articles which are, or are believed to be, infringing.

EU unregistered design

The grounds are the same as those for Community Registered designs (except copying must be proved). Copying must be proved for UK and Community unregistered design infringement.

42. What are the defences to unregistered design infringement actions?

A finding of non-infringement of a UK unregistered design will arise if the earlier right does not comply with the requirements of design protection. A partially mitigating defence is available for a finding of secondary infringement of a UK unregistered design if the defendant did not know or had no reason to believe that a UK unregistered design existed in the product (here damages will not exceed a reasonable royalty).

The defences to Community registered design infringement apply to Community unregistered design infringement.

43. What are the remedies in unregistered design infringement actions?

Remedies include:

- Injunctions.
- Damages or account of profits.
- Delivery up or destruction of infringing items.
- Costs.

CONFIDENTIAL INFORMATION

44. What are the legal conditions for rights in confidential information to arise?

To be protected by the law of confidential information, the information must be both:

- Confidential in nature, having the necessary quality of confidence.
- Disclosed in circumstances importing an obligation of confidence.

45. On what grounds can an action for unauthorised use of confidential information be brought?

If a person misuses or threatens to misuse confidential information, an action for unauthorised use of confidential information can be brought.

46. Which courts deal with actions for unauthorised use of confidential information?

Claims are dealt with by the:

- High Court.
- County Court
• The Intellectual Property Enterprise Court can deal with confidentiality claims if they are secondary to a case within the court’s statutory jurisdiction.

47. What are the defences to actions for unauthorised use of confidential information?

Defences include:
• The information is no longer confidential (that is, the requirements of confidentiality are no longer met).
• The disclosure of the information is in the public interest, or required by law.

48. What are the remedies in actions for unauthorised use of confidential information?

Remedies include:
• Injunctions.
• Damages or account of profits.
• Delivery up.
• Costs.

49. Is there a fast-track and/or a small-claims procedure for actions for unauthorised use of confidential information?

There is no small claims track for confidentiality matters, although the Intellectual Property Enterprise Court’s procedure is generally quicker than most other courts (but see Question 4Q).

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