



Jonathan Silverman and Robert MacGinn explain how intellectual property law can protect artists from plagiarism

Dealing with artistic designs

If imitation is the sincerest form of flattery then there are more sincere businessmen in the world than one would at first imagine.

Often, a client will roll up with an example of one of their products, such as a fruit bowl or a piece of jewellery, together with some naff knockoff copy which they bought either from a market stall or a retailer (sometimes one who is quite respectable) and at far lower price and probably of an inferior quality; but what practical steps can the client take?

Inevitably the first question the client will ask (even before allowing you to evaluate the claim) is: what's it going to cost? Fortunately the introduction of the Patents County Court (which actually deals with all IP rights) may well provide an economic option for the client (so at least you can answer: not half as much as you'd expect). But, before considering how to obtain a remedy, it is first worth reviewing the alternative basis upon which the client can base their rights.

Copyright

Even those practitioners with little experience of intellectual property will recognise that copyright exists in 'an original artistic work' and that this long-standing common law right is now embodied in statute and can still form a useful basis upon which to bring an action for infringement even if the concept of unregistered and registered design rights has come more to the fore.

With copyright, one can readily identify the creator of the work and where the original drawings exist, making it less difficult to demonstrate the ownership of rights, but you must be able to produce the original drawings and demonstrate the date of creation and satisfy a court that ownership vests in either the originator or assignee – so do check that point carefully.

In many cases the design will have been created by a third party as a commissioned design and, while there is an argument that the client, as manufacturer or distributor of the goods, has an exclusive right to use the design, it does not necessarily mean that the copyright is vested in him.

However one of the most attractive aspects of copyright is its longevity. As you will see later on, both registered and unregistered rights last for a far shorter lifespan than the 70 years (as a rule of thumb) for which copyright exists, although of course one needs to show that the infringing article is indeed a 'knockoff' rather than being a coincidental similar design. This will be an evidential point.

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Design rights

Both unregistered and registered design rights might be available to the client. Unregistered design rights last for three years in the EU and 15 years in the UK as of the date the product was brought to market.

So check whether the client can demonstrate the first occasion the product was offered for sale, perhaps as illustrated in a show guide or in some marketing or PR literature and be prepared to satisfy a court there has been obvious plagiarism.

Perhaps the tidiest course of action, if the client has sought guidance on the protection of new products before rather than after they have been knocked off, is to obtain protection by way of registration.

Registering design rights, whether in the UK or the EU, is swift and cheap, with the option of a series discount where the same design appears on different goods, which can sometimes be covered by one application. The key point is that the registration process has to be made within one year of the product being brought to market.

Successful registration provides protection for five years with the applicant having the right to renew for four further five-year periods giving potential protection for 25 years in total – well worth having if the product life cycle might last a long period.

It is also important to check whether the work the client seeks to protect is a one-off or whether it is intended for series production, since copyright cannot be relied upon if 50 or more items are to be produced; important when advising an artist who intends to produce a limited edition run.

Tackling infringements

If the client is complaining of a potential infringing item being offered for sale, if he has not made a test purchase then you should certainly arrange for the same fairly swiftly.

The inevitable cease and desist letter needs to be properly drafted setting out all the facts, demonstrating ownership of the design and evidencing the unlawful copying. That letter needs to be sent initially to the retailer and anyone further up the supply chain that can readily be ascertained. If there is any uncertainty as to who is in the supply chain then the letter to the retailer needs to demand disclosure of the other parties involved, perhaps stressing that lack of voluntary disclosure will lead to an application to court for the information.

In many cases, setting out your client's position clearly and forcefully will be sufficient to ensure that an infringer backs off. Failing that, look carefully at the opportunities now availed by the Patents County Court to commence proceedings with limited exposure to costs and a surprisingly practical and swift way of bringing a matter before the court for consideration. The Patent Court Guide 2011 is available online and offers useful background.

The fear that only the big guys can afford to protect their designs is a myth which one can comfortably dispel, so encourage the client to consider standing up for their rights – after all that's what we're there for.



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