

## 2. PROTECTING INDUSTRIAL DESIGNS IN THE COMMONWEALTH CARIBBEAN: A CRITICAL ANALYSIS

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### ABSTRACT

Industrial designs are increasingly becoming an important revenue stream for innovators. Innovators in the Commonwealth Caribbean have been no exception in this regard. Nonetheless, in practice, most of the region's legislation on industrial designs is out of date, parochial in its orientation and fundamentally out of sync with modern day realities. This paper seeks to explore the protection of industrial designs in the region, with the aim of identifying areas of convergence and divergence between Caribbean countries, as well as opportunities for reform where lacunae are found to exist.

**Keywords:** *registered design, unregistered design, commonplace, novelty, originality*

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## 1. INTRODUCTION

The Commonwealth Caribbean is a pluralistic society, whose eclectic cultural and traditional heritage permeates the region's artistic and creative industries. Whether it be items of jewellery, carpets, footwear or clothing apparel, Caribbean people have demonstrated tremendous acumen toward their design of items of industry or handicraft. It should therefore come as no surprise that the vast majority of Commonwealth Caribbean countries have enacted legislation,<sup>1</sup> modelled after WIPO's Model Law for Developing Countries on Industrial Designs<sup>2</sup> that allows for the registration and attendant protection of industrial designs. Additionally, some Caribbean countries allow for the protection of unregistered designs in a similar vein to the system created by the UK's Copyright Designs and Patents Act (CDPA). Yet still, in other countries such as Grenada,<sup>3</sup> Montserrat<sup>4</sup> and, to a limited extent, the Cayman Islands,<sup>5</sup> while there exists no system of design right protection for local designs, designs which have been registered in the United Kingdom automatically gain protection in these islands, and the rights attached to these designs can accordingly be enforced in said countries. Guyana, by contrast, has a hybrid system in place in which

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<sup>1</sup> Anguilla Industrial Designs Act 2002; Antigua and Barbuda Industrial Designs Act 2003; The Bahamas Industrial Property Act CAP 324; Barbados Industrial Designs Act CAP 309A; Belize Industrial Designs Act CAP 254; Dominica Industrial Designs Act 1998; Guyana Patents And Designs Act CAP 90:03; Jamaica Designs Act 1937; St Lucia Industrial Designs Act 2001; St Vincent and the Grenadines Industrial Designs Act CAP 312; Trinidad and Tobago Industrial Designs Act CAP 82:77.

<sup>2</sup> (1990) WIPO Publication No. 808 (E).

<sup>3</sup> United Designs Protection Act Cap 331.

<sup>4</sup> United Kingdom Designs (Protection) Act (1/1/2002).

<sup>5</sup> The Design Rights Registration Law (2016), s 2(1) (b).

local designs are protected upon registration,<sup>6</sup> as well as designs which have been registered in the UK.<sup>7</sup> Finally, in other countries like St Kitts and Nevis, no sui generis legislation exists to protect designs, which necessitates reliance upon the Copyright Act in respect of original artistic works.<sup>8</sup>

This paper seeks to assess the adequacy of regional protection afforded to industrial designs, having regard to developments at the level of the European Union and the United Kingdom. This paper concludes by analysing the provisions of the Cayman Islands Industrial Designs Bill 2019 in light of the discussion around the reform of industrial designs legislation in the Commonwealth Caribbean.

## 2. SUBJECT MATTER OF PROTECTION

Under the respective regional registered designs legislations, barring minor vernacular variations, a 'design' is defined. This definition typically reads as follows:

a composition of lines or colours, a three dimensional form or a material, whether or not associated with lines or colours, is deemed to be an industrial design where such composition, form or material gives a special appearance to a product of industry or handicraft, can serve as a

pattern for a product of industry or handicraft and appeals to and is judged by the eye.<sup>9</sup>

There are several points that are worth noting from this definition. The first is that both two-dimensional (lines or colours) and three-dimensional forms (shapes and configurations) are, in principle, protected. By implication, it would thus appear that surface decorations are protected. These designs must, however, be applied to a product of industry or handicraft, and must remain visible, since they have to appeal to the eye. The only exception to the requirement for a registered design to have 'special appearance' or 'eye appeal' is Section 2 of the Jamaica Designs Act 1937, which provides that:

'design' means any design applicable to any article of manufacture, or to any substance artificial or natural or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration or for the ornament thereof or for any two or more such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical or chemical, separate or combined.

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<sup>6</sup> Patents and Designs Act Chapter 90:03, s 62(1) The Registrar may, on the application made in the prescribed form and manner of any person claiming to be the proprietor of any new or original design not previously published in Guyana, register the design under this Part.

<sup>7</sup> *ibid*, s 76. Subject to the provisions of ss 77 and 78 of this Act, the registered proprietor of any design registered in the United Kingdom under the Patent and Designs Acts, 1907 to 1932, of the United Kingdom or any Act amending or substituted for those Acts shall enjoy in Guyana the like privileges and rights as though the design had registered in Guyana under this Act.

<sup>8</sup> 'A Guide to Intellectual Property: St. Christopher (Kitts) & Nevis' (Daniel Brantley Attorneys-at-Law, St. Kitts Nevis, April 27, 2016).

<sup>9</sup> Anguilla Industrial Designs Act 2002, s 2(1); Antigua and Barbuda Industrial Designs Act 2003, s 3(1); The Bahamas Industrial Property Act CAP 324, s 30(1). ('design' shall mean features of shape, configuration, pattern or ornament of an article or features of

pattern or ornament applicable to articles in so far as such features appeal to and are judged solely by the eye); Barbados Industrial Designs Act CAP 309A, s 4; Belize Industrial Designs Act CAP 254, s 2; Dominica Industrial Designs Act 1998, s 2; Guyana Patents And Designs Act CAP 90:03, s 2; Jamaica Designs Act 1937, s 2. ('design' means any design applicable to any article of manufacture, or to any substance artificial or natural or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration or for the ornament thereof or for any two or more such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical or chemical, separate or combined); St Lucia Industrial Designs Act 2001, s 3(1); St Vincent and the Grenadines Industrial Designs Act CAP 312, s 3(1); Trinidad and Tobago Industrial Designs Act CAP 82:77, s 3(1).

## A. EYE APPEAL

According to WIPO's Commentary on the Model Law for Developing Countries on Industrial Designs, reference to 'special appearance' is synonymous with a design appealing to and being judged by the eye. Thus, although some pieces of regional legislation, like Barbados' Industrial Designs Act,<sup>10</sup> refer only to 'special appearance', this notion is to be construed in similar vein to legislation that speak to designs appealing to the eye.<sup>11</sup> However, what exactly does it mean for a design to appeal to the eye?

Although the current UK Registered Designs Act (1949), as amended, and the CDPA do not impose a requirement for eye appeal,<sup>12</sup> this was not always the case. In fact, under the previous iteration of the Registered Designs Act, there was explicit reference to 'eye appeal', which was interpreted in divergent ways by a number of cases, albeit in a controversial manner.

In one of the leading cases on this particular issue, *AMP Incorporated v Utilux Proprietary Limited*,<sup>13</sup> the majority opinion of the House of Lords was that AMP Incorporated terminals which were designed for washing machines did not enjoy design right protection because they failed to meet the threshold of eye appeal. Because the discussion engaged in by the House of Lords on the issue of eye appeal was so profound, and, indeed, likely instructive in respect of the interpretation of applicable Caribbean design rights legislation, key passages from their Lordships will be quoted in full. In *AMP Incorporated*, Lord Reid was of the view that:

Then there come the words 'being features which in the finished article appeal to and are judged solely by the eye.' This must be intended to be a limitation of the foregoing generality. The eye must be the eye of the customer if I am right in holding that the policy of the Act was to preserve

to the owner of the design the commercial value resulting from customers preferring the appearance of articles, which have the design to that of those, which do not have it. Therefore, the design must be one that appeals to the eye of some customers (*Emphasis added*). In addition, the words 'judged solely by the eye' must be intended to exclude cases where a customer might choose an article of that shape not because of its appearance but because he thought that, the shape made it more useful to him.

In the case of finished articles sold to members of the public for use by them, one doubts whether this limitation is of much importance. The onus is on the person who attacks the validity of the registration of a design. So he would have to shew on a balance of probability that an article with the design would have no greater appeal by reason of its appearance to any member of the public than an article which did not have this design (*Emphasis added*). Looking to the great variety of popular tastes this would seem an almost impossible burden to discharge.<sup>14</sup>

In Lord Reid's estimation, to obtain protection, a design must represent a blend of industrial efficiency with visual appeal. In other words, if a shape is not there to appeal to the eye, but solely to make the article work, then this provision excludes it from statutory protection.

A similar view was taken by Lord Morris, who proffered that:

The features must be such that in the finished article they appeal to and are judged solely by the eye. It follows that in the finished article they must at least be noticeable.

The question is raised as to the sense in which the features in a finished article are to appeal to and are to be judged solely by the eye. I think that it is clear that the particular feature which is in question or under consideration must

<sup>10</sup> Barbados Industrial Designs Act CAP 309A, s 3(1). See also Antigua Industrial Designs Act 2003, s 3(1).

<sup>11</sup> Anguilla Industrial Designs Act, s 2(1); The Bahamas Industrial Property Act CAP 324, s 30(1); Belize Industrial Designs Act CAP 254, s 2; Dominica Industrial Designs Act 1998, s 2; Guyana Patents And Designs Act Chapter 90:03, s 2; St Lucia Industrial Designs Act 2001,

s 3(1); St Vincent and the Grenadines Industrial Designs Act CAP 312, s 3(1).

<sup>12</sup> In fact, the CDPA is said to be capable of protecting purely functional designs.

<sup>13</sup> [1971] FSR 572.

<sup>14</sup> *ibid* 577.

be seen when the finished article is seen. However, the words of the definition point, in the author's view, to considerations other than that of merely being visible. The phrases 'appeal to' and 'judged solely by the eye' denote features that will or may influence choice or selection. The eye concerned will be the eye, not of the court, but of the person who may be deciding whether, or not, to acquire the finished article possessing the feature in question (*Emphasis added*). This does not mean that the 'appeal' or the attraction must be to an aesthetic or artistic sense - though in some cases it may be. The features may be such that they gain the favour of or appeal to some while meeting with the disfavour of others. Beyond being merely visible, the feature must have some individual characteristic. It must be calculated to attract the attention of the beholder (*Emphasis added*).<sup>15</sup>

Lord Pearson endorsed the foregoing sentiments, finding that:

There must be in some way a special, peculiar, distinctive, significant or striking appearance - something which catches the eye and in this sense appeals to the eye.

Meanwhile, Viscount Dilhorne was of the view that:

I do not think it impossible that an electrician looking at the respondents' terminal would say that it appealed to his eye. He might say that it looked to him a cleaner and stronger type of terminal than any of the others which were shown to us. He might say that looking at it; it appeared to him the most useful for his purpose. I therefore think that the designs of the terminals registered by the respondents satisfy the first part of the definition of design, and if that stood alone, the registrations would be valid.

Although Viscount Dilhorne disagreed with his learned colleagues on the question of eye-appeal, the other judges were unanimous in holding that on being merely looked at,

the Claimant's terminal did not make any appeal to the eye. In their view, it had no feature of shape or configuration, which was special, peculiar, distinctive, significant or striking. There was nothing in its appearance that caught the eye. In fact, their view was that the terminal was not intended to be looked at; rather, it was to form part of the interior mechanism of the washing machine and would not normally be seen by anyone, except a maintenance engineer. Quite radically, their Lordships expressed that if, in any event, the terminal had eye appeal, 'that would be wasted.'<sup>16</sup>

The views expressed by the majority of their Lordships in *AMP Incorporated v Utilux Proprietary Limited* were reiterated in *Interlego A.G v Tyco Industries Inc & Ors (Hong Kong)*.<sup>17</sup> Here, their Lordships affirmed that before a shape can be registered as a design, it should have eye-appeal; in this context, the eye is that of the prospective customer and the appeal is that created by a distinctiveness of shape, pattern or ornamentation calculated to influence the customer's choice. In other words, courts must ask, when looking at the design, 'do these features of shape or configuration, taken as a whole and in combination, appeal to the eye?'<sup>18</sup>

## **B. SPECIAL APPEARANCE IN RELATION TO THE WHOLE OR PART OF A PRODUCT**

Aside from eye appeal, another important issue which arises from the regional statutory definitions of a 'design' is that of whether the features (lines or colours, a three dimensional form or a material) have to give a special appearance to a product as a whole or part of a product. Although this issue has not been expressly addressed in the existing jurisprudence, it is apposite to bear in mind that under the UK Registered Designs Act and CDPA and the Bermuda Copyright and Designs Act 2004, respectively, design right subsists in the appearance (shape or configuration) of the whole or part of an article. By contrast, regional statutes, in general, speak to the 'special appearance to a product', without specifying whether a person can claim design right in the features of a part, rather than the whole, of a product. It would seem, on a

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<sup>15</sup> *ibid* 583.

<sup>16</sup> *ibid* 597.

<sup>17</sup> [1988] UKPC 3.

<sup>18</sup> *ibid* 246.

plain textual reading of the regional provisions, that design right can only be claimed in respect of the appearance of a product as a whole, rather than in respect of a part of a product.

A related issue concerns the fact that whereas Bermuda's Copyright and Designs Act 2004 indicates that design rights subsist in 'any aspect' of the shape or configuration of an article (whole or part thereof), other islands' legislation are silent on this issue. As indicated earlier in the article, reference to 'any aspect' is a relic of the UK's pre-2014 CDPA, which, according to the Court in *Neptune (Europe) Limited v Devol Kitchens Limited*,<sup>19</sup> protected designs which were not embodied in all or part of an article, meaning that abstract designs were protected. In short, in Bermuda, but seemingly not in the other jurisdictions, protection may be extended to a combination of the end portion of the sprout or the top portion of the lid of a tea pot, albeit that they are disembodied from each other and from the sprout and lid, respectively. It is submitted that offering protection to these small, arbitrary aspects of an article is unacceptable, as such protection, based on the judgement of Laddie J in *Ocular Sciences Ltd. & Anr. v Aspect Vision Care Ltd. & Ors*,<sup>20</sup> inevitably creates uncertainty since a claimant could trim down his claim to the design of just part of the lid. In such a situation, a defendant accused of infringement would simply not know the scope of claimant's design right until the time of the action being heard.

Although the English decisions cited above are merely persuasive in the Commonwealth Caribbean, they nonetheless have a number of practical implications, namely that, if countenanced, design protection only extends in so far as an article has eye appeal, and, that, in general, protection

will be only afforded to aspects of an article to the extent that those aspects are not small and arbitrary.

### 3. SUBSTANTIVE REQUIREMENTS FOR PROTECTION

#### A. NEW

The vast majority of registered design legislation in the Commonwealth Caribbean require, as a basis for design protection, that the design be 'new.'<sup>21</sup> For example, Section 4 the St Lucia Industrial Designs Act provides that:

(1) An industrial design is registrable if it is new.

(2) An industrial design shall be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.

Other countries' laws are slightly nuanced, however. For example, Section 62(1) Guyana's Patents and Designs Act<sup>22</sup> provides that the design in question must be new **or** original:

The Registrar may, on the application made in the prescribed form and manner of any person claiming to be the proprietor of any new or original design not previously published in Guyana, register the design under this Part.

Meanwhile, Section 4 of Jamaica's Designs Act<sup>23</sup> legislation makes reference to new and original designs:

The author of any new and original design shall be deemed to be the proprietor thereof.

It is apparent that these pieces of legislation are based on the pre-1988 UK Registered Designs Act, which provided that:

<sup>19</sup> [2017] EWHC 2172 (PAT).

<sup>20</sup> [1997] R.P.C. 289.

<sup>21</sup> Anguilla Industrial Designs Act 2002, s 3(1)-(2); Antigua and Barbuda Industrial Designs Act 2003, s 4(1)-(2); Barbados Industrial Designs Act CAP 309A, s 9 and 11(1); Belize Industrial Designs Act CAP 254, s 3(1)-(2); Dominica Industrial Designs Act 1998, s 3(1)-(2);

St Lucia Industrial Designs Act 2001, s 4(1)-(2); St Vincent and the Grenadines Industrial Designs Act CAP 312, s 4(1)-(2); Trinidad and Tobago Industrial Designs Act CAP 82:77, s 4(1)-(2).

<sup>22</sup> Guyana Patents and Designs Act 1973 (Cap. 90:03).

<sup>23</sup> Jamaica Designs Act 1937 (Act No. 32).

Subject to the provisions of this Act, a design shall not be registered thereunder unless it is new or original and in particular shall not be so registered in respect of any article if it is the same as a design which before the date of the application for registration has been registered or published in the United Kingdom in respect of the same or any other article or differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

In *AMP Incorporated v Utilux Pty. Limited and Another*,<sup>24</sup> the Court of Appeal, in interpreting this provision, considered that in order for design right to subsist in an article, there must be substantial novelty or originality, having regard to the nature of the article in question. Differences between the design in question and the prior art which are immaterial would result in a rejection of the design for which registration is sought. The court was also minded to compare the words 'new or original' with the prior iteration of the 1949 Act which made reference to 'not previously published.'<sup>25</sup> In this connection, it accepted that 'new or original' did not alter the law, since the then new wording was apt to bear out the principles to be applied in judging novelty or originality as expressed in the authorities before 1949. For this reason, the Court's conclusion was that to qualify as 'new or original', a design must, when compared with the design of prior articles and other registered designs and published matter, show a substantial difference.

On the face of it, it might be argued that the same line of reasoning can be applied to regional registered legislation which make reference to novelty and/or originality as pre-conditions for the subsistence of a design right. In short, in comparing the registered design with the prior art and in the examination of novelty and originality, the design must be looked at as a whole. The eye is the sole judge and the eye must be an instructed eye, that is, with a knowledge of the

technicalities, if any, involved and in the light of the nature of the devices shown in the prior art. If the circumstances are such that the registered design shows a substantial difference from the prior art, it is novel and/or original, and can thus be protected. This would mean that if the decision of *In The Matter of Registered Design No 4040424 Owned by Stuart Maguire and An Application (No. 20/15) by H Stebbings to Invalidate the Registered Design*<sup>26</sup> were rendered in the Caribbean, regional courts would equally have come to the conclusion that the proprietor's design of a wedding heart box, with a distinct rounded, fluid feel and a much longer slot cover, with two angled cut-outs, was new on the ground that it was not identical or too close to the applicant's design.

Despite the foregoing, however, a strong argument exists for the proposition that the English jurisprudence, discussed above, should not be uncritically accepted. In fact, it can be argued that there is seemingly a distinction between 'new' and 'original', and that legislation, like Jamaica's, which speak to 'new and original' introduce a higher threshold for obtaining protection compared with other jurisdictions whose legislation use 'new' or 'original' (like the legislation in Guyana, and the UK Registered Designs Act). It is arguable that while 'new' ought to be interpreted as a design that is substantially different from the prior art, 'original', as discussed below, means that a design must be the expression of the author's own intellectual creation; that is, the author has not slavishly copied another's design.

## B. ORIGINALITY: REGISTERED DESIGN

Curiously, the Bahamas' Industrial Designs Act,<sup>27</sup> which introduces a system of registered design rights, speaks simply to the protection of original designs:

Section 30(2) Subject to the provisions of this Act, design copyright shall be obtainable in every *original design* by the

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<sup>24</sup> See n 13 above. Note that the House of Lords overruled this decision, but only on the question of eye appeal and featured dictated solely by technical function. As such, it appears that the dicta of the Court of Appeal in relation to novelty and originality still stands as an accurate description of the law.

<sup>25</sup> This phraseology is used in most of the regional registered designs legislation.

<sup>26</sup> Designs decision O/252/16.

<sup>27</sup> Bahamas Industrial Property Act 1965 (No. 85 of 1965).

person claiming to be the proprietor thereof by depositing a claim for design copyright at the Industrial Property Office.

Section 31. (1) A design shall be deemed to be original in so far only as it is the original work of the author.

(2) Subject to the right of priority provided for by section 63 of this Act, a design shall not be deemed to be original if it is the same as a design of or for the same or any other article by the same author which has been previously published in The Bahamas or elsewhere or has been deposited under this Act by or on behalf of or with the consent of the author or any proprietor thereof or differs from such design in modifications or variations not sufficient to alter the character or substantially affect the identity thereof.

The definition of originality, as introduced by the Bahamian Act, is, on the face of it, rather complex, but is in principle reminiscent of the threshold of originality introduced by the CDPA, albeit that the CDPA applies only to unregistered designs, whereas the Bahamian Act applies to registered designs. As indicated above, and repeatedly emphasized in a number of cases decided upon to date, including *Thelma Madine (t/a NICO)*, *Camal Enterprises Limited T/A the English Ladies Co v Leanne Phillips (T/A Leanne Alexandra)*, *Pauline Phillips & others*,<sup>28</sup> which concerned the originality of wedding dresses, and *Farmers Build Ltd v Carier Bulk Materials Handling Ltd*,<sup>29</sup> which concerned the originality of slurry separators, a design will be original if it is the expression of the author's own intellectual creation; that is, the author has not slavishly copied another's design (*Emphasis added*).<sup>30</sup> Additionally, originality is measured by reference to the test of whether sufficient skill, effort and aesthetic judgment has been expended on the new design to make it original compared to designs in the existing design corpus. Protection will be denied if the design is not the author's own intellectual

creation. This is synonymous with the applicable test used in the cognate area of copyright law. Equally, although novelty is not mentioned in the legislation, it may be argued that protection will be denied if one's design is not materially different from a design that already forms part of the existing design corpus.

### C. ORIGINALITY AND COMMONPLACE: UNREGISTERED DESIGN

Of all the Caribbean designs legislation, only the Cayman Islands and Bermuda Industrial Designs<sup>31</sup> legislations, respectively, address originality in the context of unregistered designs, in similar vein to the CDPA. For example, Section 2(1)(a) of the Cayman Islands Design Rights Registration Law<sup>32</sup> provides that:

(...) design right means a property right currently held in the United Kingdom that -

(a) subsists in an original design in accordance with Part III of the Copyright, Designs and Patents Act 1988.

Meanwhile, the Bermudan legislation, in Section 292(4), only extends protection to original designs, such designs being identified as not being 'commonplace' in the design field in question at the time of its creation. Given that both the Cayman Islands and Bermuda are British Overseas Territories, it is submitted that given the legislative context of these provisions (that is, their derivation from the CDPA), the definitions of 'originality' and 'commonplace' found in UK case law which interprets the CDPA are instructive. In this connection, the case of *Whitby Specialist Vehicles Limited v Yorkshire Specialist Vehicles Limited, Amer Rubani, Omar Rubani, Ghulam Rubani*,<sup>33</sup> which concerned the originality of ice cream vans, is apposite on the question of originality:

In order for design right to subsist, a design must be 'original' in the copyright sense of originating with the

<sup>28</sup> [2017] EWHC 3268 (IPEC).

<sup>29</sup> [1999] RPC 461.

<sup>30</sup> *ibid* 482.

<sup>31</sup> Bermuda Copyright and Designs Act 2004 (No. 5/2004), s 292(4).

<sup>32</sup> The Cayman Islands Design Rights Registration Law 2016 (Law 29 of 2016).

<sup>33</sup> [2014] EWHC 4242 (Pat).

author, and not being copied by the author from another: see *Farmers Build Ltd v Carrier Bulk Materials Handling Ltd* [1999] RPC 461 at 475, 482. In *Magmatic v PMS* at [84] I expressed the view that the test is whether sufficient skill, effort and aesthetic judgement has been expended on the new design to make it original.<sup>34</sup>

Meanwhile, Laddie J's sentiments in *Ocular Sciences Ltd. & Anr. v Aspect Vision Care Ltd. & Ors. Geoffrey Harrison Galley v Ocular Sciences Ltd*<sup>35</sup> on the question of 'commonplace' designs are worth repeating:

'commonplace' covered designs which were ordinary, nothing more than banal, and trivial.

Any design which is trite, trivial, and common-or-garden, hackneyed or of the type which would excite no peculiar attention in those in the relevant art is likely to be commonplace. This does not mean that a design made up of features which, individually, are commonplace is necessarily itself commonplace. A new and exciting design can be produced from the most trite of ingredients. But to secure protection, the combination must itself not be commonplace.<sup>36</sup>

In this case, the design of the soft contact lens in issue were held to not be unique, and thus commonplace in the design field in question.

A more nuanced pronouncement on the notion of commonplace can be found in the decision of Mummery LJ in *Farmers Build Ltd v Carrier Bulk Materials Handling Ltd*.<sup>37</sup> Here, his Lordship explained that the Court must compare how similar the proprietor's design is to the design of similar articles in the same field of design made by persons other than the parties or persons unconnected with the parties. In this connection, the closer the similarity of the various designs to each other, the more likely it is that the designs are commonplace, especially if there is no causal link, such as

copying, which accounts for the resemblance of the compared designs. If, however, there are aspects of the plaintiff's design of the article, which are not to be found in any other design in the field in question, and those aspects are found in the applicant's design, the court would be entitled to conclude that the design in question is not 'commonplace.'

#### **D. IS 'INDIVIDUAL CHARACTER' A SUBSTANTIVE REQUIREMENT UNDER CARIBBEAN REGISTERED DESIGN LEGISLATION?**

Although Section 1B of the UK's Registered Design Act, as amended, provides that novelty and individual character are the substantive requirements for registered designs to obtain protection, the question arises as to whether the individual character requirement equally applies in the Caribbean, in the absence of explicit mention of such in regional designs legislation. Individual character is related to novelty, but it is not the same thing as novelty. More pointedly, individual character, in the UK and, indeed, EU context, refers to a circumstance where the overall impression which a design produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date. By contrast, regional registered design legislation simply make reference to either novelty alone or in combination with originality, thereby seemingly excluding the requirement for individual character. Against the backdrop of Laddie J's sentiment in *Ocular Sciences Ltd. & Anr. v Aspect Vision Care Ltd. & Ors. Geoffrey Harrison Galley v Ocular Sciences Ltd*<sup>38</sup> that 'it cannot necessarily be assumed that similar expressions have similar meanings in the two statutes', an argument for implying a requirement of individual character in regional legislation is highly problematic. This view is seemingly augmented by WIPO's Model Law for Developing Countries on Industrial Designs, which does not explicitly introduce an 'individual character' requirement, although it speaks to novelty. Against this backdrop, when interpreting

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<sup>34</sup> *ibid* 43.

<sup>35</sup> [1997] RPC 289.

<sup>36</sup> *ibid* 430.

<sup>37</sup> [1999] RPC 461.

<sup>38</sup> [1997] RPC 289.

regional registered design legislation, it would seem that novelty, in the sense of an identical or substantially similar design not having previously been disclosed to the public, is the threshold requirement, and nothing more.

#### 4. EXCEPTIONS

Regional legislation outlines circumstances that would prevent the registration of a design.

##### A. PUBLIC ORDER/MORALITY

The majority of Caribbean legislation, like their UK counterparts, do not protect designs that are contrary to public order / morality.<sup>39</sup>

##### B. FEATURES DICTATED SOLELY BY TECHNICAL FUNCTION

Regional legislation, with the exception of Jamaica and Bermuda, exempt from protection, features of a design that are dictated solely by technical function. A typical provision of this nature reads as follows:

The protection under this Act does not apply to anything in an industrial design which serves solely to obtain a technical result and to the extent that it leaves no freedom as regards arbitrary features of appearance.<sup>40</sup>

As far as the interpretation of this provision is concerned, the important point to remember from *Dyson Limited v Vax Limited*<sup>41</sup> is that as long as functionality is not the only relevant factor, the design is, in principle, eligible for protection. It is only when aesthetic considerations are completely irrelevant that the features of the design are solely dictated by the need to achieve a technical solution. In

other words, where the designer had 'no freedom as regards arbitrary features of appearance' of the article, there can be no protection. However, where, in respect of a particular product, the designer is concerned with both functional and aesthetic elements, there is no objection in principle to granting design protection to such a design whose overall appearance is determined largely, but not exclusively, by functional considerations.

The exclusion applied in the case of *AMP Incorporated v Utilux Proprietary Limited*<sup>42</sup> in which the Court considered that all the features of the terminal's shape were attributable to or caused or prompted by the terminal's function of forming an electric connection between the two electric conductors, the tab and the wire in respect of washing machines. In other words, its shape possessed no features beyond those necessary to enable it to fulfil its function.

On another note, it should be remembered that not all regional legislation is drafted in the same manner, so it cannot be automatically assumed that the technical function exclusion applies across all of the islands. For example, because the Bermudan Copyright and Designs Act introduces a system of unregistered design protection, purely functional designs can be protected, as expressed by the England and Wales court in the case of *Landor & Hawa International Ltd v Azure Designs Ltd*.<sup>43</sup>

##### C. METHOD OR PRINCIPLE OF CONSTRUCTION

In a similar vein to the CDPA, Section 35(2) of the Bahamas Industrial Property Act and Section 2 of the Guyana Patents and Designs Act exclude a method or principle of construction from design protection. The other islands' legislation are

<sup>39</sup> Anguilla Industrial Designs Act 2002, s 3(4); Antigua and Barbuda Industrial Designs Act 2003, s 4(4); Barbados Industrial Designs Act CAP 309A, s 10 ('breach of the peace'); Belize Industrial Designs Act CAP 254, s 3(3); Dominica Industrial Designs Act 1998, s 3(3); Jamaica Designs Act 1937, s 14; St Lucia Industrial Designs Act 2001, s 4(4); St Vincent and the Grenadines Industrial Designs Act CAP 312, s 4(4); Trinidad and Tobago Industrial Designs Act CAP 82:77, s 4(4).

<sup>40</sup> Anguilla Industrial Designs Act 2002, s 2(2); Antigua and Barbuda Industrial Designs Act 2003, s 3(2); Barbados Industrial Designs Act

CAP 309A, s 8(b); Belize Industrial Designs Act CAP 254, s 2; Dominica Industrial Designs Act 1998, s 2; St Lucia Industrial Designs Act 2001, s 3(2); St Vincent and the Grenadines Industrial Designs Act CAP 312, s 3(2); Trinidad and Tobago Industrial Designs Act Chapter 82:77, s 3(2).

<sup>41</sup> [2010] EWHC 1923 (Pat).

<sup>42</sup> [1971] FSR 572.

<sup>43</sup> [2006] EWCA Civ 1285.

silent on this issue; as such, it could be assumed that methods or principles of construction might obtain protection in these islands, since it is arguable that if the respective legislatures wished to exclude methods or principles of construction, they would have said so explicitly.

For interpretative purposes, the decision of *Bailey v Haynes*,<sup>44</sup> which excluded from protection the design of a fishing mesh which was apparently generated by the Atlas Warp Stitch method, is instructive. In that case, the court considered that a designer could not obtain a monopoly over a process or operation by which a shape is produced, though the shape itself is not, *per se*, excluded from protection. In other words, if a particular method or principle of construction exists, competitors are not to be prevented from using this process to produce articles, provided that these competing designers do not produce the same shape or configuration as the design right owner's.

#### D. MUST MATCH & MUST FIT EXCEPTIONS

The Bermudan Copyright and Designs Act<sup>45</sup> is the only piece of regional legislation that expressly includes the 'must match' and 'match fit' exceptions.

Under section 292(3)(b) of that Act, 'design right does not subsist in features of shape or configuration of an article which are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part.' The effect of this 'must match' provision was considered in *Dyson v Qualtex*,<sup>46</sup> a case in which the Court considered that for the exception to apply, the features of an article (A1) (for example, spare parts) must be dependent upon that of a larger article (A2) (for example, a vehicle) of which A1 forms an integral part, such that the designer had little freedom but to build A1 in the manner in which he did. On the basis of the *Dyson* decision, if it is the case that the designer of A1 had design freedom, for example in designing his A1 spare parts to form an integral part of A2, and those

parts are ultimately identical to the main designer's parts, the exception will not apply, and the designer of A1 is likely to be liable to be sued by A2 for infringing his design right.

Unlike the UK's Registered Designs Act, no provision is made in regional legislation for component parts (for example, spare parts) of a complex product (for example, a vehicle), wherein those spare parts could obtain design protection if they remain visible during normal use, are new and have individual character.

The 'must fit' exception can be found in section 292(3)(b)(i) of the Bermudan Copyright and Designs Act. Where this exception applies, design right would not subsist in features of shape or configuration of an article 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 interpretation of this provision was considered by Laddie J in *Ocular Sciences Ltd. & Anr. v Aspect Vision Care Ltd. & Ors. Geoffrey Harrison Galley v Ocular Sciences Ltd*,<sup>47</sup> when he expressed that even where an article is decorative, if the design of that article (A1) was chosen by the designer as a way of achieving a fit between the subject article and the article to which it fits or with which it interfaces (A2), then it does not attract design right protection. In *Ocular Sciences Ltd*, because the features of the soft contact lens in question were designed the way they were so as to enable the lens to fit on the eye and under the eyelids so as to achieve better focus and greater eye stability, no design right subsisted in the design of said lens.

#### E. SURFACE DECORATIONS

The Bermudan Copyright and Designs Act is the only piece of regional legislation that explicitly exempts from design protection 'surface decorations.'<sup>48</sup> The term 'surface decorations' is not expressly defined by the Act, but the case of *Neptune (Europe) Limited v Devol Kitchens Limited*<sup>49</sup> appears to suggest that it primarily contemplates 2

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<sup>44</sup> [2007] FSR 10.

<sup>45</sup> Copyright and Designs Act 2004 (Bermuda).

<sup>46</sup> [2004] EWHC 2981.

<sup>47</sup> [1997] RPC 289.

<sup>48</sup> Copyright and Designs Act 2004 (Bermuda) s 292(3)(c).

<sup>49</sup> [2017] EWHC 2172 (PAT).

dimensional features of a design, such as decorations lying on the surface of an article (for example, a painted finish). On the facts of *Neptune*, however, the Court rejected the argument that the cock-beading and moulding on the Claimant's Chichester kitchen units were excluded from design right protection because they were surface decorations. Instead, the Court found that they were truly three dimensional in nature, and formed a prominent and striking part of the shape of the doors in question.

On another note, it is submitted that an important consideration to bear in mind when interpreting the Bermudan statute is that even if surface decorations are excluded from protection by virtue of design law, copyright law may nonetheless afford them the requisite protection, if they, indeed, amount to original artistic works.

## 5. RIGHTS CONFERRED

The owner or joint owner or employer or the person who commissions the design of an article, as the case may be, has exclusive rights in respect of the 'exploitation' of the design in question. This includes, but is not limited to, making articles bearing or embodying the design in question or exhibiting, selling or importing articles bearing or embodying the design.<sup>50</sup> Curiously, under Section 8 of the Jamaica Designs Act, should an individual wish to claim exclusive rights in his

design, he must, before putting the article embodying the design on sale, ensure that the article in question is marked with the prescribed mark (that is, ®) or with the prescribed word or words or figures, denoting that the design is registered.<sup>51</sup> Interestingly, if he fails to do so, then his right in the design ceases, unless the proprietor can show that he took all proper steps to ensure the marking of the article.

More generally, under the respective regional designs legislation, the owner of a design right may also grant a license to another person to exploit the rights inherent in the design,<sup>52</sup> and the licensee may take appropriate action to enforce these rights where there has been a breach by way of a court action.

## 6. DURATION

Legislation in the vast majority of Caribbean countries stipulate that design right subsists in increments of five years, and, pending renewal, can be extended to up to 15 years from the filing date of the application for registration.<sup>53</sup> In St. Vincent and the Grenadines, however, the maximum period for the subsistence of design rights is 10 years.<sup>54</sup>

In so far as Bermuda's unregistered design right is concerned, under Section 295(1) of the Copyright and Designs Act,<sup>55</sup> this right subsists for a period of 15 years from the end of the calendar year in which the design was first recorded in a

<sup>50</sup> Anguilla Industrial Designs Act 2002, s 4 and 8; Antigua and Barbuda Industrial Designs Act 2003, s 5 and 10; The Bahamas Industrial Property Act CAP 324, s 35; Barbados Industrial Designs Act CAP 309A, s 5, 6 and 7; Belize Industrial Designs Act CAP 254, s 4 and 10; Bermuda Copyright and Designs Act 2004, s 310; Dominica Industrial Designs Act 1998, s 4 and 10; Guyana Patents and Designs Act CAP 90:03, s 74; St Lucia Industrial Designs Act 2001, s 5 and 9; St Vincent and the Grenadines Industrial Designs Act CAP 312, s 5 and 9; Trinidad and Tobago Industrial Designs Act CAP 82:77, s 5 and 9.

<sup>51</sup> Jamaica Designs Act 1937, s 8.

<sup>52</sup> Anguilla Industrial Designs Act 2002, s 13; Antigua and Barbuda Industrial Designs Act 2003, s 15; Barbados Industrial Designs Act CAP 309A, s 29 and 33; Belize Industrial Designs Act CAP 254, s 4 and 16; Bermuda Copyright and Designs Act 2004, s 301 and 313; Dominica Industrial Designs Act 1998, s 4 and 16; Jamaica Designs

Act 1937, s 16; St Lucia Industrial Designs Act 2001, s 14; St Vincent and the Grenadines Industrial Designs Act CAP 312, s 14; Trinidad and Tobago Industrial Designs Act CAP 82:77, s 14.

<sup>53</sup> Anguilla Industrial Designs Act 2002, s 9; Antigua and Barbuda Industrial Designs Act 2003, s 11; The Bahamas Industrial Property Act CAP 324, s 36; Barbados Industrial Designs Act CAP 309A, s 26; Belize Industrial Designs Act CAP 254, s 11; Bermuda Copyright and Designs Act 2004, s 295(1); Dominica Industrial Designs Act 1998, s 11; Guyana Patents and Designs Act CAP 90:03, s 66; Jamaica Designs Act 1937, s 7; St Lucia Industrial Designs Act 2001, s 10; St Vincent and the Grenadines Industrial Designs Act CAP 312, s 10; Trinidad and Tobago Industrial Designs Act CAP 82:77, s 10.

<sup>54</sup> Industrial Designs Act 2009 (CAP 312) (St. Vincent and the Grenadines).

<sup>55</sup> Copyright and Designs Act 2004 (Bermuda).

design document or an article was first made to the design, whichever first occurred. However, where articles made to the design are made available for sale or hire within 5 years from the end of that calendar year, the application period of protection is 10 years from the end of the calendar year in which that first occurred.

## 7. INFRINGEMENT

The majority of registered design legislation in the Commonwealth Caribbean provide for two forms of infringements,<sup>56</sup> namely primary and secondary infringements. Primary infringements arise where a person, other than the design owner and without the design owner's permission, makes an article bearing or embodying the design. More pointedly, primary infringement would arise where the third party's design differs only in minor respects from the design owner's design. It would even extend to circumstances where the third party's article, embodying the design owner's design, is a different article from what the design owner had claimed design rights under.

Although the foregoing is the general approach countenanced by the majority of the region's design legislation, Section 35 of the Bahamian Industrial Property Act<sup>57</sup> is slightly nuanced in that it explicitly requires, first, the copying of the proprietor's design, and, second, the making, in the Bahamas, of an article according to that design or a design not substantially different therefrom. This provision is similar to section 226(2) of the UK CDPA, which provides that reproduction of a design means 'copying the design so as to produce articles exactly or substantially to that design.' The case of *C & H Engineering v F. Klucznik & Sons Ltd*<sup>58</sup> is instructive in its discussion of the test for infringement where a provision such as that which obtains in the Bahamian legislation exists. In that case, the court explained that the

alleged infringing article or articles must be compared with the document or article embodying the design. Thereafter, the court must decide whether copying took place and, if so, whether the alleged infringing article is made exactly to the design or substantially to that design. Whether or not the alleged infringing article is made substantially to the plaintiff's design is an objective test to be determined through the eyes of the person to whom the design is directed. In that case, the claimant alleged that the defendant infringed its copyright in drawings for lamb creep feeders. The defendant counterclaimed that claimant had infringed its design right in the design of a pig fender. The defendant's pig fenders were designed to meet an order by a pig farmer, B. B required top edge that did not scratch the sows' teats as they stepped over the pen. This was achieved in the defendant's design by placing a two-inch metal tube around the top edge. The claimant was also asked to supply pig fenders for B. An employee of the claimant saw the defendant's design and was told that a round tube was required around the top edge. The claimant made its pig fenders to this design but also made it possible to stack them by flaring out the sides. It was held that, taken as a whole, the pig fenders of the claimant and the defendant were not substantially the same, notwithstanding the use of the two-inch tube in both. An interested man would be struck by the design features that enable the claimant's pig fender to be stacked. Those features not only attracted the eye, but would also be seen by an interested person as functionally significant.

On another note, secondary infringement arises where a third party, for a commercial purpose and without the design owner's permission, exhibits, imports or sells an article bearing or embodying the design. The standards for claiming secondary liability are that the person has engaged in the foregoing acts for a 'commercial purpose' and that he had knowledge or has reason to believe that the article in

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<sup>56</sup> Anguilla Industrial Designs Act 2002, s 9 and 21; Antigua and Barbuda Industrial Designs Act 2003, s 10; The Bahamas Industrial Property Act CAP 324, s 35; Barbados Industrial Designs Act CAP 309A, s 5; Belize Industrial Designs Act CAP 254, s 10 and 24; Bermuda Copyright and Designs Act 2004, s 305(3); Dominica Industrial Designs Act 1998, s 24; Guyana Patents and Designs Act

CAP 90:03, s 74; Jamaica Designs Act 1937, s 12; St Lucia Industrial Designs Act 2001, s 9 and 22; St Vincent and the Grenadines Industrial Designs Act CAP 312, s 9 and 21; Trinidad and Tobago Industrial Designs Act CAP 82:77, s 9 and 22.

<sup>57</sup> Industrial Property Act 1965 (Bahamas).

<sup>58</sup> [1992] FSR 421.

question is an infringing article. On the court's approach to the question of secondary infringement, the judgment of *Action Storage Systems Limited v G-Force Europe.Com Limited, Fletcher European Containers Limited*<sup>59</sup> is instructive. In that case, the Claimant, who had designed 'eXtreme Lockers', succeeded in an action for secondary infringement against the defendant who had sold 'SuperTuff' lockers, which were created by copying the design of the eXtreme lockers, and were unsurprisingly made substantially to the overall design of the eXtreme lockers.

As far as unregistered design rights are concerned, under Section 305(3) of the Bermuda Copyright and Designs Act, if a third party, without permission and for a commercial purpose, copies the proprietor's design to produce articles exactly or substantially to that design, there is an infringement. Again, this provision is similar to section 226 of the CPDA, and thus cases such as *C & H Engineering v F. Klucznik & Sons Ltd* and *Landor & Hawa International Ltd v Azure Designs Ltd*<sup>60</sup> are instructive. In *Landor*, in particular, the court held that the defendant had infringed the claimant's unregistered design right in the expander section of its suitcase by designing its own expander section substantially to the claimant's design. The court found that copying by the defendant's designer did take place, and that when the designs were compared to each other, there was no difference of substance as between them. Accordingly, the claimant's claim of infringement succeeded.

## 8. AREAS REQUIRING APPROXIMATION

The foregoing discussion highlights clearly, that the current legislative landscape with respect to design protection in the Commonwealth Caribbean represents a mismatch of approaches in a number of areas, which signal the pressing need for approximation of regional legislation.

First, there needs to be approximation around the question of whether 'eye appeal' should continue to be a precondition for obtaining design protection, as there is increasing recognition in some quarters that designs that perform a

largely functional purpose, and whose object is not necessarily to attract spectators, should nonetheless be protected on the basis of their dissimilarity from the prior art and/or their originality. Second, there is a need for approximation around the question of whether design right can only be claimed in respect of the appearance of a product as a whole or in respect of a part of a product. It is submitted that a common regional approach should be that design right could be claimed in respect of the appearance of a product as a whole and in respect of parts of said product, since the former approach, without more, is very restrictive in nature. Third, there needs to be approximation around the question of whether design right subsists in 'any aspect' of the shape or configuration of an article. It is submitted that the approach countenanced by the 2014 amendment to the UK CPDA should be adopted, such that a person cannot claim design protection for small and arbitrary aspects of an article. Fourth, there needs to be approximation around the question of whether, as a basis for obtaining protection, the design in question needs to be new or original. Given the disparity in approaches countenanced, it is submitted that the more practical and modern approach would be that of 'novelty' since its primary focus is on whether the design has been previously disclosed to the public, and not simply whether it is original in the sense of being the author's intellectual creation. Fifth, there needs to be approximation around the question of whether 'commonplace' is a necessary precondition for design protection. It is submitted that, in keeping with developments in the UK, and, by extension, in the EU, it is prudent that 'commonplace' be widely countenanced, so as to exclude protection for ordinary, banal, and trivial designs. Finally, it is prudent that there be approximation around the question of whether a person is required to use the prescribed mark ® before putting the article embodying the design on sale. It is submitted that this is an out-of-date requirement which only disincentives the registration of industrial designs, and thus should not be countenanced when regional design legislation are approximated.

<sup>59</sup> [2016] EWHC 3151 (IPEC).

<sup>60</sup> [2006] EWCA Civ 1285.

## 9. CAYMAN ISLANDS DESIGN RIGHTS BILL, 2019

Efforts to bring reform in the area of design rights protection in the Caribbean have been remarkably slow. The only island which has made any real effort to bringing reform to legislation on design protection is the Cayman Islands, which, at the time of writing, had tabled the Design Rights Bill, 2019<sup>61</sup> (Bill).

Under the new Bill,<sup>62</sup> 'design' is defined as 'the design of the shape or configuration (whether internal or external) of the whole or part of an article.' What is noteworthy about this definition is that it omits the words 'any aspect', which was in pari materia with the pre-2014 UK Copyright, Designs and Patents Act. The effect of this provision has already been discussed above in respect of the case of *Neptune v Devol*,<sup>63</sup> but it suffices here to note that there will be no protection for abstract designs; that is, features of designs that are disembodied from the design and are merely recognizable or discernible.

In so far as the substantive requirements for protection are concerned, the Bill, like the former Act, makes reference to the requirement of originality,<sup>64</sup> which has been interpreted to mean that the design is the designer's intellectual creation, and it is as a result of sufficient skill and judgment having been expended by the designer in the creation of the design. Designs which are 'commonplace'<sup>65</sup> in the design field will not attract protection; that is, designs which are trivial, hackneyed and which excite no particular attention will not obtain design right protection. In addition to the requirement for originality, it is noteworthy that a further prerequisite to protection is that the person in question must be a qualifying person; that is, the person must have some connection to the Cayman Islands, whether as a national or resident, a British citizen or a company having substantial business activity in

the islands. Compared to the rest of the Caribbean, the Cayman Islands' legislation seems to limit the range of persons who may benefit from design rights protection. On a separate note, the design must be recorded in a design document or an article must have been made to the design in order for it to obtain protection.<sup>66</sup>

The new Bill outlines a number of features, which are expressly excluded from design protection. These include, a method or principle of construction; features of shape or configuration of an article, which enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function ('must fit' exception); or which are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part ('must match' exception); and surface decorations.<sup>67</sup>

Provided that the design in question meets the threshold definition requirement and satisfies substantive conditions for obtaining protection, ownership of the design rests with the designer.<sup>68</sup> However, in the case of jointly created designs, the designers will jointly be regarded as the owners.<sup>69</sup> If a design is made in the course of employment, the employer will, under the Bill, be regarded as the designer.<sup>70</sup>

Registered designs have a life of 15 years from the end of the calendar year in which said designs were first recorded in a design document or articles were first made to the designs, whichever first occurred.<sup>71</sup> During this period, design right is transmissible by assignment, by testamentary disposition or by operation of law as personal or moveable property.<sup>72</sup> The design may also be made subject to a license, which is granted by the owner of the design right and binding on every successor in title to the owner's interest in the right, except a

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<sup>61</sup> Design Rights Bill 2019 (Cayman Islands).

<sup>62</sup> *ibid.*

<sup>63</sup> [2017] EWHC 2172.

<sup>64</sup> Cayman Islands Design Rights Bill (n 61), s 14(1).

<sup>65</sup> *ibid.*, s 14(3).

<sup>66</sup> *ibid.*, s 14(5).

<sup>67</sup> *ibid.*, s 14.

<sup>68</sup> *ibid.*, s 15(1).

<sup>69</sup> Cayman Islands Design Rights Bill (n 61), s 16(3).

<sup>70</sup> *ibid.*, s 15(2).

<sup>71</sup> *ibid.*, s 16(1).

<sup>72</sup> *ibid.*, s 21(1).

purchaser in good faith for valuable consideration and without notice (actual or constructive) of the license or a person deriving title therefrom.<sup>73</sup> Licensees have rights and remedies, which are concurrent with those of the design right owner.<sup>74</sup>

Design owners have the exclusive right to reproduce the design for commercial purposes by making articles to that design (that is, copying the design so as to produce articles exactly or substantially to that design); or by making a design document recording the design for the purpose of enabling such articles to be made.<sup>75</sup> The new Bill recognizes two forms of infringement. The first is primary Infringement, which arises where a defendant, without a license, makes, or authorizes another to make, articles to the owner's design or makes a design document recording the design for said purpose.<sup>76</sup> The second is secondary Infringement, which arises where a person who, without the license of the design right owner, imports an infringing article into the Islands for commercial purposes; has in his or her possession an infringing article for commercial purposes; or sells, lets for hire, or offers or exposes for sale or hire, in the course of a business, an infringing article.<sup>77</sup> It is particularly noteworthy that the new Bill distinguishes between design right infringement and copyright infringement. In this connection, only the former (making an article to the design) is actionable under the new Bill, and not the latter (i.e. copying of design drawings).<sup>78</sup>

The remedies, which are available to design right owners upon an infringement having been established, are damages, injunctions or accounts of profits.<sup>79</sup> Additional damages may be awarded in appropriate cases, depending upon the flagrancy of the infringement; and any benefit accruing to the defendant due to the infringement. That said, no damages

might be awarded under the new Bill for innocent infringement, albeit other remedies remain available.<sup>80</sup> Other available remedies include an order for delivery up of infringing article (where the article is in custody, possession and control of the design right owner);<sup>81</sup> and forfeiture or destruction of an infringing article.<sup>82</sup>

Notwithstanding the existence of the exclusive right of owners and their ability to claim for infringement in appropriate cases where their right has been used for a commercial purpose without their permission, it is noteworthy that the new Bill makes provision for certain permitted uses, such as Crown use of design.<sup>83</sup> Crown use may arise, for example, during public emergencies such as war, or to protect essential services, productivity of industry, commerce and agriculture, fostering and directing exports and reducing imports, and assisting the relief of suffering.<sup>84</sup> That said, it should be borne in mind that compensation is payable for any loss resulting from the right owner or the exclusive licensee not being awarded a contract to supply the articles made to the design.<sup>85</sup> Other permitted uses include an act which is done privately and for purposes which are not commercial; an act which is done for experimental purposes; or an act of reproduction for teaching purposes or for the purpose of making citations provided that the act of reproduction is compatible with practice and does not unduly prejudice the normal exploitation of the design; and mention is made of the source.<sup>86</sup>

One of the important features of the new Bill is that it places restrictions upon a design owner obtaining a monopoly over his registered design for the full period envisaged by the Bill. In this connection, under Section 35(1) of the Bill, any person is entitled as of right to a licence to do in the last five years of the design right term any act, which would otherwise infringe

<sup>73</sup> *ibid*, s 21(4).

<sup>74</sup> *ibid*, s 32.

<sup>75</sup> *ibid*, s 25(1).

<sup>76</sup> *ibid*, s 25(3).

<sup>77</sup> *ibid*, s 26(1).

<sup>78</sup> *ibid* s 34.

<sup>79</sup> *ibid* s 28(2).

<sup>80</sup> *ibid* s 31(1).

<sup>81</sup> *ibid* s 31(1).

<sup>82</sup> *ibid* s 30.

<sup>83</sup> *ibid* s 37.

<sup>84</sup> *ibid* s 41.

<sup>85</sup> Cayman Islands Design Rights Bill (n 61), s 40.

<sup>86</sup> *ibid*, s 42.

the design right. The Bill envisages that the parties will agree to the grant of the license, but in default, the dispute is to be settled by a Design Rights Tribunal, whose creation is provided for under the Bill. Where a person has acquired a license in this connection, where a person has used the design in an otherwise illegal way within the last five years of the design right term, the design right owner is precluded from bringing a claim for an injunction or delivery of the otherwise infringing article.<sup>87</sup> That said, damages or an account of profits may be recoverable, albeit that the same cannot exceed two times the amount which would have been payable by the defendant as licensee if such a license on those terms had been granted before the earliest infringement.

As intimated above, the new Bill introduces an interesting institutional mechanism referred to as the 'Design Rights Tribunal.' This body, when operationalized, will be responsible for making binding determinations on the subsistence of a design right; the term of design right; and the identity of the person in whom design right first vested.<sup>88</sup> Interestingly, all other courts or tribunals are precluded from making determinations on these specific issues, albeit that said other courts/tribunals can hear an appeal or reference from the Tribunal; and can deal with infringement or other proceedings in which the foregoing issues arise incidentally. The provision introducing the Design Rights Tribunal appears to have been adopted so as to streamline the institutional aspects of design registration, and protection from infringement in the Cayman Islands, thereby reducing the time and resources that would otherwise have been expended if multiple institutions had to be approached.

Finally, with regard to registration requirements, it is noteworthy that only a registered agent (a person legally and ordinarily resident in the Islands or a firm of attorneys-at-law) may carry on the business of acting as agent for others.<sup>89</sup> Such a person will apply to the Registrar to be enrolled as an agent. The Registrar may, where a request is made by a registered agent, issue a certificate of good standing.<sup>90</sup> Armed with this

certificate of good standing, the agent may then make an application to the Registrar for the registration of a design right, supported by payment of the prescribed application fee.<sup>91</sup> Where the design meets the requisite conditions for registration, as described above, it will be registered in the Register of Designs.

## 10. CONCLUSIONS

This research paper provided a detailed articulation of the applicable rules, principles and guidelines relevant to the protection of registered and unregistered designs in the Caribbean, largely from a doctrinal and comparative perspective. The chapter identified a number of similarities as between the approaches countenanced in the United Kingdom and the Caribbean, whilst also outlining in a jurisprudentially grounded manner the differences that continue to exist between the two regions. The conclusion arrived at, in this connection, is that the protection of design rights is important for the development of cultural and creative industries in the Caribbean. In fact, Caribbean designers have benefited from design protection in respect of chairs, toothbrushes, jewellery, costumes and items fashion designs, as well as food containers, sports balls, coolers and spray caps for aerosol sprays. There has evidently been growth in the cultural and creative industries in the Caribbean, largely due to design protection.

This article has also highlighted the areas of convergence in respect of the applicable tests for infringement and invalidity, and pointed to the circumstances in which recourse to the courts to protect design rights might be possible. Nonetheless, it advanced the argument that there are several weaknesses in how regional legislation address industrial designs, which require amelioration. For example, it pointed to the divergent ways in which regional legislation posit the requirements for obtaining protection; namely, some legislation refer to 'novelty' alone, while others refer to 'originality', and yet still others refer to 'originality or novelty'

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<sup>87</sup> *ibid*, s 36(2). In effect, a compulsory licensing system has been created.

<sup>88</sup> *ibid*, s 48(1).

<sup>89</sup> *ibid*, s 5(1).

<sup>90</sup> *ibid*, s 11.

<sup>91</sup> *ibid*, s 6(1).

or ‘originality and novelty.’ It was argued that these terms bear their own nuances in how they are defined, and that English jurisprudence on these matters should not be unquestionably transplanted. Another point raised by the article is that there is arguably little room for the inclusion of ‘overall impression’ in the interpretation of regional designs legislation, though such an approach is countenanced in jurisdictions like the EU. The Cayman Islands’ proactive approach to design protection is advanced as a useful model that should inform the reform of regional designs legislation.

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