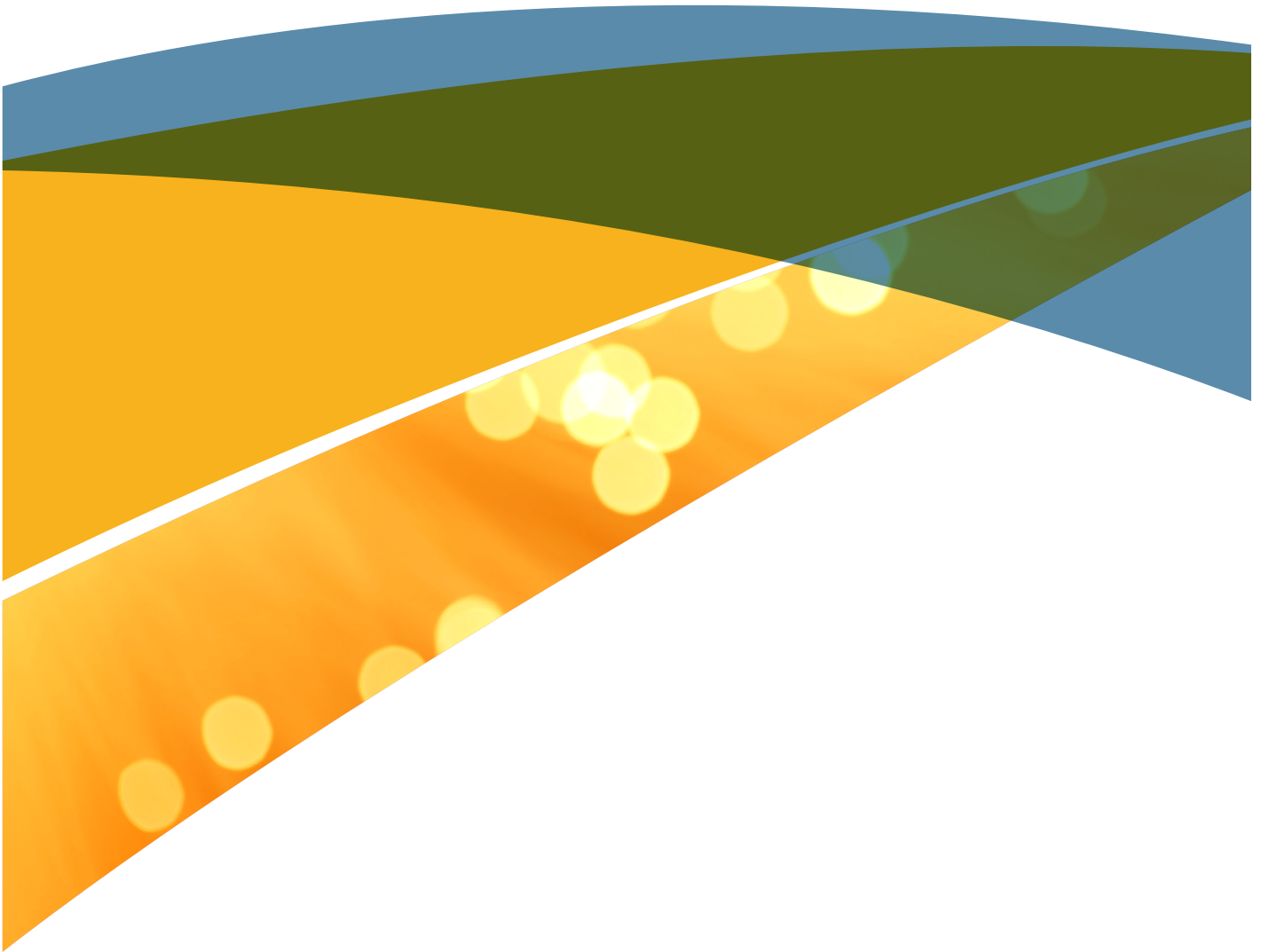




Intellectual
Property
Office

Consultation on the implementation of a Design Opinions Service





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Foreword



This consultation continues the work we are doing to modernise the law on designs so that it better supports our creative sectors. Coming from a business background I am well aware that the cost of litigation can be a real barrier to companies and individuals looking to exploit their intellectual property rights or to avoid infringing the rights of others. This Government has already done much to make the Intellectual Property and Enterprise Court more accessible to SMEs in particular. We have also recently finalised proposals to lower the costs of appeals from design decisions of the Intellectual Property Office (IPO).

It is also important that we support alternative procedures for helping companies and individuals resolve their IP disputes. In 2006 the IPO introduced a patent opinions service to provide affordable, impartial yet authoritative opinions on questions relating to the infringement or the validity of patents. The IPO has to date issued over 230 patent opinions and although they are non-binding in nature, they have nevertheless helped many companies and individuals resolve their disputes without the need for costly litigation.

We are now working on introducing a similar service for designs. The Intellectual Property Act 2014 set out the broad principles of the designs opinions service. This consultation sets out in more detail how we think the service should work. It also sets out the detailed draft regulations that will govern the service.

I very much hope that you will take this opportunity to let us know what you think of our proposals.

A handwritten signature in cursive script that reads "Lucy Neville-Rolfe". The signature is written in black ink on a white background.

Baroness Neville-Rolfe, DBE, CMG
Minister for Intellectual Property

1. Introduction

- 1.1 The IPO is committed to introducing a service that provides non binding opinions on questions relating to designs registered under the Registered Designs Act 1949 (RDA) and on matters relating to “designs of such other description as may be specified”. The Intellectual Property Act 2014¹ (“IP Act”) sets out the broad principles of the service. We are now consulting on the detailed procedure and draft regulations.
- 1.2 We published a summary of the government’s planned regulations (see <http://www.ipo.gov.uk/ipbill-summary.pdf>) during the passage of the Bill.
- 1.3 We have now produced a draft set of detailed regulations. We have sought to model, to the extent possible, the regulations and procedure on the existing patent opinions service.

2. Responding to the Consultation

- 2.1 The Government welcomes responses to the issues raised in this consultation document from any individual, organisation or company. Responses to the specific questions which are raised in this document are particularly welcomed, together with any other comments you may have. It is not necessary to respond to all the questions – you are welcome to provide answers only to those issues of most interest or relevance to you.
- 2.2 While the Government will do its best to note responses that are outside the scope of this consultation, it may not be in a position to respond to those points alongside the issues we are asking about.
- 2.3 Please email your responses to: opinionsconsultation@ipo.gov.uk. Alternatively, please use the following postal address:

Address:

Karl Whitfield
Intellectual Property Office
Room 1R94, Concept House
Newport
South Wales
NP10 8QQ

Tel: 01633 814734

- 2.4 Please let us have your comments by 15 May 2015.
- 2.5 A list of organisations being sent this document is given at Annex A.

¹ <http://www.legislation.gov.uk/ukpga/2014/18/contents/enacted>

3. What happens next?

- 3.1 The IPO intends to publish a summary of responses to the consultation within three months of the closing date. We will carefully consider all responses and then lay the final version of the rules in Parliament in time for commencement in October 2015.

4. Complaints

- 4.1 If you wish to comment on the conduct of this consultation or make a complaint about the way this consultation has been conducted, please write to:

Angela Rabess
Better Regulation Unit,
1 Victoria Street,
London SW1H 0ET

Tel: 020 7215 1661

E-mail: Angela.Rabess@bis.gsi.gov.uk

5. Openness/Confidentiality

- 5.1 This is a public consultation, the results and conclusions of which may be published. As such, your response may be made public. If you do not want all or part of your response or name made public, please state this clearly in the response. Any confidentiality disclaimer that may be generated by your organisation's IT system or included as a general statement in (for example) your email response or fax cover sheet will be taken to apply only to information in your response for which confidentiality has been requested.
- 5.2 Information provided in response to this consultation, including personal information, may be subject to publication or release to other parties or to disclosure in accordance with the access to information regimes (these are primarily the Freedom of Information Act 2000 (FOIA), the Data Protection Act 1998 (DPA) and the Environmental Information Regulations 2004). If you want information, including personal data that you provide, to be treated as confidential, please be aware that, under the FOIA, there is a statutory Code of Practice with which public authorities must comply and which deals, amongst other things, with obligations of confidence.
- 5.3 In view of this it would be helpful if you could explain to us why you regard the information you have provided as confidential. If we receive a request for disclosure of the information we will take full account of your explanation, but we cannot give an assurance that confidentiality can be maintained in all circumstances. An automatic confidentiality disclaimer generated by your IT system will not, of itself, be regarded as binding on the Department.

6. Impact Assessment

- 6.1 During Parliamentary scrutiny of the Intellectual Property Act, an impact assessment (IA) was produced for the introduction of a design opinions service. This IA set out our assessment of the impact this proposal will have and can be accessed alongside the other IAs relating to the legislation².
- 6.2 We do not envisage any changes to this IA being necessary following the current consultation – which is purely directed to the detail of the secondary legislation.

7. Summary of Proposals

- 7.1 The service will provide opinions on:
- I. Whether a UK or Community registered design, or UK or Community unregistered design, is being infringed or potentially infringed;
 - II. Whether a UK registered or Community registered or unregistered design is valid;
 - III. Whether a UK unregistered design right subsists in a particular design.
 - IV. The duration of any UK unregistered design right
- 7.2 The opinion procedure will involve three rounds of written submissions – an initial request, observations and finally observations in reply. We will aim to issue opinions within three months of the request.
- 7.3 The fee for filing an opinion request is proposed to be £200.
- 7.4 Opinions will be non-binding for all purposes.
- 7.5 An appeal to the appointed person against an opinion will be available, but only to the rights holder and only where the rights holder believes that an opinion has wrongly concluded that the design is invalid.
- 7.6 In brief, the process will be:
- I. The request will be made using the prescribed form and will need to be accompanied by the fee and a statement setting out clearly the question on which the opinion is sought.
 - II. The opinion request will be published on the IPO's official webpages so enabling interested parties not identified in the request to provide observations.
 - III. Any interested parties will be permitted 4 weeks in which to provide observations.
 - IV. The requester will have 2 weeks to provide observations in response to the observations filed.
 - V. The registrar will issue and publish the opinion normally within three months of the request.

2 <http://services.parliament.uk/bills/2013-14/intellectualproperty/documents.html>

8. Detailed proposals - the draft Design Opinions Service Regulations 2015

- 8.1 The draft Design Opinions Service Regulations 2015 are shown at Annex B. In addition to the specific questions we pose in this document, we welcome any other comments and suggestions both upon the proposed service detailed below and on the draft regulations themselves.
- 8.2 As noted above, the detail of the draft regulations follows closely the approach taken with the existing patent opinions service.

9. Scope of the Design Opinions Service (regulation 5)

- 9.1 The IP Act provides that opinions must relate to designs registered under the RDA, but also allows the service to include “designs of such other description as may be specified”. In addition to UK registered designs, this wording gives us the possibility of providing design opinions on UK unregistered designs, Community registered designs and Community unregistered designs.
- 9.2 To provide opinions only on UK rights would limit the usefulness of the service. Businesses must routinely deal with UK and Community rights, whether as rights holders or where seeking to avoid infringement. We are therefore proposing to give opinions on both UK and Community registered and unregistered design rights.
- 9.3 We envisage individuals or businesses with a UK interest, for example UK based individuals or companies or individuals or companies looking to do business in the UK, to be the main users of the service. However, if we offer opinions on Community rights there is the potential for opinion requests from requesters with no UK interest. We did consider limiting who could request opinions in the regulations to those with a clear UK interest. However, we have decided not to do this because, firstly, we would expect the number of requesters with no UK interest to be very small and, secondly, this would be very difficult to enforce if, as we propose below, we also intend to allow anonymous requests for opinions.

Question 1. Do you agree that the IPO should offer opinions on both UK and Community designs? If not, why?

Question 2. Do you agree that the IPO should offer opinions to requesters irrespective of a UK connection, such as place of domicile of rights owner or location of infringement?

Question 3. If opinions requests should not be available to those without a UK connection, on what basis should they be limited especially in view of our intention to allow anonymous requests?

10. Specific matters on which an opinion may be sought (regulation 6)

UK registered designs, Community registered and unregistered designs

- 10.1 We intend to offer an opinion on whether a UK registered design, a Community registered design or a Community unregistered design is being infringed (or potentially infringed if a particular competing design were to be used). We will also offer an opinion on whether such designs are valid.
- 10.2 We intend to allow a request to be made for an opinion on the basis of any of the grounds for invalidity set out in the relevant legislation, i.e. RDA section 11ZA³ and Article 25 of Council Regulation (EC) No 6/2002 of 12 December 2001⁴ on Community designs.
- 10.3 We will however refuse to issue an opinion if in all the circumstances we think it inappropriate to do so (regulation 9). For example, we may refuse to issue an opinion if the request asks for an opinion on whether the design is invalid because the registered proprietor is not the proprietor of the design⁵. This is because determining entitlement often involves evidence-rich assessments and possibly also cross-examination of witnesses in order to reach a robust opinion. We do not consider the opinion service to be a suitable avenue for such matters. This is consistent with the approach we have taken on patent opinions. We will however consider each request on its merits.

Question 4. Do you agree that opinions on UK registered and Community registered and unregistered Designs should be available in respect of all the invalidity grounds set out in relevant legislation? If not, why?

UK Unregistered Designs (regulation 6)

- 10.4 We intend to offer opinions on whether a UK unregistered design is being infringed (or potentially infringed if a particular competing design were to be used).
- 10.5 We will also offer opinions on whether UK unregistered design right subsists in the design. Section 213 of the Copyright Designs and Patents Act 1988 (CDPA) sets out the requirements for design right to subsist and we propose to allow requests in respect of any of these requirements.
- 10.6 We will also give opinions on questions of qualification and duration of design right although from our experience disputes about these are not common.
- 10.7 For the same reasons as set out above, we are likely to refuse any request which requires a determination of ownership of design right, although (as above) this will depend upon the particular facts of each case.

³ <https://www.gov.uk/government/publications/registered-designs-act-and-rules>

⁴ <http://eur-lex.europa.eu/legal-content/EN/TXT/?qid=1422448247661&uri=CELEX:32002R0006>

⁵ Section 11ZA(2) of the Registered Designs Act 1949

Question 5. Do you agree that opinions on UK unregistered designs should be available in respect of all the grounds set out above? If not, why?

11. How the service will operate

The request (regulation 7)

- 11.1 The regulations provide that the request for an opinion must be made on the prescribed form (see Annex C). We propose to have a generic form (covering all the different rights) for all opinion requests. The form serves to provide some basic information to aid processing of the request.

Question 6. Do you have any comments on the contents of a request and the form to be used to request an opinion?

- 11.2 The regulations also require that the requester provide a statement setting out the matters on which an opinion is sought.
- 11.3 We will provide separate guidance to help requesters formulate their requests so as to ensure that the statement has fully set out the matter. For example, if an opinion on infringement is being sought, sufficient details of the potentially infringing design must be provided. If an opinion on validity regarding an earlier design is being sought, the details of that earlier design must be provided together with any accompanying material to establish its disclosure.
- 11.4 Since unregistered rights by their nature do not appear on any register, it will be especially important that the statement sets out clearly the nature of any unregistered design on which the opinion is sought.
- 11.5 The request must be accompanied by a fee which we intend to be £200, in line with opinion requests concerning patents.

Question 7. Do you agree that the fee for a designs opinion should be £200?

Question 8. If the fee for a designs opinion was significantly more than £200, for example £2000, what effect would that have on demand for the service?

Scope of a single request

- 11.6 Individual disputes about designs can sometimes involve a number of registered and unregistered rights. We do not however propose to prescribe in the regulations what a single opinion request can cover. We will instead provide guidance on this in much the same way as we have in respect of patent opinions. The guidance will say that in general we would expect each opinion request to cover a single registered design or a single unregistered design. Where the request relates to the validity of a design or to whether design right subsists, then a single request may cover any number of the grounds on which validity or subsistence can be challenged.

- 11.7 A single request will also be able to cover both infringement and validity or subsistence.

Anonymous requests

- 11.8 We will accept opinion requests anonymously, i.e. where an agent or some other form of proxy makes the request on behalf of a client. This has been the case with a number of patent opinion requests and various reviews of the patent opinions service have shown this to be an attractive feature.

Requests concerning rights whose owner is not registered

- 11.9 Where an opinion is requested to help parties resolve a dispute then it is likely that the owner of the right, in particular where the right is registered, will be known. For unregistered rights there is no registered owner. Since the value of any opinion is enhanced significantly where it is based on observations from both sides, we would expect the requester to make reasonable efforts to identify the owner. The opinion request should state who the requester believes is the owner. If a request gives no indication of the owner then it is possible that the request will be refused, although each case will be considered on its merits. We do not propose to specifically prescribe for this situation. Rather, we will rely if necessary on the general power for the registrar to refuse to issue an opinion if he considers it inappropriate in all the circumstances to do so (regulation 9).

Confidential Documents (regulation 8)

- 11.10 The opinion process is intended to be relatively quick, simple and transparent. For those reasons there will be no possibility of any document submitted in relation to an opinion being treated as confidential. Any request for confidentiality will be refused.

Refusing or withdrawing an opinion request (regulation 9)

- 11.11 In certain circumstances the registrar might not give an opinion. For example, if the request is frivolous or vexatious, if the question on which the opinion has been sought has been sufficiently considered in any relevant proceedings, or if the registrar considers it inappropriate in all the circumstances to do so.
- 11.12 If the requester withdraws the opinion request then the registrar would not issue an opinion. There is no intention that the registrar would pursue an opinion in the public interest after it has been withdrawn.

Notification and Advertisement of the requests (regulation 10)

- 11.13 Any interested parties who are either identified in the request or who are identified on the register (save for the requester) will be notified of the request.
- 11.14 All requests will also be published on the IPO's official webpages to enable any interested parties who we do not directly contact about the request to make observations (the website will be similar to the corresponding site for patent opinions which can be seen at <https://www.gov.uk/requests-for-opinions-2015>).

Observations and observations in reply (regulation 11)

- 11.15 Any person will have a period of four weeks from the date of advertisement to make observations in response to the request. It is not compulsory for a notified interested party to make observations.
- 11.16 If observations are made by anyone, the requester will be given a two week period to provide observations in reply.

The opinion (regulation 12)

- 11.17 An opinion will then be prepared on the requested matter by a suitably qualified official of the IPO. This will be issued in writing to the requester, and any interested parties, normally within three months of the receipt of the original request. The opinion will also be publically available on the IPO's official webpages.

12. Appeals (regulations 13, 14 and 15)

Scope of any appeal

- 12.1 The IP Act provides for an appeal against an opinion. This may seem inappropriate as it is only an opinion, non-binding for all purposes, and based often on limited observations. In addition, if the requester or anyone making observations disagrees with the opinion then they will most likely be able to pursue the dispute through litigation either before the IPO or the Courts. For example if an opinion concludes there was or was not infringement then the owner, or requester if different, can pursue the matter through an infringement action or an action for a declaration of non infringement. If an opinion concludes a right is valid then an invalidity action may be possible. However, in some instances there may be no obvious route by which the question dealt with by the opinion can be alternatively pursued. For example if the opinion concludes that a registered design is invalid then the owner of the right does not have an obvious route to ask the registrar or the court to confirm that the right is actually valid. It was for this reason that the IP Act provides for the possibility of an appeal. We propose to limit the availability of an appeal to such circumstances, where no other recourse is clearly available. This is consistent with the approach taken with reviews of patent opinions.
- 12.2 For opinions on UK unregistered design rights, we believe that there will always be an alternative route for considering the matter, including by the rights owner. This could involve for example bringing infringement proceedings or asking the comptroller under section 246 of the CDPA to determine if design right subsists. We therefore propose to offer no appeal on opinions concerning UK unregistered rights.
- 12.3 For opinions on UK Registered and Community Designs we propose to provide for an appeal in certain circumstances. We believe that such appeals should only be available to the owner of the right in question and only on the ground that the opinion wrongly concluded that the design was invalid. This is the only circumstance in which no other recourse is clearly available to the rights owner and hence an appeal route is required.

- 12.4 In contrast to the mechanism for challenging a patent opinion, which is by means of a review carried out within the Intellectual Property Office which can then be appealed to the Court, an appeal of a designs opinion will go direct to an appointed person. This is someone with the necessary knowledge of, and experience in applying, intellectual property law, specifically appointed after open competition by the Lord Chancellor, and independent of the IPO.

Question 9. Are we right to limit appeals to only those circumstances where there is no other avenue to pursue the matter? If not, why?

Question 10. Are there additional circumstances in which an appeal could be required and for which no other avenue is available?

Appeal Procedure

- 12.5 An appeal would be made using form DF 55, a copy of which is included in Annex D. This will need to be filed within three months of the opinion being issued. In line with the proposed rules governing appeals to the Appointed Person⁶ a fee will not be charged for an appeal.

Question 11. Do you have any comments on the form to be used to request an appeal?

Outcome of any appeal

- 12.6 An appeal is not intended to provide a second opinion. Rather it is simply a review of the opinion reached. The review will therefore either set aside the opinion or decide that no reason has been shown to set the opinion aside. This is consistent with the approach taken with reviews of patent opinions.

13. Miscellaneous provisions

- 13.1 Regulation 3 specifies that an opinion is not binding for any purposes. This is intended to make it clear that for example the Courts would not be bound in any way in any subsequent action.
- 13.2 As with the patent opinions service, regulation 4 also provides that neither the registrar, nor any other officer of the IPO would incur any liability in connection with giving an opinion.

Question 12. Do you have any further comments on the proposed service or on the draft regulations?

⁶ <https://www.gov.uk/government/consultations/rules-governing-appeals-relating-to-design-decisions-of-the-ipo>

Annex A: list of organisations being sent this document

This consultation document has been sent to the following organisations. We will also contact other individuals who have been in direct contact with us in relation to design policy issues.

Administrative Justice and Tribunals Council
Anti Copying in Design (ACID)
Anti-Counterfeiting Group
Apple
Appointed Persons
Association Against Intellectual Property Theft (AAIPT)
Association of British Chambers of Commerce
Association of the British Pharmaceutical Industry
Association for University Research and Industry Links (AURIL)
BBC
British Brands Group
British Chambers of Commerce
British Design Innovation
British Generics Manufacturing Association
British Library
British Retail Consortium
Centre of Research for Intellectual Property & Technology (SCRIPT)
Channel 4
Channel 5
Chartered Institute of Patent Attorneys
Chartered Society of Designers
Community Matters
Confederation of British Industry (CBI)
Consumer Focus
Creative Economy
Creators Rights Alliance
Design Council
Federation of Small Businesses (FSB)

: FICPI UK
: Google
: Institute of Information Scientists, Patent and Trade Mark Group
: Institute of Practitioners in Advertising
: Institute of Trade Mark Attorneys
: Intellectual Property (IP) Crime Group
: Intellectual Property Institute
: Intellectual Property Lawyers Association
: IP Federation
: Law Society of England & Wales
: Law Society of Northern Ireland
: Law Society of Scotland
: Licensing Executives Society
: London Chamber of Commerce and Industry
: Ministry of Justice
: NOKIA
: Northern Ireland Office
: Patent Judges
: Scottish Office
: Universities UK
: University of Cambridge
: University of Edinburgh
: University of London, Queen Mary
: Wellcome Trust
: Welsh Office

Annex B: Draft Design opinions Regulations 2015

STATUTORY INSTRUMENTS

2015 XXXX

DESIGNS

The Design Opinions Service Regulations 2015

Made -----xxx

Coming into force-----1st October 2015

The Secretary of State in exercise of the powers conferred by section 28A of the Registered Designs Act 1949¹ makes the following Regulations:

1. Citation and commencement

These Regulations may be cited as the Design Opinions Service Regulations 2015 and come into force on 1st October 2015.

2. Interpretation

In these Regulations –

“appointed person” means a person appointed by the Lord Chancellor under section 27A(1)(a) of the RDA 1949;

“design in suit” means the design to which that request relates;

“national unregistered design right” means design right within the meaning of Part III of the Copyright, Designs and Patents Act 1988²;

“owner of the design” means the registered proprietor of a design registered under the RDA 1949 or the registered holder of the design in respect of the registered Community design or the person identified as the design right owner in the request for an opinion in respect of the national unregistered design right and unregistered Community design;

“the RDA 1949” means the Registered Designs Act 1949 and references to a section are to references to a section of that Act, unless otherwise specified;

¹ 1949 c.88

² 1988 c.48

“registered Community design” means a design registered in the manner provided for in Council Regulation (EC) 6/2002 of 12th December 2001 on Community Designs;

“relevant proceedings” means proceedings (whether pending or concluded) before the registrar, the court or Office for Harmonization in the Internal Market;

“request” means, unless the context otherwise requires, a request for an opinion under section 28A of the RDA 1949;

“requester” means the owner of the design or the person who makes the request;

“unregistered Community design” means a design governed under Council Regulation (EC) 6/2002 of 12th December 2001 on Community Designs;

“the 2006 Rules” means the Registered Design Rules 2006³

3. Non-binding

An opinion under these regulations shall not be binding for any purposes.

4. Exclusion of liability

The registrar nor any examiner or other officer of the Patent Office is to incur any liability by reason of or in connection with –

- (a) any opinion given under these regulations; or
- (b) any examination or investigation undertaken for the purpose of giving such an opinion.

5. Designs within scope of the opinions service

The registrar may issue an opinion on the matters set out in regulation 6 in relation to-

- (a) designs registered under the RDA 1949;
- (b) national unregistered design right;
- (c) registered Community designs;
- (d) unregistered Community designs.

6. Specified matters on which an opinion may be sought

(1) In relation to a design registered under the RDA 1949, a registered Community design or an unregistered Community design, an opinion may be sought on:

- (a) whether a particular act constitutes, or (if done) would constitute, an infringement of a design;
- (b) the validity of such a design.

- (2) In relation to the national unregistered design right an opinion may be sought on:
- (a) whether a particular act constitutes, or (if done) would constitute, an infringement of the design right;
 - (b) whether the design right subsists;
 - (c) duration of the design right.
- (3) An opinion may be sought in respect of a design registered under the RDA 1949 or the registered Community design if such design has expired or has been surrendered or cancelled by the registered owner.
- (4) The validity or subsistence of a design is not put in issue merely because its validity or subsistence is being considered in connection with an opinion under these Regulations or an appeal of such an opinion.

7. Request for an Opinion

- (1) A request must be made on [Form] and must be accompanied by a copy and statement setting out fully-
- (a) Details of the design;
 - (b) Name and address of the owner of the design;
 - (c) The question upon which an opinion is sought;
 - (d) The requester's submissions on that question;
 - (e) Any matters of fact which are requested to be taken into account;
 - (f) A fee of [£200]
- (2) The statement must be accompanied by-
- (a) The name and address of any persons, of whom the requester is aware, having an interest in that question; and
 - (b) Particulars of any proceedings of which the requester is aware which relate to the design in suit and which may be relevant to that question.

However, where the requester is acting as an agent in making the request, the persons referred to in paragraph 2(a) do not include the person for whom the requester is so acting.

- (3) The statement shall be accompanied by a copy of any evidence or other document (except a document which has been published by the registrar or is kept at the Patent Office) which is referred to in the statement.
- (4) Each such statement, evidence or other document must be provided in duplicate.

8. Confidential documents

The registrar must refuse any request relating to a document where a person files a document at the Patent Office or sends it to the registrar under these regulations and requests that the document be treated as a confidential document.

9. Refusal or withdrawal of request

(1) The registrar shall not issue an opinion if-

- (a) The request appears to the registrar to be frivolous or vexatious;
- (b) The question upon which the opinion is sought appears to the registrar to have been sufficiently considered in any relevant proceedings; or
- (c) For any reason the registrar considers it inappropriate in all the circumstances to do so.

(2) The registrar shall not issue an opinion if the requester gives him notice in writing that the request is withdrawn.

(3) If the registrar intends at any time-

- (a) To refuse the request because the condition in paragraph (1)(a) or (b) is satisfied; or
- (b) To refuse the request because, in accordance with section 28A(2)(b), the registrar considers it inappropriate in all the circumstances to issue an opinion, the registrar shall notify the requester accordingly.

(4) The registrar may remit the whole or part of the fee payable in respect of a request for an opinion where he has refused the request.

10. Notification and advertisement of request

(1) The registrar must notify each of the following persons of the request (except where the person concerned is the requester or where such persons have not been identified in the request)-

- (a) The owner of the design;
- (b) Any holder of a licence or sub-licence under the design in suit;
- (c) Any person who is specified under regulation 7(2)(a).

(2) In addition, the registrar may notify of the request any persons who appear to him to be likely to have an interest in the question upon which the opinion is sought.

(3) The registrar must send a copy of the form and statement filed under regulation 7(1) to each person so notified, together with a copy of such other documents filed under regulation 7 as the registrar thinks fit.

(4) The registrar must advertise a request in such manner as the registrar thinks fit.

- (5) However, if the request is refused or withdrawn before a notification has been made under paragraph (1)-
- (a) The owner of the design must be notified of the request (and of the fact that it has been refused or withdrawn); and
 - (b) Paragraphs (3) and (4) do not apply.

11. Submission of observations and observations in reply

- (1) If the request has not been refused or withdrawn, any person may, before the end of the relevant period, file observations on any issue raised by the request.
- (2) Such observations may include reasons why the registrar should refuse the request.
- (3) Any person who files observations under paragraph (1) must ensure that, before the end of the relevant period, a copy of those observations is received-
- (a) Where that person is not the owner of the design, by the owner; and
 - (b) By the requester.
- (4) A person to whom observations are sent under paragraph (3) may, during the period of fourteen days beginning immediately after the end of the relevant period, file observations confined strictly to matters in reply.
- (5) Any person who files observations under paragraph (4) must ensure that, within that period of two weeks, a copy of those observations is received-
- (a) Where that person is the requester, by the owner of the design; and
 - (b) Where that person is the owner of the design, by the requester.
- (6) If it is reasonably possible, the observations filed under this regulation and the copies of such observations shall be delivered only in electronic form or using electronic communications.
- (7) For the purposes of this regulation, the relevant period is four weeks beginning immediately after the date of advertisement under regulation 10(4).

12. Issue of the opinion

- (1) After the end of the procedure under regulation 11, the registrar must arrange for the preparation of the opinion.
- (2) The registrar must issue the opinion that has been prepared by sending a copy to-
- (a) The requester;
 - (b) The owner of the design; and
 - (c) Any other person who filed observations under regulation 11(1).

13. Appeal relating to an opinion

- (1) The owner of a design registered under the RDA 1949, a registered Community design or an unregistered Community design may, before the end of the period of three months beginning immediately after the date on which the opinion is issued, appeal against the opinion to the the appointed person .
- (2) However, such proceedings for an appeal may not be brought (or if brought may not be continued) if the issue raised by the appeal has been decided in other relevant proceedings.
- (3) The appeal must be made on Form [] and be accompanied by a copy and a statement in duplicate setting out the grounds on which the appeal is sought.
- (4) The statement must contain particulars of any relevant proceedings of which the appellant is aware which may be relevant to the question of whether the appeal may not be brought or continued.
- (5) The appeal may only be made on the ground that the opinion referred to under paragraph 1 wrongly concluded that the design in suit was invalid.

14. Appeal procedure

- (1) On receipt of the appeal, the registrar must send a copy of the form and statement filed under regulation 13 to-
 - (a) The appointed person
 - (b) The requester (if different from the applicant); and
 - (c) Any person who filed observations under regulation 11.
- (2) The registrar must advertise the application in such manner as the registrar thinks fit.
- (3) Before the end of the relevant period, any person may file a statement in support of the application or a counter-statement contesting it (which in either case must be in duplicate), and on so doing shall become a party of the appeal.
- (4) For the purposes of paragraph (3) the relevant period is-
 - (a) Four weeks beginning immediately after the date on which the application is advertised under paragraph (2); or
 - (b) If it expires later, the period of two months beginning immediately after the date on which the opinion is issued under regulation 12(2).
- (5) The registrar shall send to the other parties a copy of each statement or counter-statement filed under paragraph (3).
- (6) Rules 23 and 24 of the 2006 Rules apply to the appointed person and to proceedings before the appointed person as they apply to the registrar and to proceedings before the registrar.

15. Outcome of appeal

- (1) On completion of the proceedings under regulation 14 the appointed person shall either-
 - (a) set aside the opinion in whole or in part; or
 - (b) decide that no reason has been shown for the opinion to be set aside.
- (2) A decision under paragraph (1)(a) or (b) shall not estop any party to any proceedings from raising any issue regarding the validity of the design in suit.
- (3) No appeal shall lie from a decision under paragraph (1).

EXPLANATORY NOTE

(This note is not part of the Regulations)

These Regulations set out the detail and procedure for seeking an opinion from the registrar in relation to designs. Included within scope of the service are: UK registered designs (section 28A of the Registered Designs Act 1949); UK unregistered designs (section 249A of the Copyright, Designs and Patents Act 1988); and Community designs (governed under Council Regulation (EC) No 6/2002 of 12th December 2001).

A full impact assessment in respect of the effect that the introduction of the designs opinion service [will have on the costs of business and the public sector was completed in preparation for the Intellectual Property Bill (now the Intellectual Property Act 2014) and is available from the Intellectual Property Office, Concept House, Cardiff Road, Newport, South Wales, NP10 8QQ and is published with the Explanatory Memorandum alongside this instrument on www.legislation.gov.uk.]

Annex C: Draft Opinion request form



Intellectual
Property
Office

Patents Form 17/Designs Form xx

Patents Act 1977 (*Rule 93*)

Registered Designs Act 1949 (Regulation 7)

Request for opinion

(See the notes on the back of this form)

Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

1. Your reference

2. Number of patent/supplementary protection certificate/registered design on which an opinion is sought (see note c)

3. Your full name, address and postcode

4. Full name of the owner of each patent/supplementary protection certificate/design (see note d)

5. Are you requesting:

- an opinion in relation to a patent
- an opinion in relation to a supplementary protection certificate
- an opinion in relation to a design

6. Relevant information concerning related proceedings and interested parties (*see note (e)*)

7. Name of your agent (*if you have one*)

“Address for service” in the European Economic Area or Channel Islands to which all correspondence should be sent (including postcode)
(*see note (f)*)

Patents ADP number (*if you know it*)

8. Signature Date

9. Name, e-mail address, telephone, fax and / or mobile number, if any, of a contact point for the applicant

Warning

Any material that you submit with this Form will be made available to the public. A copy will also be sent to the owner of the patent/supplementary protection certificate/design (unless you are the owner) and to other interested parties. These will include anyone you mention in your request, any registered licensees, and others. You should be careful not to make any statement that constitutes an unjustified threat to sue for infringement.

Notes

- a) If you need help to fill in this form or you have any questions, please contact the Office on 0300 300 2000
- b) Write your answers in capital letters using black ink or you may type them. If there is not enough space for all the relevant details on any part of this form, please continue on a separate sheet of paper and write "see continuation sheet" in the relevant part(s) of the form. Any continuation sheets should be attached to this form.
- c) If the request relates to an unregistered design right then you should leave section 2 blank but you must set out clearly in the statement full particulars of the design right on which an opinion is sought
- d) Except in the case of unregistered designs, if you are the sole owner of the right to which this request relates, you should leave section 4 blank. If you are the sole owner of a national unregistered design or unregistered Community design, provide your name and address. In all cases, if you own the right jointly with others, you should identify your co-owners in section 4. If you are not the owner of the right to which this request relates, you should identify the owner or owners in section 4.
- e) You should use section 6 to identify any relevant proceedings which relate to the right - either under way or completed - of which you are aware. You should also disclose the name and address of any person, of whom you are aware, having an interest in the question upon which an opinion is sought. You do not need to name people with no more than a marginal interest in the issue. If the request concerns an opinion on infringement, you should if possible give the name and address of the alleged primary infringer (eg, the manufacturer or importer of the product/ in question). Having done so, it may not be necessary to identify alleged secondary infringers (such as retailers who are merely selling the product in question).
- f) Although you may have an address for service in the Channel Islands, any agent you appoint to act for you must reside or have a place of business in the European Economic Area or Isle of Man.
- g) You must file this form in duplicate.
- h) You must file two copies of a statement at the same time as you file the form. You must also provide two copies of any evidence or other document which is referred to in the statement. A translation into English should be provided of any document not in English or Welsh. The statement should set out fully the question on which an opinion is sought.
- i) Once you have filled in the form remember to sign and date it.
- j) For details of fees and ways to pay, please contact the Office.

Annex D: Draft form for requesting an appeal of a Design Opinion



Intellectual
Property
Office

Design Opinions Form DF 55 O Notice of appeal to the appointed person

No Fee

Use this form to appeal an opinion relating to a registered design to the appointed person if you are the owner of the design in question.

You must file this form **no later** than 3 months immediately after the date of the opinion.

1. Opinion number being appealed For the design being appealed.	
---------------------------------------------------------------------------	--

2. Full name Person filing this request.	
----------------------------------------------------	--

Address

The address must be in the United Kingdom, European Economic Area (EEA) or the Channel Islands.

	Postcode

3. Signature	
Name (BLOCK CAPITALS)	

Date	
-------------	--

4. Your reference Complete if you would like us to quote this in communications with you, otherwise leave blank.	
----------------------------------------------------------------------------------------------------------------------------	--

Contact details Name, daytime telephone number of the person to contact in case of query.	
-----------------------------------------------------------------------------------------------------	--

5. Reasons for appeal and relevant information concerning proceedings must be contained in a separate statement
(See note f)

Checklist

Please make sure you have remembered to:

- Provide the design opinion number
Sign the form
- Attach your statement of reasons for your appeal

Where to send

Intellectual Property Office
Litigation Section
Room 1R31
Concept House
Cardiff Road Newport
South Wales
NP10 8QQ

Jan 2015

DF 550

Warning

Any material that you submit with this Form will be made available to the public. A copy will also be sent to the person who made the request for an opinion (unless you made the original request) and to anyone who filed observations in response to the original request for an opinion.

Notes

- a) If you need help to fill in this form or you have any questions, please contact the Office on 0300 300 2000
- b) To file an appeal you must be the owner of the design. If you are not, the opinion may be reconsidered by other methods by submitting requests to the Intellectual Property Office, e.g. applying to invalidate the registered design.
- c) Write your answers in capital letters using black ink or you may type them.
- d) If there is not enough space for all the relevant details on any part of this form, please continue on a separate sheet of paper and write "see continuation sheet" in the relevant part(s) of the form. Any continuation sheets should be attached to this form.
 - a. When you submit this form, you should attach to it a written statement setting out the grounds on which you are seeking to appeal against the opinion. The only ground for appeal is that the opinion wrongly concluded that the design in suit was invalid.
- e) This should also identify any relevant proceedings which relate to the design (that you are aware of), whether in the courts or at the Intellectual Property Office, or at the Office for Harmonisation in the Internal Market (OHIM, the European trade mark and design Office) - either under way or concluded.
- f) You must file this form in duplicate.
- g) You must file two copies of a statement at the same time as you file the form. You must also provide two copies of any evidence or other document which is referred to in the statement. A translation into English should be provided of any document not in English or Welsh.
- h) Once you have filled in the form remember to sign and date it.

Intellectual Property Office
Concept House
Cardiff Road
Newport
NP10 8QQ

Tel: 0300 300 2000

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