

Response ID ANON-6TNE-VM6X-E

Submitted to Reviewing the designs framework: Call for views
Submitted on 2022-03-23 11:09:52

Introduction

1 What is your name?

Name:

[REDACTED]

2 What is your organisation?

Organisation:

Gill Jennings & Every LLP

3 What is your email address?

Email:

[REDACTED]

4 The Intellectual Property Office may wish to contact you to discuss your response. Would you be happy to be contacted to discuss your response?

Yes

Respondent information

5 If you are an individual, are you?

A legal professional

If you have selected other please specify:

6 If you are responding on behalf of an organisation, are you?

Any other type of organisation

If you selected other please specify:

Intellectual Property Law Firm

7 In which main industry do you or your business operate?

Other

If you selected other please specify:

Intellectual property law representing applicants across all sectors.

8 How many people does your business employ?

50-249

Registered designs - search and examination

9 Do you have views on whether the IPO should change examination practice for designs?

Please add your views here:

We do not want to see any major change to the IPO's examination practice for designs. Overall, it will be good for rights holders for the process to remain to remain closely harmonised with the EU process and we believe that the simplicity of the designs examination process is justified by the nature of the right.

A significant benefit of the UK design system is that it is low cost for applicants and there is a rapid registration process. Shifting to a substantive examination system would inevitably increase costs and slow registration, which, in turn, would be a disincentive to filing. The scope of protection granted by a design is more limited than patents for example, so it seems fair to applicants to have corresponding more limited registration process.

A point of significant note is that, from outside the UK, the UK market is now considered a supplementary filing location relative to the larger EU market. In view of the EU system operating without substantive examination, the UK system changing to a system with more hurdles would disincentivise foreign

applicants from filing in the UK.

A two-tier system, such as one similar to the IP Australia system, is likely to make enforcement more difficult when rapid action is required to limit damage to future business. Should an injunction be needed urgently to stop an infringer acting before they can take over the market, a two-tier system would make such rapid action impossible. This is because, if a two-tier system existed, there would be a need to go through the substantive stage before an injunction could be successfully gained. By virtue of fast action being needed, the substantive stage could not have been conducted earlier, so by the time that stage is completed the damage to future prospects for a business would already have occurred.

However, we believe that it may be beneficial to have the option to request that a design is examined for novelty and individual character. This could perhaps be achieved by extending the IPO's opinion service to include an option for designs validity.

A pre-application tool to assist applicants in identifying relevant registered designs before filing could be of use as long as there was not requirement to identify designs considered similar in order to proceed with filing. This would help reduce clearly invalid filings.

A bad faith provision would likely not be worthwhile introducing as a way for the IPO to object to registrations. We expect that the rate at which this would be used by the IPO would be so low that it would not be worth implementing. It may be better to make it easier and faster for third parties to attack registrations that have been made in bad faith.

An opposition period would be worse than the current invalidity process in our view. An opposition period puts the onus on legitimate rights owners to watch all applications/registrations and to act within a limited window. An opposition period would therefore raise costs for legitimate rights holders and likely increase the perception or assumption of legitimacy of a registration that was not opposed.

Aside from the points mentioned in the call for views, we believe that, procedurally, the examination process could do with an overhaul as it currently feels messy and ad-hoc. For instance, there are no clear rules on getting extensions for due dates or what happens if a date were missed.

10 Do you think it would be useful to introduce any of the options outlined? (please select all that apply)

Other

Please provide more detail below:

An option to have design examined for novelty and individual character.

Simplifying the designs system

11 What form of designs protection works best for you at present?

Please add your views here:

In practice, we find our clients benefit the most from registered designs and supplementary unregistered design/continuing unregistered design.

12 Do the different and overlapping ways of protecting the appearance of a product present any issues to creators and users of the system? If you think the system could be simplified, we would like your views on how to do this.

Please add your views here:

Overall, we believe that the current system for unregistered designs is confusing and simplification would be beneficial for rights holders.

In particular, unregistered design rights and supplementary unregistered designs differ in a number of different ways that make them confusing for rights holders. The type of designs they can protect differs, with UDR protecting shape and configuration only, while SUD offers protection for 2D aspects of appearance. They also differ in the criteria for validity, with UDR requiring a design to be original/not commonplace whereas SUD require novelty and individual character. They differ in requirements for generating the right, with UDR having a residency requirement whereas SUD has only a disclosure requirement. And they differ in the length of their protection, with SUD providing three years of protection and UDR confusingly lasting for between 10 and 15 years.

In our view, the UDR regime is out of date and SUD should be no more than a temporary fix to replace the extra unregistered rights that businesses had through the European Community system. Our recommendation would be to replace both of these rights with a single right that is modelled on the unregistered European Community design system. This new design system should keep the disclosure requirement, and the novelty and individual character requirement of the SUD. The term could possibly be extended beyond three years, and it would also be possible to provide different terms for shape only protection as for designs incorporating 2D elements if there were a desire to somewhat replicate the differences that exist in this regard between the UDR and SUD systems.

13 Are there terms in the Registered Designs Act which would benefit from clarification or guidance e.g. "get up"?

Please add your views here:

There are many inconsistencies between the UDR and SUD systems, which is why we believe that they should both be replaced by a new system that is modelled on the unregistered European Community design system.

14 Please share any issues you or your clients have experienced in relation to the changes to disclosure requirements for unregistered designs since the end of the transition period (31 December 2020).

Please add your views here:

We have no direct experience of this; however, the current non-reciprocal arrangement is to the detriment of UK businesses as a UK-first disclosure leads to lesser geographical scope of protection than an EU-first disclosure.

15 Would any of the options outlined, such as simultaneous disclosure, address this issue? Are there any other ways of addressing the lack of reciprocal recognition for unregistered designs in the UK and EU? If so, please provide details on how they may work in practice.

Please add your views here:

In our view, it would be to the benefit of UK rights holders to allow UK UDR to be generated for all disclosures in the EU and UK, since it would give them an easier route to getting both EU and UK UDR.

If this is not viable, then a framework setting out how to achieve suitable simultaneous disclosure, as would be recognized under UK law, would be of value.

Future technologies

16 How can the current system better meet the needs of a digital environment and future technologies?

Please add your views here:

We believe that registered designs should fundamentally remain a right that is determined by a series of images in order to match other systems around the world. Until and unless other countries accept animated representations, then for harmonisation, we believe that the current use of representations should remain.

Nonetheless, there may be ways to improve how conventional design representations may be used in some of the circumstances outlined. Improved clarity on how to register animations and changing digital interfaces would be useful. It would be particularly useful to be able to distinguish between an animation comprising a series of images in a predetermined order, compared with a digital display that may exhibit any one of a number of images in an order that depends on other factors, e.g. user input.

17 Are areas such as digital designs and 4D printed products adequately protected by the current system?

Please add your views here:

We believe that the current system already adequately protects products that change shape or configuration. However, as indicated previously, it may be beneficial to be able to distinguish between a series of configurations that occur in a predetermined order vs. configurations that may occur in different orders.

18 Do you think it would be useful to introduce any of the options outlined? These include extending supplementary unregistered design to cover computer generated designs, filing of digital representations and ceasing accepting physical specimens.

Please add your views here:

We see no reason that computer-generated designs should not be protected for SUD in the same way as other rights.

19 What are your views on the protection of computer-generated designs?

Please add your views here:

We have no other views on the protection of computer-generated designs.

Better regulation

20 Should UK law have an express deferment provision and how long should it be?

Please add your views here:

Yes. The period should be at least 18 months, to align with the with the publication period for patents. Currently, a patent and design filed for the same product will inevitably lead to publication of the design 6 months before publication of the patent. This can make decisions around the end of the priority year for a patent awkward where there may be an imminent design publication to contend with. This would be resolved by allowing publication to be deferred up to 18 months.

However, much more preferably, the period should be 30 months to match the period for European Community designs.

21 What information, if any, should be published in relation to a deferred design?

Please add your views here:

Applicant name, application number, and title/indication of product. This would allow third parties to consider their position without giving access to the appearance of the design, thereby continuing to protect the reason for deferring the design.

22 Is there a need for specific provisions for prior use or to deal with co-pending applications?

Please add your views here:

The law should also be made clear as to what would happen in the unlikely event that two registrations were filed for the same design by different parties. Analogously to patents, we presume that the second-filed design, if the same as the first-filed design, would lack novelty and so be invalid, but if they differ and yet have the same overall impression, may co-exist.

Enforcement

23 What are your views on the effectiveness of the UK's enforcement framework?

Please add your views here:

We believe that the system is currently too expensive. Design rights are often seen as inexpensive and relied on by small businesses.

24 How could it be improved to help small businesses and individual designers enforce their rights?

Please add your views here:

A designs infringement (and possibly validity) opinion service, similar to that for patents, may be of use here.

25 What has been your experience of the introduction of criminal sanctions for registered designs?

Please add your views here:

We have no experience on this issue.

26 What are your thoughts on extending criminal sanctions to unregistered designs and what economic evidence do you have to support your view?

Please add your views here:

We have no thoughts on this issue.