

Response ID ANON-6TNE-VM6J-Z

Submitted to Reviewing the designs framework: Call for views
Submitted on 2022-03-25 18:39:01

Introduction

1 What is your name?

Name:

[REDACTED]

2 What is your organisation?

Organisation:
Burberry Ltd

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?

Not Answered

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:
Luxury Retail business

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

Other

If you selected other please specify:
Luxury fashion retail

8 How many people does your business employ?

250+

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 are not in favour of a more robust examination process that would raise potential novelty and/or individual character concerns, whether conducted by examiners or AI. This would likely add to the cost and delay of securing registered design rights in the UK and would seemingly be out of sync with the EU and many other jurisdictions' design regimes. The two-tier examination system would seem to potentially lead to delay at the critical point when speed may be of the essence, namely in taking immediate action against a potential infringement of your design, so we would also not be in favour of this proposal.

While introduction of an opposition period would seem like a sensible move, the practical reality is that setting up an effective "watching" service to obtain notification of potentially conflicting designs would likely be very difficult, given the current limitation involved in searching the design register.

We are not aware of any real issue at the IPO relating to anti-competitive design applications, but we would be in favour of the introduction of bad faith

provisions to provide an additional ground of invalidation (and/or opposition).

A pre-application AI tool or non-binding opinion on validity and/or infringement could be a very useful option, particularly in creating better access to the system for those without professional legal representation. Certainly having more comprehensive and flexible searchability of registered designs would be helpful.

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

Bad faith and opposition periods

Please provide more detail below:

see answer at 9 above.

Simplifying the designs system

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

Please add your views here:

As a luxury fashion brand that creates and discloses hundreds of new designs seasonally and well in advance of the products being available on the market, the unregistered design regime is most beneficial. While the official fees for registered designs are not prohibitive, the practicalities and cost of obtaining representations of all aspects of a design (eg via CAD, line drawings etc) can be significant. There is also a reasonable amount of flexibility in relying on unregistered design rights, particularly given the strict interpretation of the parameters of a design based on the filed representations in cases such as Trunki.

While we do use the registered design system to protect longer life products such as fragrance bottle and packaging designs, surface patterns/logos, and the like, often we don't know whether a particular fashion design will have longevity within the year grace period.

So given the sheer quantity of new designs created by our business, and the relatively short fashion lifecycle, we largely rely on the unregistered design regime for protection.

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:

It is confusing to the non-specialist users of the system which, in the fashion industry would (or could) be substantial if it was more user friendly. The SUD right seems the more flexible of the co-existing UK unregistered design options, but suffers by comparison in terms of the period of protection. Potentially it would be sensible to dispense with the UK Unregistered Design right, while extending the term of an SUD to at least 5 years, to simplify the system.

With respect to the potential overlap of copyright and design rights, given the uncertainty introduced following the decisions in Cofemel, Brompton, and Response Clothing perhaps it is necessary to clarify the position through legislation so that businesses have certainty, both in terms of protection and in freedom of design.

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:

We have not had to rely on the "get up" provisions but clarity or guidance would be welcomed by users.

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:

The lack of certainty on whether simultaneous disclosure through, for example, live streaming would satisfy requirements in the UK and EU jurisdictions is a risk. While this hasn't yet compelled our business to alter the location of significant disclosure activities such as runway shows, the potential loss of unregistered rights in one jurisdiction or the other is an important risk consideration. We would urge the government to further explore and work towards reciprocal recognition of unregistered designs so that users of these systems have legal certainty.

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:

Future technologies

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

Please add your views here:

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

Please add your views here:

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 would encourage the acceptance of digital representations where appropriate. We would not object to the ceasing of acceptance of physical specimens.

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

Please add your views here:

Better regulation

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

Please add your views here:

We rarely rely on deferment in designs, as will often launch a product before determining whether it warrants registered protection, however we would consider 12 months sufficient for our requirements.

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

Please add your views here:

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

Please add your views here:

Enforcement

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

Please add your views here:

The legislative framework is robust and comprehensive. However, the ability to enforce rights effectively (for both large and small businesses) can be hampered by resourcing of the relevant bodies such as Customs, Trading Standards and Police. In addition, the prohibitive cost of legal representation can make access to civil procedures to enforce against infringement of rights almost impossible for new and small businesses.

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

Please add your views here:

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

Please add your views here:

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:

While the introduction of criminal sanctions against copying of unregistered designs is theoretically welcome, we agree that the practical application of such provisions would introduce an unrealistic burden on the relevant authorities so we would not be in favour of this.