

Response ID ANON-6TNE-VM66-C

Submitted to Reviewing the designs framework: Call for views
Submitted on 2022-03-25 16:38:36

Introduction

1 What is your name?

Name:

[REDACTED]

2 What is your organisation?

Organisation:

[REDACTED]

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?

Other

If you have selected other please specify:

NGO

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

Any other type of organisation

If you selected other please specify:

[REDACTED]

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

Other

If you selected other please specify:

NGO

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:

It seems worth considering a discussion on the introduction of substantive examination of design applications, as a way of improving the quality of the granted rights.

Novelty examination for example could be a good change, which is in line with many design registration systems.

Regarding the searching, however, if the IPO can find only exact matches, the search is not very useful for the applicants, very seldom identical designs are created at the same time independently without clear copying purpose.

The main problem that remains is the individual character and if designs close to one`s own exist already. A novelty search however cannot answer this

question.

Consequently, the search made by IPO would mean only extra costs and delayed registration. Furthermore, the search would be limited because there can exist relevant unregistered designs which cannot be found even the search would be very covering.

However, if more useful means of searching could be developed in future, such as by using AI, this may make searching more practical.

Therefore, it could be considered to provide for substantive examination in the law, but not to activate this provision at the current time.

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

Use of AI tools, Bad faith and opposition periods

Please provide more detail below:

A key objective of [REDACTED] is to facilitate the exercise of rights by designers and the simplification of procedures. Therefore, as long as no substantive examination is provided for in design law, it seems desirable that application-based, low-cost procedures for cancellation of registered designs be introduced. This either before the IPO itself or before the national industrial property offices of all member states. For example, in the absence of pre-registration searching, an opposition procedure would be a good option. As long as all someone has only to take in consideration formal aspects to obtain a design right, invalidation of a registered design before the industrial property office is of the utmost importance. Furthermore, it would be good, if the IPO could provide AI-tools for search purposes for the applicants without charges so the applicants could make checkings voluntarily by themselves before filing (see our comments on searching above).

Simplifying the designs system

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

Please add your views here:

A good option might be simplifying the UK design system by harmonizing the pre- and post-Brexit forms of protection to

- a) registered design rights and
- b) unregistered design rights.

Having supplementary and continuing unregistered design rights, in addition to UK unregistered design rights, makes things complicated for applicants.

Perhaps the supplementary and continuing unregistered design rights could be phased out over time.

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:

No comment.

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:

No comment.

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:

No comment.

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:

[REDACTED] passed a resolution in April 2008 calling for a grace period for Unregistered Community Designs as a way of solving the disclosure problem, because of a frequent need for the first disclosure of designs, even by European design owners, to be outside the geographical area of the European Union [REDACTED]
[REDACTED]

A similar approach could work for the system of supplementary unregistered designs in the UK.

Future technologies

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

Please add your views here:

Revamping legislation, regulation and IPO practice to ensure adequate protection for future design technologies.

For example, [REDACTED] passed a resolution in April 2019 calling for clear protection and enforceability for Virtual Designs

[REDACTED]

The law should provide clear basis for the registration of designs reflecting the current technological system, whilst allowing for changes in the technological environment.

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

Please add your views here:

See our comment for question 16.

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:

See our comment for question 16.

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

Please add your views here:

See our comment for question 16.

Better regulation

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

Please add your views here:

The current 12-month deferral provides sufficient flexibility and certainty for applicants.

However, there is also no objection to a deferral of 18 or 30 months.

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

Please add your views here:

No comment.

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

Please add your views here:

No comment.

Enforcement

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

Please add your views here:

No comment.

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

Please add your views here:

No comment.

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

Please add your views here:

Quite often the criminal sanctions are impractical, since law enforcement has much bigger issues than IP enforcement.

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:

No comment.