

Response ID ANON-6TNE-VMCT-Q

Submitted to Reviewing the designs framework: Call for views
Submitted on 2022-03-17 16:00:28

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?

An academic

If you have selected other please specify:

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

An academic institution

If you selected other please specify:

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

Other

If you selected other please specify:

IP law and research institute

8 How many people does your business employ?

2-9

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:

1) Novelty search - The novelty search was formally abandoned some years earlier and, even before that, had not been systematically performed. So the changes proposed are more significant than just reversing the 2006 amendments. Having said there, if there is a possibility of a pre-application AI tool to perform elementary searches, this may be good for ensuring that the public domain is not unnecessarily captured by the unsuspecting or by IP trolls.

2) One should note, however, that rapid grant and enforceability are important in certain sectors where products have short shelf lives for example fashion and toys. The Korean IPO has selectively dropped search and novelty examination in these specific sectors. Thus, there should be some consideration of whether we need some exemptions allowing a sector- or class-specific application of search and examination.

2) The search should be limited to novelty/prior art; it may not be technologically feasible to carry on the individual character search which carries a certain amount of subjectivity (eg overall impressions; informed user who can come from two different groups - Pepsico decision)

3) Pre-grant opposition – we do not see any benefit in this, since we have post-grant IPO revocation. The inherent delays in an opposition system would render some designs unenforceable.

4) Post-grant search – This could be a valuable option and could be rolled into the existing search on DF21.

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

Prior art searching, Two-tier system, Use of AI tools

Please provide more detail below:

See answers to Question 9 above.

Simplifying the designs system

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

Please add your views here:

NA

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:

General comment: Designs sit at a crossroad of IPRs. Some are incorporated as purely utilitarian features within a product whilst other types of designs evolve into classic designs albeit within a functional area (e.g. classic car or furniture designs). The piece meal approach to design protection - treating it as an issue under design law alone, for example, rather than an all-IPR issue has led to much uncertainty in the market and to users. And there has been a continuous lack of cohesion or uniformity in the legal treatment of designs by courts since the 1911 CA and the 1839 Copyright of Designs Act (which is the precursor of the modern registered system): see *King Features v Kleeman*, *Dorling v Honnor*, *British Leyland v Armstrong*, *Amp v Utilux* etc. - Also see IPO commissioned report 2012: *The Development of Design Law Past and Future (2012/15)* - "Research shows that the design community considers the law expensive and unpredictable."

1. Unregistered design rights: Unless we wish to resile from the Trade and Cooperation Agreement, we are obliged to provide the UCD and some level of cumulative copyright protection, so the only candidate for the axe would be UK Unregistered Design Right. Getting rid of this would remove protection for investment in purely functional designs especially in the automotive engineering sector.

2. First Disclosure/publication: The TCA commits us to a form of SUD that is based on publication for both creation of the right and its duration, but leaves some flexibility. The UK UDR system uses residence as one form of qualification, but also uses first marketing, and the latter is further employed to calculate duration of UK UDR. So use of first marketing (in the UK or another qualifying country) as the sole criterion for all rights might be possible. Alternatively, first marketing (as the sole UK UDR criterion) and first disclosure that would come to the attention of the circles etc etc (as the sole SUD criterion) would fulfil the same purpose.

(. Simultaneous disclosure:: Consider how the Berne Convention overcomes this issue with its "simultaneous publication rule" whereby protection is accorded if the work is simultaneously published in two countries within a certain time period (ie 30 days), if the nationality /habitation rule does not kick in.

3. Our view is that the defences and permitted acts should be harmonised across all design rights (and to the extent possible, across all IP rights). The IP Act 2014 made progress by harmonising some UK UDR defences with those available under registered design law and SUD. Since some degree of copyright protection seems likely, I would recommend also harmonising defences with those for copyright in artistic works.

4. Copyright protection: the current state of protection under copyright law is abysmal as the "works of artistic craftsmanship" is unworkable - see *Hensher v Restawhile*, and *Lucasfilm v Ainsworth*. If the courts apply the criterion of original work as set out by the CJEU decisions (and currently part of retained law under the Withdrawal Act), purely functional designs would not be protected - and this would remove the unwarranted fear of competition being stifled by extending copyright protection. Moreover, there are certain iconic British designs which do deserve copyright protection. The reciprocity rule under s.2(7) Berne Convention certainly opens the possibility of British designs failing to gain copyright protection in the EU if copyright is continuously disallowed to important classic British designs here in the UK; whereas EU designs do and will gain copyright protection. This area should have a more in depth consultation.

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:

1. Definition of design: The term "get-up" is all encompassing and at times this is confusing as it also overlaps with environmental designs (including landscapes, street design, and shop interiors). Further confusion arises when one considers the categorisations employed under the International Classification for Industrial Designs under the Locarno Agreement.

2. Thus it is dependent on the UK Government policy as to whether it wishes to embrace the concept of design in a holistic and inclusive manner (eg design "includes"..) or revert to a category-dictated schema (eg. designs "mean" pattern, configuration, shape...). Our view is that the former is flexible and takes into account future types of designs; however the latter will take in ornamentation and shape, and will automatically include the term "get-up". This will really depend on how resilient and encompassing a design system the UK wishes to build.

3. Proviso: From EU design jurisprudence across various countries, there is a good deal of confusion as to whether the term "appearance" is limited to visual aspects, or whether the concept of the design goes further to embrace tactile and other aspects, which constitute the economic value of the design.

If there is a push to expand the definition, then a holistic analysis of the purpose of design law has to be done; with the expansion of shapes under trade mark law, there has been considerable jurisprudence as to the demarcation between design and trade mark laws (as well as copyright law); thus, if the current definition is re-defined and broadened, we should expect to see a confusion as to protectable subject matter across the various IP laws.

See EU Legal Review on industrial design protection in Europe - 2016.

<https://op.europa.eu/en/publication-detail/-/publication/43fd4a5c-6c26-4639-ac9a-281ab57687de>

4. Alternative: the law could provide for a more systematic (non-exhaustive) categorisation of design types. This could be achieved by drawing a clearer distinction between the three principle design categories, that is graphical design (which may include inter alia logos, graphical user interfaces, surface patterns and typographic typefaces), design related to physical objects (which may include inter alia packaging and sets of articles), and get-up (which may include inter alia interior design).

This may be a good idea for non-expert lawyers as well as industry. The usual categories taught by design schools could also be considered - product, graphic and environmental designs. If one considers how long the list of elements which can constitute trade marks are in legislation, there may be more scope to expatiate on what "design" covers.

5. Must-match: There is a case for replacing the clunky test of "must-match" within the UK UDR for a clearer right of repair. This would be in line with the UK Government's right to repair regulations for a more ecodesign-sensitive legislative framework. It would also clarify and liberalise the position within the UK; and a similar test should also be considered for other overlapping rights (ie copyright, and also trade mark where shapes are protected). If it were felt too punitive to OEMs, the existing licence-of-right provisions could be re-visited with a licence of right available immediately for repair uses.

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:

Disclosure of supplementary unregistered designs: We believe that a worldwide disclosure is sufficient to create UCD namely that a same-day (not necessarily simultaneous) disclosure is sufficient to create a valid UCD and therefore also SUD.

From the point of view of British designers, solving the UCD problem in the EU may be more important than solving the SUD problem, as British designers have other options (e.g. UK UDR and copyright) for protection in the UK but less so in the EU. Whilst some EU countries provide alternatives to SUD (e.g. copyright and unfair competition) these tend to be more precarious.

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:

See answers above.

Future technologies

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

Please add your views here:

1. Should filing CAD or other e-representations of 3D shapes be possible? Yes this should be a feasible way forward if the 3D rendition is accurate enough with the sufficient details as required. In which case, physical specimens could be abandoned.

2. Should design protection (of all kinds) extend to "virtual designs" – e.g. would reproduction of the shape of a car in a video game infringe? This depends, again, on the policy decision underpinning the future design law in UK - embracing an inclusive and holistic definition of design, or a category-dictated definition. In this age of video games, interactive health systems, and AR/VR/metaverse environments, it does not seem progressive to exclude virtual designs at all. At this stage, however, the overlap with copyright law will increase - and it must be a consideration to consider the exclusions be harmonised under both laws - e.g. spare parts, incidental inclusion, functional subject matter.

3. How should AI authorship be handled? This should be harmonised with the approach adopted under patent and copyright law (re consultation on AI). The same definition of "author" should be employed to protect computer generated designs as for UK UDR, UK RD and copyright should be introduced for SUD.

4. One issue is to what extent consumers will claim the right to use 3D machines, and claim private, noncommercial use defences. The difficulty is not clearly evident from either case law or anecdotal stories; the only issue that will arise – and there have been some stories on this aspect in the press during the Covid19 responses by schools and the general public in relation to the lack of respiratory equipment, and other medical devices. As stated in the Legal Review 2016, one recommendation would be to review the possibility of restricting the scope of the "private and non-commercial" use limitation by adopting provisos such as limiting 3D printing to "acts which do not unduly prejudice the normal exploitation of the design", or something aligned to the 3 step test under the TRIPs Agreement.

5. A secondary issue is the liability of intermediaries which affects the extent to which the rights can be enforced. It may be impractical to enforce rights against the primary infringer ie end-user; thus, another possibility would be to pursue the intermediaries involved in facilitating the download and eventual reproduction by the end-user – thus, this may be an area for study especially in comparing solutions under patent and copyright laws (e.g. levies, compensation schemes, the caselaw under Art. 27(1) CPC from which the design provision is derived...)

6. Another point is whether all limitations should be generally subject to wording that they are "compatible with fair trade and commercial practice and

do not unduly prejudice the lawful interests of the rightholder” – again aligned with the TRIPS Agreement (and this is available under other Member States such as Lithuania, Denmark)

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

Please add your views here:

See above Q 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 Q.16.

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

Please add your views here:

See Q16.

Better regulation

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

Please add your views here:

Deferment: In our view, a deferment period of a little more than 6 months (the Paris Convention priority period) is a practical feature which allows some protection against loss of priority abroad. There should not be a longer period than the present 12 months, but there would perhaps be some slight advantage in aligning with the 30 month Hague Agreement period.

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

Please add your views here:

NA

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

Please add your views here:

NA

Enforcement

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

Please add your views here:

Enforcement: We believe that all forms of design enforcement are suitable for the IPEC Small Claims track. This has proved a useful mechanism for small parties. We also favour the introduction of the long-delayed Designs Opinion Service which would offer a form of expert determination without the costs of litigation.

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:

There is no evidence of the Magistrates' court/CPS being widely used.

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:

NA