

Reviewing the UK designs framework: Call for views

Our comments regarding Question 9. Do you have views on whether the IPO should change examination practice for designs?

Currently, the United Kingdom Intellectual Property Office (“IPO”) is following the European Union Intellectual Property Office’s design examination process. We respectfully propose that the United Kingdom change this and follow a more robust prior art search and examination process prior to granting an enforceable right, in line with countries such as the United States and Australia.

Without examination for novelty and individual character, almost any design can be registered. This lack of substantive examination, and the low quality that results, creates uncertainty about the validity of registrations for innovators and businesses and can harm consumers. In particular, businesses may forego the introduction of new products out of concern for design registrations that are in fact invalid.

This uncertainty also applies to an innovator’s own design registrations. If companies are left to ascertain the validity of registrations as applied to their independently developed products, they may question their own design rights knowing that registrations have no substantive standard for validity prior to grant. Examination for novelty and individual character prior to registration can help increase public confidence in the validity and scope of registered designs.

Our comments regarding Question 10. (Do you think it would be useful to introduce any of the options outlined?) (Prior art search)

We believe that the IPO should introduce prior art searching. The design registration system should provide consistent quality and certainty with respect to the exclusive right granted by a registered design. A timely search by an Examiner to identify prior art for a design has the best opportunity for avoiding registration of designs that lack novelty and individual character. Listing the closest prior art considered by the Examiner provides the public with a relevant reference for evaluating the individual character of the registered design. A prior art search with an examination reduces the public’s uncertainty about the scope and validity of the exclusive right granted.

Our comments regarding Question 10. (Do you think it would be useful to introduce any of the options outlined?) (Two-tier system)

We strongly believe that the IPO should engage in substantive examination of all designs that are submitted for registration. However, if resource constraints limit the IPO’s ability to fully examine every application for registration, then a two-tier system should be put into place. An unexamined registration creates uncertainty and places a burden on the public, because the public must determine the validity and scope of the unexamined registration as noted above. However, if the office is unable to provide examination of all applications, examination as a

prerequisite to enforcement provides the public with some protection by reducing the number of invalid registrations being asserted.