

## Response ID ANON-6TNE-VM6S-9

Submitted to Reviewing the designs framework: Call for views  
Submitted on 2022-03-25 18:24:13

### Introduction

1 What is your name?

Name:

[REDACTED]

2 What is your organisation?

Organisation:

The Chartered Institute of Patent Attorneys (CIPA)

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:

Not responding as an Individual

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

Any other type of organisation

If you selected other please specify:

Professional Body representing Patent Attorneys

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

Other

If you selected other please specify:

Clients of our members operate in all of the above areas.

8 How many people does your business employ?

10-49

### 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 think it would be beneficial for the UKIPO sign up to DAS for designs - both as an office first filing (OFF) and as an office of second filing (OSF). This will significantly increase the number of users using the UKIPO as an OFF (whereas we often currently use the EUIPO as OFF, since they are participating in DAS).

We think it would be beneficial for the UKIPO to add an online file wrapper (prosecution history) for UK design cases. Currently it is very difficult to see what changes have been made (if any) during the prosecution of a UK registered design application. So if the views change during prosecution, it is very difficult to see that from the UK design register. Equally, if other actions happen (e.g. restoration) on the UK design registration, it is very difficult to see the history of these actions, noting the online file wrapper is currently only sparsely populated with updates occurring on the design registration.

We think it would be beneficial for the UKIPO to increase the maximum description length for designs submitted on the online e-filing software. We appreciate it is truncated for a number of practical reasons, but having such a short description can make things difficult later on, when it comes to using

the UK registered design application as a priority document in, say, the USA, where a much longer description may be typically used. We think it would be beneficial for the UKIPO to increase the size of the images displayed in each .PDF design filing receipt (noting these images are currently very small). The small nature of these drawings means clients of our members query why we have submitted such poor quality drawings (when that is not the case - it is just due to compression by the UKIPO to make them fit on the filing receipt). It also makes it difficult to double check a draft design application which is prepared by someone else as a draft design .PDF, to check whether the right drawings have been uploaded as part of the design checking process. Indeed, the EUIPO .PDF design filing receipt provides a much clearer/higher-quality set of drawings as part of the .PDF filing receipt for an EU registered design application, which makes it much easier to review the submitted views. We think it would be beneficial for the UKIPO to increase the duration a draft UK design application is kept saved for (7 days is too short in the opinion of our members). Currently a draft UK design application can be saved for up to 7 days before it must be re-saved to stay alive. This 7 day period is often far too short, noting if a draft design is sent to a client for review, they may often take more than 7 days to look at/approve it, meaning re-saving the draft every 6 days. A much better system would be like the EUIPO and WIPO allow you to do, which is to have a profile you can set up which allows you to prepare/save draft design applications for an indefinite period, and which can all easily be retrieved later on, as needed. We think it would be beneficial for the UKIPO to provide clarification on what types of GUI/animated designs are allowable, as there is far too little guidance in the Examination Guidelines, and too much variation as to what is, and what is not, allowable between cases. Indeed, the only real guidance is that from 11.35 of the Registered Designs Examination Practice guide, which is far too brief. What our members therefore find happens, as a result, is that UK Examiners treat this guidance far too inconsistently - some allowing animated designs to require human interaction, whilst others not, for instance. Our members also think that the law should be changed to allow divisional applications to be filed for Hague designations. We also think that certified copies of the application as e-filed should be provided by email, in the same way that they are for trade mark e-filings. We think that Registration Certificates should be provided electronically by email as they are for trade mark registrations - this should provide all the correct dates in terms of filing/ publication etc.

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, Bad faith and opposition periods, Other

Please provide more detail below:

General comment 1: whilst it is true that novelty examination was abandoned in 2006, 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. General comment 2: Our members believe that rapid grant and enforceability are important to certain design sectors, namely fashion and toys. The Korean IPO has selectively dropped search and novelty examination in these specific sectors. One option therefore might be worthwhile to ensure that any legislation allowed a sector- or class-specific application of search and examination. Pre-grant novelty search - On balance our members are generally against manual searches and examination before grant. Experience of our members is that this involved a lot of searches for not much result, and some delay but very few refusals. These problems could be mitigated in two ways: (a) Search but do not examine - make the search advisory only as EUIPO does for trade marks (and the French used to do for patents); (b) Use AI only to do the searches. Whether the results would justify the expense is still doubtful. The UKIPO already has a prior art searching service, using the DF21 for £24. But whilst this search is helpful, the search results give little guidance as to what has been practically searched by the UKIPO in these instances, which can mean the value of the search is unknown. In any case though, £24 is very cheap - which is good! Perhaps too cheap if this means the quality of the search is rushed? Pre-grant opposition - Our members don't see any benefit in this, since we have post-grant IPO revocation already. The inherent delays in an opposition system would render some designs unenforceable. Post-grant search - Our members have had experience of the Australian system and it proved useful and could be a valuable option. Similarly, the Chinese system is considered a useful and valuable option to at least some of our members. This could be added to the existing search on DF21. Thought should be given to the enforceability issue. Some of members would favour ensuring that the searches are carried out so quickly as to not substantially delay any litigation (in the event that as per the Chinese and Australian systems, a search must be carried out before litigation), e.g. within a matter of weeks, or allowing litigation to be started prior to the post-grant search, but giving the defendant time enough to see the results before filing their defence. Others would instead prefer that the IPO ensures that their examination was rapid enough to not significantly delay litigation, e.g. a matter of weeks.

## Simplifying the designs system

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

Please add your views here:

Clients of our members make use of all the different forms of design protection and different forms work better for different sectors.

Unless we wish to resile from the Future Trade and Cooperation Agreement, we are obliged to provide something like UCD and some level of cumulative copyright protection, so the only candidate for the axe would be UK Unregistered Design Right. Getting rid of that would remove protection for investment in purely functional designs. Abandoning the TCA would open up the option to get rid of SUD.

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:

Whilst our members generally agree that there is a current lack of clarity. We do not think it impacts designers - as a rule they are unaware of the more esoteric options on the table, and think only about registration and copyright. But it does impact on competitors (and by the same token, benefits designers).

Foreign parties in particular are usually unaware of UCD and UK UDR. But these rights are often unavailable to them anyway. Our view is that, at a minimum, 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, we would recommend also harmonising defences with those for copyright in artistic works.

In an ideal world, appreciating the legislation changes would be extremely difficult, it would be simpler if there was just one form of unregistered design right, which harnesses the best of both the existing forms of UK unregistered design right currently in existence.

### 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:

“get-up” translates into a variety of different terms in the different EU languages. Since it is clear from the definitions that products, their ornamentation and their packaging are all protectable we doubt we need to retain this.

We find that most people – and we include UK legal professionals of all types – struggle to understand how unregistered design rights come into existence. That lack of knowledge is actually less of a problem than you might expect, because designers do not typically plan to create these rights at all. Where designers and design oriented companies think about protection up-front, they register. Unregistered rights come into play where there is no registration, or the registration is defective – after the event of infringement.

Simplification is desirable. 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 usually come to the same thing anyway.

Our members think there is much to be said for abandoning the “must-match” criterion for UK UDR and replacing it with a right to repair. That would mark a major change in the function of UK UDR which would no longer protect any form of spare parts for use in repair, but would clarify and liberalise the position. If it were felt too punitive to OEMs, the existing licence-of-right provisions could be used – repair uses would be entitled to a licence of right from day one, not a free defence.

Increased clarification would be helpful as to the allowability of animated/GUI designs, if not in the Act then at least in the Registered Designs Examination Practice guide.

We also think it would also be of benefit if the UKIPO considered a provision in the UK registered design act for the inclusion of a short (1 month or 2 month) restoration period in the case of missing the 6 month priority window - using the 'unintentional' test. Whilst the UKIPO in this instance may simply state 'use the 12 month novelty grace period instead', there may be many practical reasons why the 12 month novelty grace period may not be applicable in these instances.

We also think that UK Examination Practice Guide for designs is lacking in any substantive comments as to how the UKIPO determines whether a priority claim is valid or not, in instances where the UK design doesn't exactly match the design from the priority application (e.g. if a line is changed from dotted to solid, but is a small change in all?)

### 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:

One of our members has made a detailed study of the issue over the years since 2002, and is of the opinion that a worldwide disclosure is sufficient to create UCD, and that the German courts have got the issue wrong. We think it is also the case that same-day (not necessarily simultaneous) disclosure is sufficient to create a valid UCD and therefore also SUD. We believe it would be sensible to retain the present position of allowing disclosures outside the UK to initiate SUD. Having said this, we think clarification could be welcome.

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 chancy and less harmonised.

### 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:

There are several linked issues here:

(1) 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?

(2) Should it be easier to register dynamic designs?

(3) Should filing CAD or other e-representations of 3D shapes be possible?

(4) Should specimens be abandoned?

(5) How should AI authorship be handled?

Taking the (4) first, we believe that physical specimens have a role to play unless it is possible to replace them with a convincing 3D electronic representation. So if (3) is adopted, as we think it should be, it would be possible to stop accepting physical specimens. As so few are filed, it might be possible for the UKIPO to scan specimens itself rather than putting the burden on applicants. Existing specimens could also be back-scanned.

As for (1), we think the answer is a definite “yes”, subject to a “scenes a faire” defence protecting against incidental inclusion (as is available in copyright law). (2) is also a “yes”.

As for (5), the consultation asks whether SUD should be extended to protect computer generated designs. We think the same definitions of “author” as for UK UDR, UK RD and copyright should be introduced for SUD. That deals adequately with computer-generated works at the present state of

technology. Since it is unnecessary to name a designer on filing a UK registered design, the ongoing DABUS debate does not bite. We suspect allowing 3D files to be submitted may be difficult to then enforce, as the scope of the design may then be challenging to discern in some instances.

That being said, for animated designs, it may be helpful to allow a movie/animated video clip to be uploaded - noting you can effectively do this already, by submitting a number of sequential views on 'paper' to forms@ipo.gov.uk using a DF2A, noting the 'paper' version of the UK registered design application process is not limited to 12 views, so you can submit lots of sequential view to effectively create a movie anyway, in principal. If an animated/video file was allowed however, care would be required to ensure the design is still clear in scope (e.g. shown on a plain background, with any sound removed, perhaps?)

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

Please add your views here:

See previous comments with regards to animated designs being very inconsistently treated by the UKIPO, hence why increased clarity in this respect would seemingly be needed.

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:

As indicated above we don't see much personal need to continue allowing the deposition of physical specimens, noting this can in any case result in inconsistent scopes of protection.

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

Please add your views here:

See above

## Better regulation

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

Please add your views here:

Our members have a number of opinions in one 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 and does see any need for 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.

In another view the 12 month deferment period (from the filing date of the UK registered design application) is considered to be sufficient, noting you can practically extend this to 18 months by using the UKIPO as an Office of Second Filing (OSF), and by having the UK registered design claim priority from an earlier priority registered design application using the full six month period.

That being said, if the UKIPO did want to increase usage of the UKIPO as an Office of First Filing, they might wish to consider changing the maximum deferment period to 18 months from the priority date (along with signing up to the DAS system as noted previously), which would still result in the same end goal as per the above. This would then also mean the publication period for a UK registered design may be largely aligned with that of the publication period for a UK patent application, which could also be advantageous.

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

Please add your views here:

We think how the EUIPO treats deferred designs is helpful, such that you can see that a design registration has been applied for, and by whom, but the content of the design registration cannot otherwise be discerned until full publication arises. At least as a competitor then, you at least have an understanding that some sort of design has been applied for, rather than being completely in the dark as to what has been applied for.

Indeed, this approach is no different to what the UKIPO currently has on the UK patent front, where from the UK patent journal you can at least some basic details about filed, but not yet published, UK patent applications made by any party. So the above change would harmonise UK design and patent procedure in that respect.

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:

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:

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.

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

Please add your views here:

We have a single member who has advised a single party about criminal design infringement. In this case we understand this party's experience of use of the Magistrates' courts and the CPS has been unhelpful and frustrating to them. We have seen no evidence that the system is widely used, or working well.

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 do not think that it is appropriate to criminalise something when it is impossible to identify the right, who owns it or when it runs from or when it expires?

Anyone is free to copy a product in the market place, unless there is a right in it. How do we find out what those rights are?

When it comes to criminal provisions for copyright, then one tends to be talking about substantial works – such as films, books and records – many of which contain copyright notices with dates of creation and the name of the owner. Those criminal provisions are really about piracy. However, those provisions are too broad and cause much trouble and could do with being curtailed for small items where you can't readily identify that it is a copyright work and still in copyright. This is particularly likely to be a problem where the copyright claim is that a product has become iconic and now has copyright, when it might not have been iconic 5 years earlier and had no copyright.

When it comes to registered designs, at least there is a register with images. If we can work out what is important, we can do some kind of clearance search.

When it comes to an unregistered design right, until the designer starts to identify what rights subsists and in what, who made it, how the claimant owns it, when it was created, first sold etc, then it is impossible for a third party to be able to know whether they are doing something which might be alleged to be an infringement. It is impossible to give clearance advice.