

## Response ID ANON-6TNE-VMWP-7

Submitted to Reviewing the designs framework: Call for views  
Submitted on 2022-02-15 08:50:46

### 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?

A legal professional

If you have selected other please specify:

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

Not Answered

If you selected other please specify:

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

Not Answered

If you selected other please specify:

8 How many people does your business employ?

Not Answered

### 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:

Yes:

1) having 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).

2) adding 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.

3) increasing the maximum description length for designs submitted on the online e-filing software. I 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.

4) increasing 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 typically balk and query why we have submitted such poor quality drawings (when we haven't - it is just due to compression by the UKIPO to make them fit in 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.

5) increasing the duration a draft UK design application is kept saved for (7 days is too short in my opinion). 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 we send a draft design out to a client for review, they may often take more than 7 days to look at/approve it, meaning we have to re-save the draft every 6 days, which can get a little irritating. 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 retried later on, as needed.

6) increased 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. So what happens, as a result, is that UK Examiners treat this guidance far too inconsistently - some requiring animated designs to allow human interaction, whilst others not, for instance.

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

Prior art searching

Please provide more detail below:

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?

## Simplifying the designs system

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

Please add your views here:

Registered design protection (both via the UKIPO and via The Hague system).

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:

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:

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.

I think it would also be helpful 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.

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 comments.

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:

No comments.

## Future technologies

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

Please add your views here:

I 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:

I 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:

No comment.

## Better regulation

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

Please add your views here:

In my opinion, I consider the 12 month deferment period (from the filing date of the UK registered design application) 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, as you note, 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:

I 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:

Not in my personal view, no.

## 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:

No comment.

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:

Only to say that I would be cautious about the introduction of too many criminal sanctions for design matters, noting if a criminal conviction arises, and the design turns out to be subsequently invalid (e.g. due to new prior art which arose after the conviction), the prospect of a wrongful criminal conviction would be, clearly, undesirable.