

## Response ID ANON-6TNE-VM6W-D

Submitted to Reviewing the designs framework: Call for views  
Submitted on 2022-03-24 22:33:58

### 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?

Any other type of organisation

If you selected other please specify:

Legal

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

Other

If you selected other please specify:

Intellectual property

8 How many people does your business employ?

50-249

### 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:

In our experience, our clients like the quick and inexpensive (relative to patents) nature of the UK registered design system. These are often the main “selling points” for encouraging a client to register their designs, especially for SMEs and those new to IP as well as clients in fast moving sectors such as app design or fashion. An increase in the official fees and delay to registration due to an examination process and/or opposition procedure being introduced could easily sway clients not to bother with UK designs and instead rely on unregistered rights in the UK. Such a change would also introduce an unpredictability to the downstream costs of registered designs, which we feel a lot of clients would not wish to take on. Many of our clients do not seek design registrations overseas for these reasons.

Although we can envisage some clients seeing the benefit in having their designs examined (e.g. to provide more certainty as to the validity of their design), we believe this would be the minority.

If the UKIPO was to bring in the rule of design registrations not being able to be enforced without them first going through examination, then perhaps there should be the option on filing to either go down the traditional registration route or the new examination route (with increased fees). Applicants can then choose which route to take, knowing that if the traditional registration route is chosen then they must have the design examined before enforcing the registration. In this way, the attractiveness of the traditional registration system still stands with the option for obtaining a more robust registration at the outset. We can envisage clients selecting their high-value designs for examination on filing.

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

Other

Please provide more detail below:

As explained in the box above

## Simplifying the designs system

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

Please add your views here:

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:

Could surface decoration be included in unregistered design rights to bring it more in line with registered designs? The different durations of protection for unregistered design rights can cause confusion for clients and makes advising on them more complex, so could some thought be given to harmonising the length of protection provided (although this potentially could be seen as 'losing' some rights if the length of UK unregistered design right protection is shortened)

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:

In light of the increased number of animated designs (e.g. in relation to app design) that we are seeing being filed, clarification on what is meant by "animation" would be helpful. Examples in relation to apps would help, as well as clarification/examples regarding how much of a progression is required in order to be accepted as an animated design. We have received a lot of objections in relation to animated designs and so clarification would help us to better advise clients on how best to protect these types of designs.

Also, clarification on "limitation/disclaimer" would be helpful. The UKIPO website has guidance, but more clarification/examples are needed on possible limitations/disclaimers that can be used. Additionally, the length of the text field that can be included when filing designs online is limited and often has to be truncated.

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:

The need for clients to consider carefully how, when and where a design is first disclosed in order to establish either supplementary unregistered design rights in the EU or unregistered community design rights in the EU is a considerable logistical challenge. Also there seems to be little clarity around how a non-geographical, i.e. online, disclosure available in both the UK and EU should be interpreted, so guidance in this area in particular would be welcomed.

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:

Although simultaneous disclosure may address the issue, this would appear to be a "back door" into protection which was clearly lost by UK businesses as a result of the Brexit process. In our view, it would be appropriate for the UK to disregard a disclosure of a particular design which was made simultaneously (or slightly before) by an EU-based subsidiary (or parent) of the UK limited company which makes the simultaneous (or slightly later) disclosure of a design only where the EU would agree to the same provisions. At present, we do not foresee this being agreed in principle.

## Future technologies

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

Please add your views here:

"Digital designs" – as outlined previously, clarification on what is meant by "animation" would be helpful. Better yet, allow an animated video to be filed (discussed further in the next question). Moreover, the limit on image pixel size makes it difficult to protect the appearance of certain GUIs, especially webpages.

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

Please add your views here:

“Transformable designs” – it is stated that this is where no removable parts are added or taken away; but does this cover all 4D products? Are there instances where a part looks as if it has been taken away but it has actually just “transformed”? In which case, there would need to be special provisions for protecting 4D designs.

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:

Physical specimens – in our experience, this is very rarely used and so we cannot envisage an issue with removing this provision

Filing digital files:

- For GUIs - Remove physical limit on image pixel size.

- For animations – Permitting an animated video to be filed makes a lot of sense since there are many shortcomings in relation to trying to protect a digital animation via a series of still images. Presumably this would mean the Register would host the animation for third parties to view? It would be important to consider whether there would be a limit on running time or number of changes in the video and what these would be to make it fair but still attractive to clients. This change could put the UK at the forefront of allowing digital designers to protect their designs – potentially making the UK very attractive!

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

Please add your views here:

## Better regulation

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

Please add your views here:

Yes – deferred publication is crucially important to some clients, e.g. to align publication of the design registration with launch of their product. This should remain an option. The 12-month deferment period is a little short and could be increased to at least 18 months (to align with patent publication) or 30 months (to align with the EUIPO system).

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

Please add your views here:

The same pre-publication information that is published on the UK Register for patent applications could be similarly published for design applications for which deferred publication has been requested. For example, the applicant, filing date and title of the product could be published. This would be useful for third parties to monitor unpublished designs.

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:

On the basis that UK registered designs are well known as being unexamined, in practice we have found that registered designs are often held to be valid but not infringed due to a crowded register and numerous similar registered designs co-existing on the register itself, which limits the scope of differences between the registered design in suit and the alleged infringing article required to find a “different overall impression”.

In addition, when seeking to establish that the designs create a different overall impression, the volume of disclosure which can be provided by the defendant often makes the process of litigating registered designs disproportionately expensive to the registration cost of the rights themselves.

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

Please add your views here:

In our view, having the choice of examination by the office of design registrations prior to registration would assist in creating a presumption of validity for many of the designs on the register, and perhaps also provide a basis for limiting the scope of disclosure of the defendant to a number of the “closest” designs (much in the way the EPO operates on “closest prior art”) for registered design cases. This could create a “slimmed down” procedure even when compared to the IPEC approach.

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

Please add your views here:

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: