

## Response ID ANON-6TNE-VM6V-C

Submitted to Reviewing the designs framework: Call for views  
Submitted on 2022-03-25 18:05:23

### 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:

I am an Appointed Person to hear designs appeals from the IPO, and practise at the Bar in the field of designs law and other intellectual property

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

Specialist design, e.g. fashion design, industrial design, graphic design

If you selected other please specify:

Legal advice and litigation services relating to designs, and lead editor of designs law textbook Russell-Clarke & Howe on Industrial Design (Sweet & Maxwell)

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:

In my experience the lack of examination for novelty or individual character has led to presence on the register of many designs which are clearly invalid when challenged. Unfortunately such invalid designs can be easily deployed in such a way as to cause serious commercial damage to legitimate business interests: for example, a registered design can be easily used as the basis of a "take down" notice to an online market place. Online market places in practice comply with such notices are not interested in themselves investigating the rights and wrongs of an invalidity argument. This means that a company which wants to sell goods cannot do so until it has succeeded in IPO invalidation proceedings, which can take a long time (e.g. 2-3 years if appeals are included). Although it would be expensive to examine every application, a cost which would need to be paid in fees by applicants, the Australian system whereby applications must be examined before they can be enforced or asserted in any way is a reasonable compromise. In such a system the examination should be for both novelty and individual character.

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

Two-tier system

Please provide more detail below:  
Please see my answer 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:

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:

Please see my note on simplification of UK designs laws submitted separately. The present complex system of overlapping different rights adds greatly to the cost and difficulty of providing legal advice and of litigation.

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:

Please see my separate paper on cleaning up the present unsatisfactory definition of "product". The term "get-up" should on any view be removed from the definition of product - it only serves to create confusions since "get-up" is attributes applied to a product and not a product as such. I cannot see how clarification or guidance would make it any better.

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:

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:

Intangible designs such as pictorial representations in computer graphics are more appropriately protected (and are adequately protected) by copyright law rather than by designs laws.

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

Please add your views here:

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:

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

Please add your views here:

Section 9(3) of CDPA 1988 makes provision for copyright works which are computer generated and similar provision could be made for designs.

### Better regulation

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

Please add your views here:

Deferment of publication is in principle undesirable since it leads to the risk of other businesses embarking on selling a product which (without their knowledge) turns out to be covered by a prior-filed design registration

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

Please add your views here:

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

Please add your views here:

If you go down this road, then there needs to be an equivalent of s.64 of the Patents Act 1977 (right to continue use begun before the priority date) but adjusted to refer to the publication date of the design registration

## Enforcement

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

Please add your views here:

The enforcement framework is generally effective through the civil courts, and IPEC has improved access by smaller parties to the system

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:

I have had no experience of the impact of these provisions.

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:

It would be a serious mistake to extend criminal offences to infringement of unregistered rights, owing to the uncertainty of scope of what has been created by the rights owner.