

Response ID ANON-6TNE-VM64-A

Submitted to Reviewing the designs framework: Call for views
Submitted on 2022-03-23 14:39:46

Introduction

1 What is your name?

Name:

[REDACTED]

2 What is your organisation?

Organisation:
Wilson Gunn

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?

Other

If you selected other please specify:
patent attorneys, various clients

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:

I am strongly of the opinion that the IPO should introduce an OPTIONAL examination stage. This should be post-registration and could result in "Certification". Certification should then be required before litigation or issuing take-down notices.

The point should be to weed out plainly invalid designs which are being used vexatiously.

The approach could be modelled on either the Australian or Chinese approaches.

More detail can be found in the article I co-authored in the Cipa Journal Volume 51, number 1-2 JANUARY-FEBRUARY 2022, from pages 19-22. If this is not available to you, please let me know and I can send a copy.

The conclusion of the article is set out below:

If it were possible to take the best of the Chinese and Australian systems, then any UK post-examination system would have the speed of the Chinese approach and the option to request search of another party's design from the Australian approach.

Ultimately, however, it would be necessary for online marketplaces in the UK to only allow enforcement with a certificate of examination as per the policies of the Alibaba group and JD in China. This could be achieved by ensuring that any new UK legislation ensures that online marketplaces are able to refuse to action an allegation of registered design infringement without evidence of examination. If the online marketplaces do not or are unable to require evidence of examination, we may end up in much the same position as we are already in now, requiring action for threats, which will often be more costly than it is worth, to deal with abusive enforcement of registered designs.

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

Prior art searching, Other

Please provide more detail below:

Post-registration, optional, search and examination, ideally necessary before enforcement and ideally "instigatable" by a third party