

Call for Views on Designs¹

Due Date: 25 March 2022

Section A: Response to Call for Views on Designs

1. Context:

The existing framework encompassing intellectual property laws that protect designs is overly complex. In the UK, depending on how one characterizes the context, four to six different types of overlapping design protection are available (see [below](#)). This creates barriers in effectively protecting creations for designers. Further, the overlapping elements of copyright and design protection in the UK are confusing to many designers and even to some legal practitioners. Designs have traditionally been protected by design law, copyright law, or both, depending of course on whether the respective requirements for protection are met.

For this introductory overview, in context, the Government's Innovation strategy³ states that :

'[D]esign is core to successful innovation' and that '[G]reat design means putting the needs, wishes and behaviours of people at the heart of the innovation process, so that new ideas are truly desirable as well as being technically feasible and financially viable'.

If that is the case, then designers need to be afforded better tools, simpler processes and greater clarity in the law as it applies to designers and the protection of their creative rights. The IPO recognises⁴ that SMEs need the right support commercialising their IP and addressing these gaps and complexities in the laws impacting Designs is a key element for SMEs in the design industry.

In 2018, the [Design Council](#) reported that the design economy generated £85.2bn in gross value added ('GVA') to the UK in 2016, equivalent to 7% of total UK GVA. The Call for Views on Designs states that this '*demonstrates the importance of designs to the United Kingdom both now and in the future*'⁵. Yet, the industry is struggling with the costs and complexities of UK laws on designs, especially post Brexit. Further, adoption of new technologies that *might* aid or simplify some of the cost and time challenges that the UK's design industry faces with the current UK laws on designs, post Brexit, is not keeping pace.

Entrepreneurs and designers in SME businesses in the textile, industrial and non-industrial design sectors are perhaps some of the most seriously impacted by the cost of adoption and the additional cost of upskilling staff to address post-Brexit inconsistencies in the law(s) impacting designs and the costs of adoption of new technology, such as 3-D printing, 4-D⁶ designs or AI-generated designs.

Perhaps *because* of its complexity, design protection is often misunderstood by designers and so less used, compared other IP rights. In our conversations with industry groups, a consistent sentiment was expressed that designers are the '*poor cousins*' of their counterparts in the music, fashion or

¹ <https://www.gov.uk/government/consultations/reviewing-the-designs-framework-call-for-views/call-for-views-on-designs>

² See Section C for details

³ <https://www.gov.uk/government/publications/uk-innovation-strategy-leading-the-future-by-creating-it/uk-innovation-strategy-leading-the-future-by-creating-it-accessible-webpage>

⁴ <https://www.gov.uk/government/publications/uk-innovation-strategy-leading-the-future-by-creating-it/uk-innovation-strategy-leading-the-future-by-creating-it-accessible-webpage>

⁵ Vide Ref. 1, *supra*

⁶ 4-D printing is based on 3-D printing technology, but it adds a fourth dimension – time. It uses specialist materials that are able to change shape or function after the production of a work. The change in the object's shape occurs through stimuli (such as temperature or water).

software industries. Complexity is also, per ACID feedback, being used by some lawyers to exclude the small designer without the funds to instruct lawyers, often an unaffordable expense for SMEs.

This submission advocates the need for a substantial overhaul of the overlapping rights and a resetting of the law relating to design protection in the UK to assist designers in making the most of the UK Designs laws and related IPO processes. This includes maximising the benefits of the rights granted by the law on designs whilst promoting a more efficient, cheaper, simpler and more useable registration system, with the adoption of new AI and machine learning search tools that do **not** extend the existing lengthy registration process and avoid raising applicant costs⁷ any further.

2. Scope and Ambit

Any new regime also needs to recognise not only the overlapping challenges of the existing legislative framework but also the challenges of new technologies and their impact, including 3-D printing and 3-D/4-D designs and the future of the 4-D printing pioneers, technologies that are now increasingly available and prevalent in US, the EU and UK and to seek comparable benchmarks – in the US, EU and Asia – to ensure that the UK Designs laws remain competitive, encourage design registrations in the UK and offer clear, cost-effective solutions for the industry's challenges.

The breadth of the consultation suggests that the Government shows willingness and clear intent to assist business in creating a national designs regime that works better for designers.

We would therefore encourage the IPO address these concerns with a significant overhaul of the system, helping businesses to leverage the strategic and commercial value of their designs.

3. Overview / Summary of Feedback

The headline points of note, in our view are as follows:

1. **Brexit-related consequences.** EU IP post Brexit left the design industry with a problem of registering in EU and UK. Prior to Brexit, it was clearer/easier.
2. **Higher Legal costs.** The industry has lost some confidence in IP attorneys and IP attorneys are not as familiar with registered designs and unregistered design practices or the finer points of application of copyright and design laws, especially post-Brexit;
3. **Confidence.** The sector has lost confidence in the design registration system, offering no real protection against larger companies who pay for legal advice and continue to infringe.
4. **Damages.** If awarded these are low and do not compensate for costs; statutory guidance on damages or minimum damages provisions would help the industry.
5. **Novelty searches.** Currently, the UK Patent Office does not search for conflicting designs when it receives an application. This area needs attention and redress. Whilst some expressed concerns about the cost of new searches, delays in application procedures and costs of training to use such new tools, there is a significant opportunity to use AI and machine learning in the Registered Design process and to simplify, making registered design searches easier and helping countless businesses through the current quagmire.
6. **Criminal sanctions.** Further criminal sanctions / provisions should exist in UK law beyond those in the existing legislative framework, e.g. s.5 of the RDA. It is worth recalling that the majority of designers rely on unregistered design protection. Therefore, criminal sanctions should exist for unregistered design infringement. We would advocate for a change in the law, making it a criminal offence to infringe unregistered design rights. This reflects the contention that there are more attractive protections elsewhereⁱ;
7. **Harmonisation.** Globally - there is a lack of registered design law uniformity. Dubai is an example of issues experienced by ACID. The UK should consider EU laws and laws in

⁷ In the UK, the official registration cost is £50 per design (£70 for up to 10 designs). In the EU, the official registration cost is €230 (€115 for up to 10 designs). This does not include lawyers' fees or other additional expenses (such as the cost of preparing the drawings).

comparable jurisdictions and frame a harmonizing law for designs. One element to include would be that disclosure (required) should be anywhere, whether in the EU, the UK, or elsewhere. The place where the design is first disclosed has become critical in determining whether the design is protected as either a supplementary unregistered design in the UK or an unregistered community design in the EU.

8. **Term for Registered and Unregistered Designs: Extension.** We would advocate for a change in the duration of the protection of unregistered design rights. 10 years (from disclosure) is too short and we would recommend to extend to 25 years (given the call for extension of IP protection for AI-generated IP might extend such protection to 25 years)
9. **Economic Impact.** Key members of ACID (Anti-Copying in Design) have indicated⁸ that their members and organisations have ‘scaled back on global exports post Brexit as a result of above’.
10. **Registered design for 3-D/4-D printing.** This remains an open question. Whilst 3-D printing is now prevalent⁹, 4-D printing is emerging as a new area of industrial and design application that will require new legislative consideration. 4-D printing may forever change the design landscape. 3-D printing or additive manufacturing has already allowed designers to create three-dimensional objects from two-dimensional digital files with obvious implications for counterfeiting, in industrial design sectors, particularly but also in the fashion industry.

In addition to the copyright protection afforded to works of artistic craftsmanship in designs, four specific ‘design rights’ available in the UK prior to 31 December 2020 (IP completion day) are set out below.

A) Registered design rights:

1. UK registered designs
2. Registered Community Designs (RCDs) (in force across the entire EU)

B) Unregistered design rights:

1. UK unregistered [design right](#) (also known as ‘design right’)
2. Unregistered Community Designs (UCDs) (in force across the entire EU)

Those four different types of overlapping design protection available **today in the UK** are:

- (1) [registered designs](#),
- (2) [supplementary unregistered design](#),
- (3) continuing unregistered community design (if made public in UK or EU before 1 Jan 2021); and,
- (4) UK unregistered design right (“design right”).

In addition, as mentioned, copyright will also subsist in works of artistic craftsmanship.

Further, there are also two further EU rights – a) Community Unregistered Design Right and b) Community Registered Design Right. Whilst they are not available in the UK, they are available to UK designers if they first publish their designs within the EU.

⁸ In direct discussions with ACID

⁹ <https://ec.europa.eu/docsroom/documents/18921/attachments/3/translations/en/renditions/native>

4. Recommendations

Framework and Harmonisation

We encourage the IPO and UK Government to take steps to restore designers' confidence in the UK Design registration system by simplifying and clarifying the rights into 3 categories:

- 1) **Registered designs** (including for 3-D and 4-D designs)
- 2) **Unregistered Designs.** Harmonising all elements into a single simpler category of Unregistered designs (removing overlaps with copyright or clarifying that protection for such rights shall subsist in copyright)

Currently shape and configuration (how the parts are arranged) of 3-dimensional objects is automatically protected in the UK for whichever ends first of:

- 10 years after it was first sold; or
- 15 years after it was created

- 3) **Copyright.** Clarifying which elements applicable to designs can be protected by copyright, including consideration and treatment for 3-D and 4-D designs, adding clarity for applicants and users and removing the current confusion caused by overlapping elements.

At the international level, Article 2(7) of the Berne Convention on the Protection of Literary and Artistic Works (hereinafter, "Berne Convention") lets signatory countries decide the extent and mode of application of their copyright laws to works of applied art and industrial designs and models.

In the EU, Article 17 of the Design Directive obliges Member States to consider designs protected by design rights also eligible for copyright protection, if such designs comply with the respective protection requirements. The key requirement for copyright protection in the EU is originality, defined as "the author's own intellectual creation."

For this requirement to be fulfilled, the author must have been able to express her creativity in an original manner, Article 17 of the Design Directive also states that "[t]he extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State."

The provision seemed thus to leave to Member States the decision of whether to apply the harmonised criterion of originality – "the author's own intellectual creation" – to designs, or to instead adopt a different protection requirement for this specific type of work.

Following this possibility, a few Member States such as Germany, Portugal and Spain required a higher threshold of originality or artistic merit of the work.

The CJEU has however clarified that the harmonised criterion for copyright protection applies to designs as well. In other words, the only requirement that a design has to fulfil in order to be protected by copyright in the EU is that it is original in the sense that it is the author's own intellectual creation.

In the context of the specific Calls for Views, our Recommendations are as follows:

1. **Extended Term.**
 - a. a longer period of protection for unregistered designs, extended **to at least 25 years** given the protection afforded to computer generated copyright works (50 years) and the call for copyright protection for AI-generated works to be 25 years. 10 / 15 years protection is too short for the investment and costs to designers and the importance of Design to the Design Council initiatives, as stated above.
 - b. a period of **5 years** for "supplementary unregistered design rights", as defined in the current framework.
2. **Criminal penalties.** Criminal penalties do not exist for unregistered design right infringement. We propose that infringement attract a sanction similar to the lower end of the rights set out above **namely 6 months and/or a £5,000 fine and a 1-year term of imprisonment on Indictment**
3. **Damages.** We recommend a minimum statutory damages or guidance on the range of damages to protect SMEs investment and costs incurred in unregistered and registered design protection, much as PRC instigated minimum damages for patent infringement under the PRC Patents Act, in the first 15 years after implementation, to align a population previously unguided on paying damages for patent infringement (Art 64 Patents Act, PRC¹⁰).

We also propose an extension of the period of registered design protection to align with the UK term of copyright protection for certain elements (if not all) of designs.

5. Context

Table created to illustrate the range of IP protections, term durations and criminal sanctions across various IP asset classes and the limited criminal sanctions for infringement of design rights

Illustrative headlines only below; not exhaustive - further details available [here](#).

IP Right	Duration/Term of protection of IP right	Detail / Sub-set of IP right	Criminal sanction for breach or infringement	Sentence in Magistrates Court	Crown Court Indictment
Trade Marks - Unauthorised use of a trade mark	10 years from date of registration, renewable in perpetuity	See link here	S. 92(1)	6 months and/or a £5,000 fine.	10 years and/or a fine
		See link here	S. 92(2)	6 months and/or a £5,000 fine.	10 years and/or a fine
Patents	Patents: 20 years (compulsory licensing after 16 years for some patents)	Patents Act 1977		Patent infringement in the UK is a civil law matter not a criminal law issue.	Patent infringement is generally a strict liability civil offence

¹⁰¹⁰ <https://www.wipo.int/edocs/lexdocs/laws/en/cn/cn028en.pdf>

IP Right	Duration/Term of protection of IP right	Detail / Sub-set of IP right	Criminal sanction for breach or infringement	Sentence in Magistrates Court	Crown Court Indictment
Copyright Designs and Patents Act	Copyright: Life of the Author plus 70 years Patents: 20 years (compulsory licensing after 16 years for some patents)	See link here	S. 107(1)(a)+(b) S. 107(1)(d)(iv) S. 107(1)(e) s. 198(1) (a) – (d) and IA	6 months and/or an unlimited fine	10 years and/or a fine.
			107(1)(c) S. 107(1)(d)(i)-(iii) S.107(2) Copyright Designs and Patents Act 1988, Sections 107, 198, 296 Z B and 297. Sections 107 and 198 as amended by the Digital Economy Act 2017	3 months and/or a £5,000 fine.	
			S. 107 (2A)	3 months and/or an unlimited fine	10 years and/or a fine.
Copyright Designs and Patents Act	Computer generated works – 50 years		S. 12(7) CDPA	As for copyright infringement	
Registered Designs	25 years must be renewed every 5 years	Registered Designs Act (as amended)	S. 35ZA (1) and (3) inserted by Section 13 of the Intellectual Property Act 2014. The offence appears in Section 35ZA:	England, Wales or Northern Ireland, to imprisonment for a term not exceeding 6 months or to a fine not exceeding the statutory max. or to both. Scotland, to imprisonment for a term not exceeding 12 months or a fine not	imprisonment for a term not exceeding 10 years or to a fine or to both

IP Right	Duration/Term of protection of IP right	Detail / Sub-set of IP right	Criminal sanction for breach or infringement	Sentence in Magistrates Court	Crown Court Indictment
				exceeding the statutory max. or both.	
Unregistered Designs Unregistered design right under the Copyright, Designs and Patents Act 1988 (CDPA).	Shape and Configuration Currently shape and configuration (how the parts are arranged) of 3-dimensional objects is automatically protected in the UK for whichever ends first of: 1) 10 years after it was first sold 2) 15 years after it was created Appearance. The appearance of a product is protected in the UK for 3 years from the date you make your design public. This is known as ‘ supplementary unregistered design right ’ or SUD (or ‘continuing unregistered community design’ if you made your design public in the UK or the EU before 1 January 2021). The appearance of a product can be 2-dimensional and 3-dimensional and includes its shape, colours, texture, materials				

B. Specific Questions and Responses

1. Do you have views on whether the IPO should change examination practice for designs? Do you think it would be useful to introduce any of the options outlined? These include prior art searching, a two-tier system, use of AI tools, bad faith and opposition periods. Are there other options not outlined?

Fundamentally, a wholesale change and alignment of laws applicable to designs is needed in the UK. The Government is therefore advisedly seeking feedback to its consultation on Designs for an industry that appears to have been left behind, in many ways.

At present, no examination for registered designs or unregistered designs takes place in the UK so we propose that the two are aligned so that examination takes place before registration, at least for registered designs. Perhaps using AI and machine learning search tools may allow the IPO to combine examination for both registered and unregistered designs and allow rights owners to search the landscape to ensure that their designs are ‘new’ and not ‘commonplace’ in the design field in question.

Using AI for prior art searches is a positive approach and is supported by many.


However, if a new process is implemented, it should be aimed at increasing certainty and streamlining the process for SMEs and designers, not to add complexity and cost.

Currently, lengthy design registration processes, complexities and costs impacting this segment are in need of redress. Those that characterise this segment as the ‘*poor cousins*’ of the IP industry, feel neglected when compared to the engineering, manufacturing or high-tech patent-led industry or the literary, online publishing, media, software, music or fashion-led copyright industries and the global brand-led trade mark fields of law. This industry segment would therefore benefit from a substantial rethink and overhaul of areas of the law that leave industry experts at times exasperated or frustrated by the inconsistencies and the resulting costs of protection for small businesses whose focus is on designs. It is therefore not surprising that a consensus of opinion, including from ACID (Anti-Copying in Design), have found their members expressed increasing concern at the complexity,

lack of cohesiveness and cost of understanding the laws and regulations around registered and unregistered designs post Brexit and the lack of harmonization of EU and UK laws.

Adoption of machine learning or AI-assisted prior art searches pre-examination could go a long way to assisting designers and the Patent Office in performing searches when applications for registration of designs are made. This could remove a significant obstacle to the trust in the system since many infringers challenge registrations on the basis of invalidity.

2. 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.

 correctly, in our opinion, stated¹¹ that :

“Designs are very likely to become the first intellectual property right where the law in the UK and EU will truly diverge following Brexit. The law on designs is currently overly complex. In the UK alone four¹² different types of overlapping design protection are available. This creates barriers in effectively protecting creations for designers. The consultation offers a chance to get your views heard, and to lobby for a modernised model.” (emphasis added)

We would contend that the overlapping ways of protecting the appearance of a product present a number of issues to creators and designers.

There are many overlapping concepts. In essence, a design right protects the *aesthetic features* of an invention, whereas copyright protects the *underlying expression of ideas (and the drawing of the design)* whilst design laws protect the *actual design itself*. Using a computer game as an example, copyright would protect the code but would not necessarily prohibit somebody from arriving independently at a similar work.

See [Recommendations](#) above.

3. Are there inconsistencies between the design rights that need to be addressed e.g., qualification requirements, spare parts exemption? Are there terms in the Registered Designs Act which would benefit from clarification or guidance e.g. “get up”?

No specific comment.

The market for auto spare parts is of major significance to the national economies of countries with automotive industries. Because original equipment manufacturers (OEMs) hold design protection over spare parts, they tend to monopolise the spare parts aftermarket to the exclusion of third-party producers of replica parts.¹³

4. 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



¹³The underlying principle appears to be embodied in the British Leyland v Armstrong 1986 decision of the House of Lords (HoL) where the HoL rejected British Leyland’s attempt to use copyright laws to monopolise protection in Mini Metro exhaust pipes. ICLR report: [1986] 2 WLR 400]
<https://www.bailii.org/uk/cases/UKHL/1986/7.html>

December 2020). 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.

The UK Government must continue and accelerate its discussions on design with the EU post Brexit. The UK fashion design industry in particular will be seriously impacted if this is not higher on the agenda, to ensure clarity and reciprocal rights with one of the UK's largest trading partners.

The place where the design is first disclosed has become critical in determining whether the design is protected as either a supplementary unregistered design (in the UK) or an unregistered community design (in the EU), especially post-Brexit. Businesses now have to determine where to disclose their designs first, which was not the case pre-Brexit. Post-Brexit, the availability of supplementary unregistered design protection in the UK and unregistered Community design protection in the EU are *mutually exclusive* and dependent upon the territory in which the design is first disclosed. This is a serious problem for designers wanting design protection right across Europe, including the UK. At the moment, designers have to choose which market is most business critical for them.

Currently, a designer in the UK cannot register in the EU if the design was first disclosed in the UK and cannot register in the UK if a registered design is first disclosed in the EU, the designer cannot register in the UK, but at least the IPO may be compensated for that in the post-Brexit phase (post 'IP Completion Day'). Changes resulting from the UK's departure from the EU have unfortunately resulted in conflicting disclosure requirements forcing designers, in some instances, to choose between SUD protection in the UK and UCD protection in the EU27. This arises because the UCD right is only available where first disclosure was made in the EU27, whereas the SUD is only available where first disclosure was made in the UK.

So, for example, a fashion house exhibiting in London first will be denied protection in the EU27 whereas a fashion house exhibiting in Paris first will be denied protection in the UK. It has been suggested that simultaneous disclosure by live streaming in both territories could be a practical solution to this, but this has not been tested and some commentators are sceptical. A reciprocal agreement between the UK and the EU27 to recognise disclosure in each other's territory is needed but so far this has not been forthcoming. It can be hoped that both the UK and EU27 will recognise the insularity of such a limited approach to disclosure, not only to benefit their own designers but also to encourage international investment.

We strongly advocate for efforts to tackle the dilemma for design businesses around the availability of supplementary unregistered design protection in the UK and UCD protection in the EU. Simultaneous publication could be helped by improved new technology which would offer all those within the EU the opportunity to publish at the same time which would negate the risk of losing rights in other EU countries when one publishes first in a particular country.

The UK IPO may wish to be bold and allow the rights to arise on first disclosure anywhere in the world.

5. How can the current system better meet the needs of a digital environment and future technologies? Are areas such as digital designs and 4-D printed products adequately protected by the current system?

Design enforcement for registered design infringement is inadequate. With the advent of 4-D designs, the law needs to recognise both the method of searches for pre-existing 4-D designs, disclosure rules and the elements of 4-D design that will qualify for registration.

Whilst we cannot see that sufficient evidence exists, as yet, to support changes to the law on 4-D designs and printing, 4-D printing requires appropriate 4-D software and smart materials, both of which are still in their infancy in terms of research and development. Yet, this technology holds great promise for several industries, including the design industry. While copyright and design laws might still be able to accommodate, to a certain extent, the activities and results inherent to 3-D printing, the non-permanent character of 4-D printed objects represents a challenge to current laws¹⁴. For example, once made into a 3-D design, the design is no longer subject to criminal sanctions.

The process raises many copyright and design-related questions and several law suits ensued as soon as 3-D printing became more widely available.

4-D printing is an entirely different matter, both from a factual perspective and from a legal perspective. 4-D printing uses 3-D printing technology to create dynamic objects, i.e., objects that mutate or change shape over time when provided with the pre-programmed stimuli (such as temperature or water). Hence, for example, what begins as a static sculpture with a certain shape, can transform into a moving sculpture that adopts a different shape when exposed to high temperatures. 4-D printing requires smart design and smart materials, the development of which is still in its infancy, but it is expected that the underlying technology will become increasingly common and accessible in the coming years. 4-D printing raises new legal questions because the main legal issue can end up being the protectability (by copyright and design law) of the 4-D printed designs, and not problems of infringement. In fact, 4-D printed designs are not like the usual subject-matter of protection in that they are not stable design objects.

4-D designs may attract both copyright and design law protection, provided that certain requirements for protection are met. However, because of their dynamic character, 4D printed designs might raise issues of protectability under both copyright law (3.2.1.) and design law (3.2.2.).

According to B. Pasa (ed.) *Il Design, L'Innovazione Tecnologica e Digitale* (ESI Press, 2020) ...*'An answer may be found in the UK legislative framework, where the problem of identification of dynamic subject-matter was under discussion in Komesaroff vs Mickle. In the UK, Sec. 4 of the Copyright, Designs and Patents Act 1988 (hereinafter, "CDPA") lists different types of artistic works. The list is exhaustive, and the extent of protection is defined by the category under which the work falls. Artistic works are generally taken to embody "the way something appears in space, as opposed to the way something appears in time."*ⁱⁱ

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

See above.

Computer-generated designs need to be protected. In the context of this question, it is interesting to note the definition of a 'product' under the Registered Designs Act (RDA) 1949 - 'Product' is defined as "any industrial or handicraft item **other than a computer program**'(emphasis added).

The Registered Design Act (RDA) 1949 is unfamiliar to many designers and some IP lawyers and has been amended quite significantly, over a period of time and particularly through the Design Directive of 1998 ('DD'). The DD was particularly instrumental in bringing UK closer to other Member States, from the perspective of the substantive law¹⁵.

¹⁴ https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3573625

¹⁵ However, the DD maintained national procedures for obtaining, enforcing and invalidating national registered designs. See also, Vitoria M., et al, Laddie, Prescott & Vitoria, *The Modern Law of*

We would recommend that computer-generated design protection be aligned with computer generated protection afforded for copyright works.

On AI, as with patents and views submitted on the Call for Views on Patents and AI, we contend that, until further research is carried out, it is not possible for AI to be the author or owner of a registered or unregistered design because there is no clarity about the legal entity applying for the rights.

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

Yes, we believe there should be provision for express deferment.

There is currently no framework in UK legislation creating the right to defer publication of a registered design. As a matter of practice, the IPO permits applicants to defer publication of their design by up to 12 months, even though few know or understand this benefit.

The Government Guidance on this deferment in the table below the heading at [‘Applying for the UK registered design to be deferred’](#)¹⁶ demonstrates the complexity.

When the transition period relating to the UK’s exit from the EU ended on 1 January 2021, RCDs and UCDs were no longer valid in the UK. These rights were immediately and automatically replaced by UK rights: if you owned an existing right, you did not need to take any action.

Design protection across UK and EU can currently be obtained via a registered right in the following ways:

- a UK registered design granted by the IPO (protection in the UK)
- an RCD granted by the EUIPO (protection in the EU)
- an international registration designating either the UK or the EU, filed under the Hague Agreement at WIPO

The existing UK unregistered design protection mentioned [above](#) is also available:

Of course, since 1 January 2021, any existing RCDs, UCDs, European Union Trade Marks (EUTM), and International (EU) designs and trade marks only provide protection in the remaining EU member states. Under the EU law, an RCD that was deferred on exit day was treated as being equivalent to a pending application. The publication of an RCD may be deferred at EUIPO for up to thirty months. Where deferment is requested, EUIPO will not publish the design until either the holder has paid a publication fee and the deferment period has elapsed, or the holder requests publication before such expiry. Whilst the deferment period is ongoing, EUIPO will only publish basic details about the right holder and the filing date. The holder of a deferred RCD could preserve its earlier filing and priority dates in the UK by filing an equivalent registered design application in the nine months after the end of the transition period, that being up to and including 30 September 2021. The application would not have been the subject of a substantive examination, because the RCD had already been examined by EUIPO (pre-Brexit).

8. What information, if any, should be published in relation to a deferred design? Is there a need for specific provisions for prior use or to deal with co-pending applications?

Copyright and Designs, (4th ed) (Butterworths Law; 2011), 1867

¹⁶ <https://www.gov.uk/guidance/changes-to-eu-and-international-designs-and-trade-mark-protection>

We have no comment or views on what information, if any, should be published in relation to a deferred design?

Yes, there should be a specific provision for prior use or to deal with co-pending applications.

9. What are your views on the effectiveness of the UK's enforcement framework? How could it be improved to help small businesses and individual designers enforce their rights?

According to the Centre for Intellectual Property Management, CIPPM¹⁷:

*'Design enforcement may become even more complex in the future with the emergence of 3-D printing. This technology makes it easier to breach industrial designs and hence it is necessary to question exactly how rights will be enforced in the future ... Enforcing infringement laws [is] likely to become a complicated process with the decentralised nature of 3-D printing counterfeit and piracy. Furthermore, the anonymity and perception of safety that comes along with infringement inside private homes along with the ease and low-cost of 3-D printers contributes to these complications'*¹⁸

The above quote captured the challenges presented by additive manufacturing (or 3-D printing as it is more commonly known) back in 2015. The term 'additive manufacturing' emanates from the process of creating a product layer-by-layer. Whilst this new technology has opened up new frontiers, there is the fear that manufacturing and businesses will be disrupted as ordinary consumers gain access to power tools of design and production¹⁹.

Whilst actual infringement of registered and unregistered designs through the use of 3-D printers remained relatively unknown until the report of the CIPPM in 2019 (see above), due to limitations in technology, access to printing material and the cost of hardware, that report²⁰ confirmed concerns surrounding the anticipated impact of such copying. Moreover, given the decreasing costs in 3-D printers, advancements in technology and greater access to online tools for consumer use, it is reasonable to anticipate that it may become a significant issue in the near future. Therefore, in adapting to this technology, it is both prudent and timely to review the current design laws in order to adopt policy recommendations before the reproduction of physical objects do what MP3 files did for music and film.

We find the validity of the IPO argument that it would be too complex to include criminal provisions for the intentional infringement of an unregistered design due to the difficulty in determining which unregistered rights exist and who owns them, to be questionable. The rapid development of 4-D printing techniques will pose additional challenges.

10. What are your thoughts on extending criminal sanctions to unregistered designs and what economic evidence do you have to support your view?

The limitation of the current law: Offences under s. 5. RDA

¹⁷ https://microsites.bournemouth.ac.uk/cippm/files/2019/12/03-2019-DMendis_Design-Rights-and-3-D-Printing.pdf

¹⁸ 1 Economic Review of Industrial Design in Europe (MARKT2013/064/D2/ST/OP) (Europe Economics; 2015), p. 13

¹⁹ 5 H Lipson & M Kurman, Fabricated: The New World of 3-D Printing (Indiana: John Wiley & Sons, Inc.; 2013), 7

²⁰ C.f. reference 8, above

(1) If any person fails to comply with any direction given under section 5 of this Act or makes or causes to be made an application for the registration of a design in contravention of that section, he shall be guilty of an offence and liable:

[F1²¹ (a) on conviction on indictment to imprisonment for a term not exceeding two years or a fine, or both;

(b) on summary conviction to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or both.]

In the (almost) 10 years since the Impact Assessment of 2013²², little has changed in the effectiveness of the UK's enforcement framework for micro and SME designers, designer makers and manufacturers to improve the status quo. **The Impact Assessment of 17 January 2013 included the following:**

Stakeholders have told the IPO that the UK's legal framework for protecting designs is complex, confusing and, therefore, somewhat incoherent. This has:

- *created a lack of legal clarity and onerous proprietorship rights;*
- *reduced the protection available to overseas rights holders who trade or wish to trade in the EU;*
- *reduced legal certainty for firms seeking to protect or use designs.*

This is burdensome for smaller businesses with less experience and knowledge of the intellectual property system.

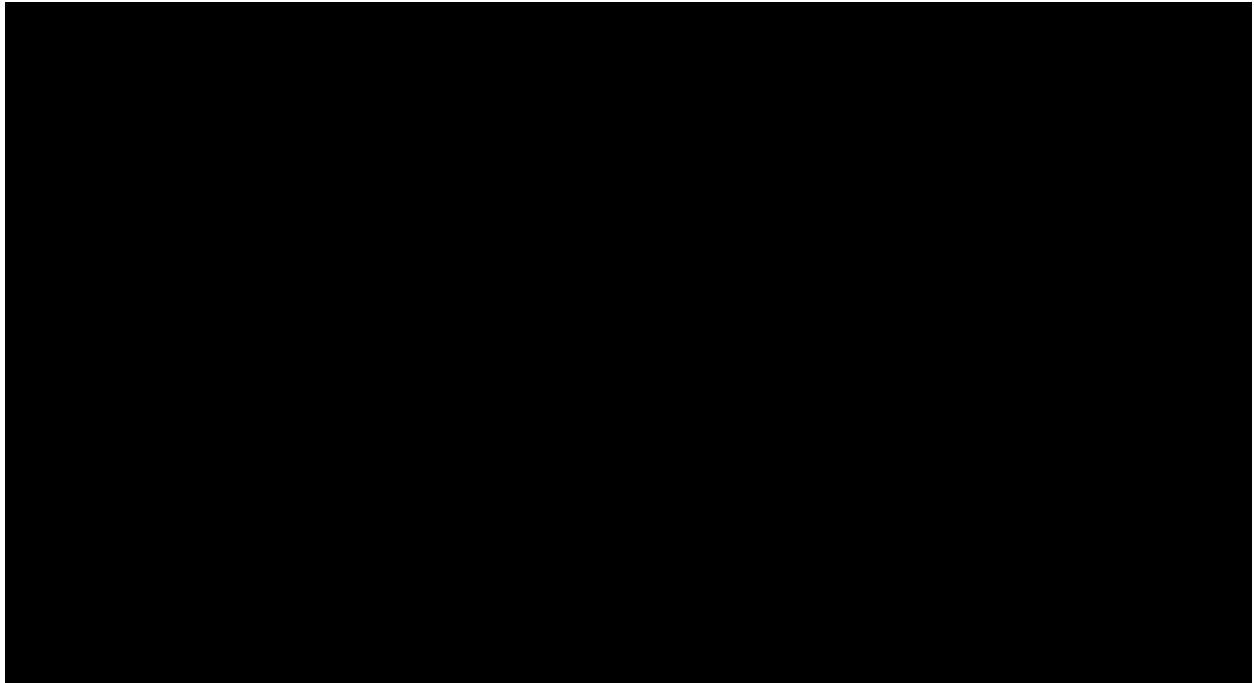
We recommend an extension of criminal sanctions for unregistered designs, which do not currently exist for unregistered design right infringement. We would propose that infringement attracts a sanction similar to other forms of IP infringement and in any event **no less than 6 months and/or a £5,000 fine and a 1-year term of imprisonment on Indictment**

We also recommend at least guidance on a range of statutory damages or provision for a minimum level of statutory damages to protect SMEs investment and costs incurred in registered design protection.

²¹ S. 33(1)(a)(b) substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\), s. 272, Sch. 3 para. 22\(2\)\(4\)](#)

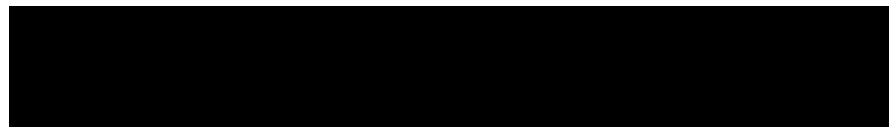
²² <https://www.parliament.uk/globalassets/documents/impact-assessments/IA13-16M.pdf>

SECTION C:



2. Consent. The individuals named above would be agreeable to being contacted by the Intellectual Property Office (UK IPO) in relation to this consultation.

3: Contact details:



ENDNOTES

ⁱ On more than one occasion representatives of [REDACTED] have complained that criminal sanctions for unregistered design right infringement would prevent them from pursuing the favoured business model of some of their members, namely copying the designs of individual designers or at the very least using their designs as a template for making their own designs. Copying of any IP right should not be encouraged. If intentionally copying a two dimensional art work is treated as theft under English law resulting in a possible term of imprisonment of ten years, why should the intentional copying of the artwork transformed into a three-dimensional design not be accorded the same protection? Copying is copying and in such cases theft, pure and simple. [REDACTED]

ⁱⁱ *In other words, Sec. 4 addresses conventional works, such as sculptures and architectural works, whose expression is generally intended to be stable or “fixed”.*

When the dynamic character of a work comes into play, issues tied to the identification of the subject-matter and rationales of fixation appear to be inevitable. Komesaroff vs Mickle concerned a specific category of artistic works in the UK: works of artistic craftsmanship. To



be eligible for copyright protection as a work of artistic craftsmanship, the subject-matter needs to show an element of real artistic or aesthetic quality as well as craftsmanship. In that particular case, the work at stake, named “moving sand picture”, consisted of coloured sands, liquid and a layer of bubbles positioned between two glass panels; when the sands trickled through the bubbles as a result of the action of gravity, mini sand landscapes took shape.

The Court particularly addressed the dynamic character of the subject-matter and stated: “it must be possible to define the work of artistic craftsmanship on which she bases her action, and this can only be done by a reference to a static aspect of what has been referred to by counsel as a work of kinetic art”. 45The court seems to refer to a static feature in order to ascertain the extent to which the work can fall within a given category, and therefore be identified. In that specific case, the static features determine whether a work is to be regarded as a work of artistic craftsmanship. It would thus be arguable that the identification process of a 4D printed object should be held when the work presents static features. This possibility appears to be in line also with the reasoning adopted by the CJEU: by concentrating on the static features of a 4D printed object, it is possible – or at least easier – to identify it “clearly and precisely.”