

Response ID ANON-6TNE-VM6T-A

Submitted to Reviewing the designs framework: Call for views
Submitted on 2022-03-25 10:11:43

Introduction

1 What is your name?

Name:

[REDACTED]

2 What is your organisation?

Organisation:

Reckitt Benckiser Group PLC

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?

An industry body

If you selected other please specify:

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

Other

If you selected other please specify:

Fast moving consumer goods manufacturer

8 How many people does your business employ?

250+

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:

Reckitt would support the introduction of a two-tier registration system where the current registration system is maintained but examination is required prior to enforcement.

This would provide a balance between lower costs associated with applying for design protection whilst ensuring that enforcement actions (Letter before action / issuing UK Court proceedings) are only undertaken on UK Registered Designs that have had their validity tested (novelty and individual character) by the UK IPO relative to prior filed Design Registrations and are in receipt of UK IPO certification of validity (or similar).

Over time e-commerce platforms could be lobbied to modify their take-down policies to only take action in relation to UK Registered Designs that have been examined.

Reckitt would be in favour of an opposition period following publication to afford an opportunity to efficiently and inexpensively remove clearly invalid registrations.

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:

As set out above, Reckitt would support the introduction of a two-tier registration system where the current registration system is maintained but examination is required prior to enforcement. This would provide a balance between lower costs associated with applying for design protection whilst ensuring that enforcement actions (Letter before action / issuing UK Court proceedings) are only undertaken on UK Registered Designs that have had their validity tested (novelty and individual character) by the UK IPO relative to prior filed Design Registrations and are in receipt of UK IPO certification of validity (or similar).

Simplifying the designs system

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

Please add your views here:

Registered design protection works best for Reckitt as it provides a better degree of certainty to us of what our IP rights in a design are and allows us to assess the rights of others clearly and efficiently.

Rarely would we rely on UK Unregistered Design Rights, if we did it is likely because something has "gone wrong" and we failed to adequately protect our rights using the registration 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:

Reckitt is in favour of UK Unregistered Design Right being harmonised with European law, particularly the duration of protection being reduced to 3 years from when the design was first made available to the public.

This arrangement provides ample opportunity to designers whom are unable/unwilling to register their designs to make use of their Rights. This shorter period also provides greater certainty for businesses when considering Freedom to Launch risks.

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:

No comment

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 comment

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 comment

Future technologies

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

Please add your views here:

No comment

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

Please add your views here:

No comment

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:

No comment

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:

Reckitt is in favour of harmonisation but, in practice, considers the 30 month deferment period available to RCDs needlessly lengthy relative to providing certainty for the public. Reckitt pursues corresponding design protection in countries outside of the UK and Europe with shorter publication periods for applications.

Furthermore, as Reckitt is advocating for a two-tier registration system any deferment period needs to be taken into account as part of the examination process.

By way of explanation, if examination were to be requested and the UK IPO identified a prior-filed design application that would deny novelty to the design being examined but the prior-filed design application had deferred its publication the examination could not be concluded until the owner of the prior-filed design application requested publication or failed to request publication prior to the expiry of the deferment period.

Therefore, it is Reckitt's view that suitable balance can be found between the competing tensions of the benefits of deferring publication vs the need to obtain a reliably quick examination of a registered design application if the deferment period was a maximum of 12 months from the filing date of the application.

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

Please add your views here:

Reckitt does not believe that any information should be published in relation to a deferred design.

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

Please add your views here:

Only the provisions outlined above in our response to Qu.20.

Enforcement

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

Please add your views here:

Reckitt is of the view that the UK's enforcement framework works well.

Reckitt would be in favour in expanding the remit of the IPEC Small Claims Track to include registered designs.

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

Please add your views here:

Although not a small business, Reckitt suspects that expanding the remit of the IPEC Small Claims Track to include registered designs would also favour small businesses and individuals.

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

Please add your views here:

Reckitt has no experience to date as a consequence of the introduction of criminal snactions.

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:

Reckitt strongly opposes extending criminal sanctions to unregistered designs.

Reckitt is a fast-moving consumer goods company with quick innovation pipelines andt Reckitt never knowingly copies existing designs when creating its products but always conducts Freedom to Launch investigations prior to launching a product with a new design to ensure there are no unforeseen allegations of infringement of 3rd party-owned IP. By their very nature of not being searchable in a registry of IP rights, unregistered designs are practically impossible to consider during any Freedom to Launch investigations. Therefore, if despite those best efforts criminal sanctions could be imposed as a consequence of an IP right that cannot readily be identified prior to launch is both unjust and punitive. Furthermore, such a move would likely slow design innovation on the basis that the only way to be certain of removing the risk of criminal sanctions would be to delay the launch of any

new design in the UK until after the period of duration of UK Unregistered Design Right – which Reckitt suggests should be 3 years.