

Response ID ANON-6TNE-VM67-D

Submitted to Reviewing the designs framework: Call for views
Submitted on 2022-03-25 13:16:51

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?

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:

as a registered patent and trade mark attorney

8 How many people does your business employ?

0-1

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 think that the Office should abandon any form of examination, simply letting the computer get on with the job of data capture and registration certificate issuance. The registration certificate would not, of course, need to reproduce the design itself since that could be, automatically and immediately, available online, save in the case dealt with later, about deferment.

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

Prior art searching, Use of AI tools, Bad faith and opposition periods, Other

Please provide more detail below:

If the Office could, preferably in collaboration with others who are seeking to do the same thing, introduce an effective and almost certainly AI based "prior design search" or even "prior art search", the latter being obviously very much more challenging, it might be useful as a resource for designers and separately it might be required that such a search be carried out prior to launching infringement proceedings, though if such a search system were

available to anyone, it could well be that the accused alleged infringer would use it to seek invalidity arguments rather than the registrant using it to establish (which of course could not be done with any certainty) validity. I doubt very much that introducing an opposition period would be of any value. It is difficult to see why, at the application stage, anyone would want to go to the trouble and expense of opposing a third party whose application it found for some reason worrying. The other option not outlined is set forth earlier in an email sent to the office

Simplifying the designs system

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

Please add your views here:

This question should have appeared in the consultation paper. Which works best depends on whether one uses any of the systems requiring positive action to be taken. All those who do not must necessarily find that the automatic free systems work best, as they are the only ones which can work at all.

Those who choose to use a registration system may find that works best if it does not need the proof of copying, but may find that the requirement of having to choose just what to register and to illustrate it means that they may finish up with no effective protection at all against an intentional emulator.

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:

- The automatic ways in which the appearance of a product is already protected obviously do not present any issues. All previous attempts to simplify the system have resulted in its being more complex, particularly having regard to the need to maintain existing rights essentially intact.

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:

Very odd that the first part of Question 3 in the consultation paper has disappeared. An error, or did someone decide that the issue was "too difficult"?

If the object of the exercise is to build up a thoroughly comprehensive and useful database of designs, the qualification requirements could usefully be scrapped. As far as the spare parts exemption goes, I do not imagine that there will be any consensus for moving from the current compromise. In terms of clarification of the meanings of terms in the Registered Designs Act, the attempt to clarify may well impact on past judicial decisions, to no great benefit for anyone. I am unaware of any obiter in any design decision from the courts where they have indicated that statutory revision would assist

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:

- I am not aware of any client having experienced any difficulty. Disclosing a design for the first time by way of a website would appear having regard to the nature of the worldwide web itself, to be a case of simultaneous disclosure in every single country of the world, and it is, of course, the easiest way of making a disclosure.

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:

Automatic instant registration by eliminating examination and letting the computer get on with it and eregister and publish would of course provide simultaneous disclosure for anyone who applied before any other disclosure had taken place. It would also have the advantage that it would not in fact be easily findable save by name searching, but if the registration was applied for in a different name from that of the eventual owner, the design could essentially be kept in practice out of the public domain unless someone knew that it was there, findable by a simple name search on the register, if you knew the name.

Future technologies

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

Please add your views here:

- If the current system is not capable of protecting digital designs and 4D printed products, then it should be made very simply clear that that is subject matter that can be protected. The issues of how the design is communicated to the Office are imminently solvable by a sensible online computer system.

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

Please add your views here:

By the sound of the observations in the call for views, some of them are while others might not be, but it will I suspect take an adverse (to the registrant) decision in a contested case before the adequacy of current protection is tested.

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:

- I suspect that removal of the ability to accept physical specimens could be construed as making design protection more easily available, but I suspect that it would have no effect whatever since I also suspect that no one avails themselves of that arguably now wholly outdated possibility. Filing of digital representations should be simple and easy - it just needs good IT.

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

Please add your views here:

Computer generated designs should be protected in the same way as any other sort of design.

Better regulation

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

Please add your views here:

Certain industries wanted it and they got it and they are used to it. It is unclear that there has been any change in circumstances which would reduce that desire. The publication of the registration should be deferred preferably to the precise same deferred period i.e. 30 months as adopted elsewhere, it being possible, however, to be ended by an applicant who wants the actual registration but downstream from filing.

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

Please add your views here:

- If it is deferred, I believe that no data should be published about it at all.

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

Please add your views here:

If one is concerned about potential overlaps, provision exempting use of a design where the later applicant can demonstrate real and effective steps to put his or her later design into practice while an earlier design was kept secret would appear to provide an appropriate and equitable solution.

If registration is, for all cases save those where deferment was requested, automatic and immediate, then there is no "pendency" and thus no "copending" issues.

Enforcement

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

Please add your views here:

The provisions available by the use of the Intellectual Property Enterprise Court are quite effective, when used. What holds businesses, small businesses and individual designers from enforcing their rights through the courts is the cost and management time involved. Most of the time it is simply not worth it. Shaming the alleged infringer via social media may prove far more effective.

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

Please add your views here:

By letting TSOs take a case on, free of any cost to the rights owner, but as a way of reflecting that small businesses and individual designers should not be subject to others infringing their rights.

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

Please add your views here:

None

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:

Extending criminal sanctions to unregistered designs would, I suggest, be wholly unproductive. Because of the different standard of proof required, an aggrieved potential complainant could be induced to spend a great deal of money on a hopeless case or, if the allegation of criminal activity were then to be handed over to the public authorities to prosecute, e.g. via Trading Standards Offices, it is difficult to see that the additional burden placed on them would be useful, but of course the assertion made by an aggrieved originator that his or her design had been copied could be misused by alleging criminal activity when none had in fact taken place.