

## Response ID ANON-6TNE-VMWY-G

Submitted to Reviewing the designs framework: Call for views  
Submitted on 2022-02-16 17:39:21

### 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?

Not Answered

If you selected other please specify:

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:

Although I like the idea of an AI novelty self check system & the idea that a design applicant needs to submit the design to a novelty and/or individual character examination prior to commencing legal action, one of the most significant advantages of the current design system is the speed with which design applications are granted. In most cases, litigation is not forefront in the applicant's mind when applying and the speed with which applications for designs are processed should not be compromised for the few cases where litigation and/or bad faith applications occur.

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

Use of AI tools, Other

Please provide more detail below:

Providing that the speed to grant of designs is not compromised (see above).

## Simplifying the designs system

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

Please add your views here:

For unregistered designs the requirement for residency or first disclosure/marketing in the UK provides some simplification. Without some form of UK acknowledgement of a digital transmission in the UK then this is extremely problematic for non-UK residents.

The regime of applying copyright protection to "works of artistic craftsmanship" i.e. not mass produced seems to be a sensible solution. After all such items clearly fall within a similar remit to the writing of literature, creating sculptures and/or making a painting/artwork.

These principles seem to be sufficient to differentiate between the requirements for registered & unregistered designs.

### 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:

In my experience the different and overlapping ways of protecting the appearance of a product is not something that is problematic to creators. They want their work to be protected somehow and if that is by multiple systems that is fine for the creator. What they don't want is for the system to be oversimplified meaning that their creative works run the risk of "falling through the cracks" and not being protected in any way.

### 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:

This is problematic because many of these terms have been clarified in various legal cases and the risk is that a new "clarification" may actually cause more uncertainty. For example a new "clarification" may remain unclear until it is actually tested in the caselaw.

### 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:

Neither I nor my clients have been required to rely on unregistered designs – so I have no views on this issue.

### 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:

Simultaneous disclosure would address this issue, but is not always available to many smaller design clients. I cannot comment personally on unregistered design rights in the UK and EU, but I do have clients that have resorted to filing Registered Designs in the UK and EU simultaneously using the Hague Agreement. Maybe a similar form of arrangement could be setup for unregistered designs too.

## Future technologies

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

Please add your views here:

A simple request to start: Please could the UKIPO sign up to the DAS system for digital transmission of priority documents for Registered Designs in addition to the PDAS that has been in place for several years for patent applications?

Yes, applicants should be able to submit digital design files enabling designs to be seen in virtual 3D and dynamically. This is particularly important as many designs are now created using computer design and modelling systems.

The restriction to 2D representations are now outdated as are the submission of physical design samples, which are difficult to handle with modern on-line searching tools.

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

Please add your views here:

Personally, the inclusion of 4D printed products seems to raise the possibility/problem of destabilising the current design system with limited benefit. However, this is not an area of my expertise and providing that the relevant safeguards can be put in place, this may be an area where the system can be "future proofed" in a fast moving digital environment.

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:

Already covered in questions 16 & 17.

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

Please add your views here:

Computer generated designs is something that I think it is almost impossible to guard against. Unless the applicant specifically highlights that the design is computer-generated, how would the UKIPO be able to determine this?

However, I don't think that a computer/AI system should be listed as the designer, because there is no method of litigation against such an entity. Rather, the people and/or team of people who devise the computer/AI methodology should be listed as the designers.

## Better regulation

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

Please add your views here:

Personally, I am in favour of aligning the UK deferment period with the Hague design system and that of other offices. However, I think that "basic information" should be made available on filing as suggested, so that third parties operating in the same or similar field are given the chance to monitor future design publications, as suggested above.

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

Please add your views here:

"Basic information" (see answer to question 20) such as filing date and design field.

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

Please add your views here:

Yes, specific provisions for prior use and for dealing with co-pending applications must be included in any future system for clarity amongst both designers and third parties.

## Enforcement

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

Please add your views here:

My clients (both individuals & SMEs) have both encountered and/or are concerned with the costs associated with enforcement, particularly when faced with engagement from much larger companies/organisations having seemingly unlimited financial resources. Therefore, I suggest that cost limits are necessary for such situations.

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

Please add your views here:

A limitation on the size of defence teams for large companies/organisations and the cost limits mentioned in answer to question 23.

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:

In light of the answer to question 25, I don't think that it is worth extending criminal sanctions to unregistered designs.