

Venner Shipley LLP Responses to UKIPO's Call for Views: Reviewing the Designs Framework

QUESTIONS:

A. INTRODUCTION

1. **What is your name?**

2. **What is your organisation?**

Venner Shipley LLP

3. **What is your email address?**

[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

B. RESPONDENT INFORMATION

5. If you are an individual, are you?

- General public
- A Designer
- Design consultant
- An academic
- A legal professional
- A profession in another sector
- Other [*If you have selected other please specify*]

6. If you are responding on behalf of an organisation, are you?

- A design organisation
- An academic institution
- An industrial body
- **Any other type of organisation** [*If you selected other please specify*]
Intellectual Property Firm

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

- Specialist design, e.g. fashion design, industrial design, graphic design
- Clothing and accessories manufacturing
- Footwear manufacturing
- Ceramic products
- Consumer electronics
- Motor vehicle parts and accessories
- Furniture manufacturing
- Jewellery manufacturing
- Games and toys manufacturing
- Software publishing

- Computer programming
- Architecture
- Other [*If you selected other please specify*]: **All of the above**

8. **How many people does your business employ**

- 0-1
- 2-9
- 10-49
- **50-249**
- 250+

C. REGISTERED DESIGNS – SEARCH AND EXAMINATION

In the UK, you can protect a design that “is new and has individual character”. Following changes to the law in 2006, the IPO does not check whether a design meets these requirements before allowing registration. This was done to harmonise practice with the EUIPO. It means that the onus is on applicants to consider novelty and individual character requirements before they apply. Competitors can apply to have a design invalidated if they believe a registered design does not meet these requirements.

Since then, there have been many changes affecting the designs sector. These include increased use of online platforms, a more global marketplace and improved search technology. Further, as rights granted by the EUIPO no longer apply to the UK, there is no longer a need for harmonisation. With this in mind, we seek views on whether the UK should reintroduce novelty searching, as well as a corresponding examination on novelty and individual character.

A search would likely include available registered designs databases and internet searching. Artificial Intelligence (AI) tools could be used to assist the search examiner. In the future, searches could be conducted largely by AI systems. In this case, there would be a range of technical and legal issues to consider.

A pre-application AI tool could also be introduced and could be similar in function to the recently introduced [Trade Mark pre-apply service](#). This would assist applicants in identifying relevant registered designs before filing. It would also help applicants improve their chances of successfully registering a design.

Alternatively, the search could be limited to exact matches only. In this case, the individual character of a design would not be considered. Here, only designs that are identical to an existing design would be objected to.

A further alternative to carrying out novelty searching on all applications would be introduction of a two-tier registration system. Here applications would be filed and examined in accordance with current legal requirements. Then, if the rights holder wanted to enforce their design, they would need to request a full search for novelty and individual character. Enforcement could include any attempt to stop others selling a product on third party e-commerce websites. We are aware that IP Australia has a similar [process for enforcement](#).

Novelty searching would be especially useful in helping identify and prevent anti-competitive registrations. These are registrations where pre-existing designs are deliberately registered and then used to stop the legitimate business activities of the original designer. However, there are other ways in which such applications could be dealt with, for example by introducing a bad faith provision for designs. This would allow the registrar to object to these kinds of filings on that basis. However, it may be difficult to provide evidence that a third party has acted in bad faith which could reduce the usefulness of this provision. We would like your views on the merits, or otherwise, of a bad faith provision.

The effects of anti-competitive applications could also be mitigated through the introduction of an “opposition period”. Here designs would be published before registration, enabling third parties to oppose or comment on a design. Opposition to registration could occur on the [grounds set out in the Registered Designs Act](#). If no objections were raised in this timeframe, the design would be automatically registered at the end of the opposition period.

However, all these changes would increase the registration time and might involve higher application fees. There could also be unforeseen effects on other areas of the registered designs framework.

9. Do you have views on whether the IPO should change examination practice for designs?

- The current UK system allows for the low cost and efficient registration of designs. This is due to the fact that design applications are not searched or substantively examined. We consider that the UKIPO should strive to maintain these advantages of the current system and therefore we are of the opinion that search and substantive examination should not be a requirement for registration. However, the prospect of introducing search and examination of registrations as a prerequisite to enforcement would appear to retain many of the strengths of the current system whilst providing greater certainty to rights holders and third parties (as discussed below), and therefore this potential change should be considered in more detail.
- If the UKIPO does conduct an absolute or relative grounds examination, a design applicant should be afforded the opportunity to respond, within a reasonable period of time, to any objection made. Specifically in relation to any possible ground for refusal based on technical function, it should be considered that the fact that a design includes one or more elements or features that serve a functional purpose should not be a bar to protection of the design unless the overall appearance of the design is solely dictated by its function. If the UKIPO conducts a relative grounds examination, the examination of the designs should include an analysis of actual conditions in which the public will encounter the designs rather than based solely on classification.
- Considering the merits of the issues under this question, one reason to re-introduce examination for novelty and individual character would be if it would reduce the number of counterclaims for invalidity in an infringement context.
- Clearly, no search and examination process is going to guarantee validity of the design, but it would still provide the potential to reduce the instances of enforcement of registered designs that are not new or lack individual character, thereby protecting third parties whilst improving the presumption of validity for the rights holder.
- A mechanism for examining designs would also be useful for preventing abusive and/or anti-competitive designs that are filed with the intention of stopping the original designer from exploiting them. However, the ‘unjustified threats’ regime in the UK already provides some counter-balance against these risks, as asserting an invalid design against a third party may result in liability for making an ‘unjustified threat’.

Another point more broadly related to the UKIPO registration/examination system is that the UKIPO notably is not a participating office of the WIPO DAS system for the exchange of priority documents. Being a registration system, priority is not normally examined unless validity is challenged post-registration or in enforcement proceedings. It is also noted that the UKIPO application system enables applicants to submit a declaration that the design being applied for at the UKIPO is identical to that of the priority application. However, there may often be reasons (e.g. due to specific jurisdictional practices) why the application filed in the UK is not identical to the priority case and so such a declaration cannot be made. In which case, the applicant is still required to file a copy of the priority application (albeit an electronic copy is accepted). In such circumstances, it would be much simpler and more cost-effective for an applicant to indicate a WIPO DAS code on an application instead of providing a certified copy of the priority application.

We propose retaining the ability to file written disclaimers with the design application. This can be particularly beneficial when time and/or cost constraints prevent the preparation of representations specifically for the design application. For example, a written disclaimer allows the applicant to file colour photographs or greyscale CAD drawings whilst indicating that protection is sought for shape alone – without the written disclaimer it would likely be necessary to prepare and file black and white line drawings in order to achieve a comparable scope of protection.

10. We also propose retaining the ability to amend the representations and also file written disclaimers after filing (e.g. to deal with formalities objections) without necessarily having to re-date the application. **Do you think it would be useful to introduce any of the options outlined? (please select all that apply: Prior art searching / Two-tier system / Use of AI tools / Bad Faith and Opposition Periods / Other).**

- Prior art searching
 - Assessment of ‘individual character’ is necessarily a subjective assessment, whereas assessment of novelty is more objective, so examining only for novelty may make examination more straight forward and less contentious. However, we question how useful a design which has only been examined for novelty, and not for individual character is – it is a half-way house which would make examination most costly and time consuming, and there would still be considerable doubt about its validity. In our view, if substantive examination is introduced then it should address both novelty and individual character.
 - One difficulty in searching for prior designs is that, even if a design classification system is adopted, a design in a completely different classification field can still be prior art that may invalidate the design in question. Another difficulty is that the state of the art also encompasses disclosures that are not themselves design registrations (including, for example, product launches, marketing material and internet disclosures) and would therefore not appear in a search of the UKIPO registered design database. Nevertheless, in our view some form of design search and examination could still be beneficial to give greater certainty to rights holders and third parties, and it is noted that similar deficiencies to those noted above are also present in the patent searching and examination

process (which focuses heavily on searching prior published patent applications), and yet this is still deemed worthwhile.

- The advantages of searching and examining design registrations should be balanced against the particular advantages of the current UK registered design system, namely its low cost and the speed of obtaining registered IP rights. Any proposed changes to the current system should consider the impact on these positive aspects. Accordingly, we do not support prior art searching and examination as part of the design registration process, where the current limited examination of the UKIPO works well in practice. We do however consider that introducing the requirement to have a registration searched and examined prior to enforcement could be a useful compromise: retaining the current efficient and low-cost registration system whilst improving the presumption of validity of the design at the point of enforcement and helping to prevent the anti-competitive effects of enforcement of invalid designs.
- One impact of a two-tier system that would need to be carefully considered is what would happen in cases of urgency. For example, would a design right holder be able to apply for an interim injunction on the basis of a registered right, or would the design right holder have to wait until the designs had been substantively examined, at which point an interim injunction may no longer be available?
- The possibility for improvements to prior art searching by third parties is also favoured. It is recognised that this UKIPO question relates to prior art searching in examination by the UKIPO. However, third party prior art searching is commented upon under “other” below (also commented upon under “AI tools” below).
- Use of AI tools
 - In theory, AI tools could be a very efficient way in which to carry out searches; however, as the scope of protection of a design is not limited by the Locarno class which is indicated, the only criteria which could be used to search would be the representations of the design. This could give rise to a large number of results.
 - We suggest making the UK design register more easily searchable, so that applicants could use it to check whether any identical or similar designs have already been registered before filing an application.
- Bad faith and opposition periods

We consider that the ability to cancel designs on the basis that they were filed in bad faith would be a useful addition to the grounds of invalidity. If it were to be introduced, applicants could be required to certify that the design is new and has individual character. If opposition periods were to be introduced, we suggest publishing a periodic gazette of approved design applications.

- Other: Third party searching/Classification of designs

In our view, Industrial Property Offices should provide access to design rights for which publication is not deferred so applicants may search the records, on a free-

of-charge basis. Furthermore, we recommend that, in the interests of international harmonization and also facilitating searching of the designs register, Industrial Property Offices use the Locarno Classification for the classification of goods.

Currently, the UKIPO registered design application system requires the applicant to provide an indication of the product to which the design is to be applied. However, this indication of the product is not standardised because there is no requirement to indicate the product using the Locarno classification system. The UKIPO website does not have a comprehensive search tool enabling third parties to search the UKIPO designs register, unless the design number or applicant is known. Classification-based searching is not possible. The UKIPO only directs users to the DesignView search tool for designs registered in the UK by WIPO/EUIPO. It would be preferred for the UKIPO to provide for more comprehensive and user-friendly searching of the UK design registry. Currently, searching the design registry is generally time consuming and expensive, often involving manually viewing large numbers of designs. Investment in AI tools freely available to users would be very welcome.

D. SIMPLIFYING THE DESIGNS SYSTEM

There are currently four different types of overlapping design protection in the UK. They are:

- registered designs,
- supplementary unregistered design,
- continuing unregistered design and,
- UK unregistered design right (“design right”).

A registered design protects the 2D and 3D appearance of the whole or part of a product resulting from a number of features. These include lines, contours, shape, texture and ornamentation. Protection rewards investment in the creative process and allows the owner of the design to control its use for up to 25 years.

The supplementary unregistered design was created when the UK left the EU. This provided the same scope of protection in the UK as had previously been given by the unregistered Community design. It provides shorter term protection without the burden of registration formalities. This benefits sectors which produce large numbers of designs with a short market life. It protects the 2D and 3D appearance of a product for 3 years from when the product is first disclosed in the UK.

The continuing unregistered designs provides UK protection for products protected in the UK as unregistered Community designs before 1 January 2021. They exist in the UK for what remained of their existing three-year term and are provided for in the Withdrawal Agreement. As we are bound by the Withdrawal Agreement, changes are not being considering to continuing unregistered designs as part of this call for views.

The UK unregistered design right protects the design of the internal or external shape or configuration of the whole or part of an article. It does not protect surface decoration. Protection lasts for the shorter of 15 years from when the design was first made or recorded in a design document, or 10 years from when it was first sold.

In addition to design protection, a product may benefit from copyright protection. This would be the case when the product is considered an original artistic work within copyright law. Copyright in original artistic works lasts for the life of the creator, plus 70 years.

Overlapping rights

Protection of designs in their broadest sense is complex. A product may be protected by a number of different overlapping forms of design protection and copyright.

These different IP rights protect different aspects of a product. They also have different qualification requirements, terms of protection, restricted acts, exceptions, and limitations.

The extent to which copyright protects designs – in particular which designs are considered original “works of artistic craftsmanship” – is not completely clear. When

copyright applies to a design it will be protected for the lifetime of its designer plus 70 years. The scope of copyright protection is also different to designs, and they are subject to different exceptions.

The application of copyright to designs could allow some designs to gain longer protection than was originally envisaged in legislation. Designers may need to consider case law to determine whether their products are protected by copyright, design rights or both. This may not always be easy, particularly for items which are primarily functional rather than aesthetic. While some products will benefit from being eligible for both copyright and design protection, a clearer distinction between them would simplify the system.

The complexity of the system may cause problems to designers who lack legal representation. The lack of clarity about how a product is protected can impact competitors assessing their freedom to operate. We seek views on where the current system inhibits best use of designs. The government is keen to ensure a balanced system which encourages investment in design in a competitive market. Simplification of the system or a reduction in the different types of unregistered rights available may be one way to achieve this.

Differences between unregistered design rights

The creation of the supplementary unregistered design alongside UK unregistered design right means there are two forms of unregistered design protection available in the UK. However, there are areas of inconsistency between these rights. These include spare parts exceptions and qualification requirements. While the supplementary unregistered design does not provide for an exception to designs protection for spare parts, both design right and registered designs do. Similarly, the qualification requirements are different for both the unregistered rights:

- for the supplementary unregistered design, the right exists when a product is first disclosed. There is no residency requirement
- for design right, there's a need to meet a residence qualification

Moving to a disclosure requirement or a residency requirement for both these rights would simplify the system. Similarly, extending the spare parts exemption to supplementary unregistered design supports the right to repair agenda and increases the lifespan of products. This contributes to the government's commitment to achieving net zero by 2050.

However, there may be benefits in retaining differences between these rights. We are keen to hear from users what the pros and cons of harmonising these aspects, or retaining the status quo are. We are also interested in understanding if there are other differences between unregistered designs which need addressing, or provide particular benefits to you.

Definitions

Another area we would like your views on is in relation to certain definitions contained within the Registered Designs Act. For example, the [law sets out that “get-up”](#) is considered a product which can be protected as a design. However, there is no definition of what this term means. This can cause difficulties when examiners consider the validity of an application for the “get-up” of a product. We are seeking your views on what you understand “get-up” to mean and whether it would be helpful for the government to produce guidance in this area.

We are also interested in your views on whether other terms in the Registered Designs Act are unclear and would benefit from clarification or guidance.

Disclosure of supplementary unregistered designs

The UK’s departure from the EU has resulted in changes to the designs landscape. One consequence of this is that a product is now only protected in the territory in which it is first disclosed:

- as a supplementary unregistered design in the UK, or;
- as an unregistered community design in the EU,

The lack of an agreement with the EU to recognise disclosure reciprocally is a cause of concern to some businesses. Businesses which rely on unregistered designs need to choose where to disclose and protect a product.

The government understands that designers would like to be able to obtain unregistered protection in both territories, but the solution is not straightforward. Making the EU - or indeed any country or territory - a qualifying territory for the supplementary unregistered design may not be straightforward. A full assessment of all impacts, both positive and negative, would need to be carried out to determine whether this is a viable option.

It has been suggested that **simultaneous disclosure** may provide a solution. This could be achieved by live-streaming in the territories concerned or disclosure on a digital platform. However, this approach is untested in the courts. There are also unresolved questions about whether any delay in transmission could destroy the novelty of a design. It is also untested as to whether a disclosure in a digital environment constitutes a valid disclosure under supplementary unregistered design legislation. We would need to consider the consequences of allowing a live-streamed disclosure from anywhere in the world giving rise to UK design protection.

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

N/A.

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.

The protection of the appearance of a product in the UK is complex for two reasons. The first is the number of different overlapping designs rights which currently exist, and the second is the overlap between copyright and designs.

Designs

In the UK, there are currently 5 different designs regimes in place in addition to copyright. The design regimes are as follows:

- Registered UK designs
- Re-registered Community designs
- Continuing Community unregistered designs
- UK unregistered design right
- UK supplementary unregistered design right

This array of different types of protection increases the costs of clearing designs, as well as the costs of enforcing designs as each possible type of protection must be considered and the differences between them, particularly the scope of protection, term, and the applicable validity and infringement tests must be considered when choosing which right to rely on.

Some of this complexity will be removed through the passage of time, when all of the Continuing Community unregistered designs expire, the last of which will expire on 31 December 2023, and then when all of the re-registered Community designs expire, the last of which will expire on 31 December 2045 (assuming they are renewed for the maximum 25-year period).

As Registered UK designs, Re-registered Community designs and Continuing Community unregistered designs are all harmonised (subject to the necessary differences between registered and unregistered rights), the real complexity is derived from the existence of two different UK national unregistered design rights.

It is our understanding that the UK is committed to introducing something akin to the UK Supplementary unregistered design right under the terms of the EU UK Trade and Cooperation Agreement. The agreement provides that each party must protect unregistered designs from unauthorised use by third parties where the use results from copying. 'Use' must cover offering for sale, putting on the market, importing or exporting the product.

The UK Supplementary unregistered design right was created by *The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019* which modified the provisions of the Council Regulation (EC) 06/2002 of 12th December 2001 on Community Designs (the "**Community Designs Regulation**"). Accordingly, it largely mirrors the scope of protection of the Community unregistered design right and,

in particular, has a term of 3 years and will only apply to designs which are first disclosed in the UK.

There are a number of differences between UK Supplementary unregistered design right and UK unregistered design right. We suggest exploring the possibility of merging the two different unregistered design rights, retaining the most advantageous features of each:

- Term: UK Supplementary unregistered design right has a term of 3 years, whereas UK unregistered design right has a term of up to 15 years, with a 'licence of right' being available in the final 5 years. A term of 3 years is not always sufficient to enable action to be taken against infringers, as sometimes it takes more than three years for a product to become sufficiently commercially successful for it to attract imitators. Further, where the design that is copied is an iteration of any earlier design, it may be necessary to enforce the design rights in the first version of a design, which may have expired by the time the later iteration of a design is copied. On the other hand, the impact of increasing the term of protection of the Supplementary unregistered design right should be very carefully considered. Of particular concern, is any unintended consequences on areas of industry that do not generally attract protection via the UK unregistered design right. For example, surface decoration and two-dimensional designs are ineligible for UK unregistered design right protection (which is limited to shape) and therefore currently only attract design protection for 3 years via the UK Supplementary unregistered design right – substantially increasing this term of protection may significantly impact such industries.
- Scope of protection: UK Supplementary unregistered design right protects the overall appearance of a product (including surface ornamentation and two-dimensional designs) whereas UK unregistered design right protects the shape of a product. Both types of protection can be extremely useful when it comes to enforcement, and so it would be desirable for both the overall appearance and the shape of a design to continue to be protected by unregistered design rights in the UK.
- Infringement test: UK Supplementary unregistered design right is infringed by the unauthorised use of a design or a design which does not produce a different overall impression. UK unregistered design right is infringed by the making of an article exactly or substantially to the design for commercial purposes. Assessing whether an article has been made 'substantially to a design' is difficult as it is not clear what criteria should be used to assess whether something has been made substantially to a design. The test of 'overall impression' makes it clear that the focus is on the appearance of the design, which is preferable.
- Validity test: The test for validity also differs. UK Supplementary unregistered design right must be 'novel' and have 'individual character' over prior designs in order to be valid. A registered design has individual character if it produces a different overall impression than prior designs. In contrast, UK unregistered design right subsists in designs that are 'original', which means that the design was not commonplace in the design field in question at the time of creation. As with the infringement tests discussed above, the practical effects of the different tests for assessing validity should be considered.
- Qualification / first disclosure: It is the UK government's interpretation that UK Supplementary unregistered design right will only arise where the design is first

disclosed in the UK. UKUDR will only arise if the design is a 'qualifying' design. The 'disclosure' requirement is discussed below. The qualification criteria for UKUDR are very complex, and require a detailed factual investigation into the circumstances of creation and first marketing which increases the costs and complexity of enforcing UKUDR. On the one hand, we question whether the qualification criteria as a feature of intellectual property regimes in general actually serves any useful purpose, when ultimately the goal should be providing a high-quality enforcement environment that fosters innovation. On the other hand, care should be taken to ensure that any changes to the UK qualification criteria should not put UK designers at a disadvantage if reciprocal protection is not available in other jurisdictions (e.g. if other jurisdictions operate a closed system and have their own set of qualifying criteria).

13. Are there terms in the Registered Designs Act which would benefit from clarification or guidance e.g. "get up"?

We consider that there is no need to introduce a definition of "get-up" in design law. If a definition is required, it should include certain aspects usually covered under the concept of "trade dress", such as the appearance of a product and its packaging, or the "look and feel" of a design concept. If the intention is to provide protection for a different concept, and notably designs of the interior/exterior of certain spaces such as shops, restaurants, etc, then we suggest a different term is added (preferably not having to be defined), whilst retaining the undefined term 'get-up'. We believe that it is a prerequisite to the drafting of a wording for a legal definition of "get-up" to first obtain sufficient clarity on the intended subject matter of protection.

It would be worthwhile defining the scope of the provision that excludes the protection of component parts of complex products which are not visible in normal use. There is some debate as to what exactly is excluded from protection. For example, is the provision intended to only exclude spare parts of complex machinery (e.g. automobiles - which was the reason that the exclusion was originally conceived) or should the exclusion be interpreted more broadly to also cover spare parts of other types of products or even consumables. For example, why would this provision potentially exclude protection of, e.g. vehicle spark plugs, but allow for the protection of, e.g. printer cartridges. We would welcome clarity on the extent of the exclusion.

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).

Prior to the UK leaving the EU, the position under EU law was thought to be (based on a number of decisions of the German national courts) that a design had to be first disclosed in the EU in order to be protected by Community unregistered design right. However, the position had never been tested by the CJEU and many UK commentators thought that the location of first disclosure should not affect the availability of Community unregistered design right.

When the UK created the Supplementary UK unregistered design right, having failed to agree with the EU to the reciprocal protection of Community unregistered designs and Supplementary UK unregistered designs, the UK provided that only designs which were first disclosed in the UK could be protected by Supplementary UK unregistered

designs. This approach promotes a patch-work of design protection, and introduces a trap for the unwary – if a design is first disclosed in the EU then the Supplementary UK unregistered design right is not available. This means that the designer would need to file a registered design within the first 12 months of the disclosure or otherwise rely on the UK unregistered design right (which has different provisions for assessing validity and infringement compared to the other design regimes and, for example, does not protect surface decoration and two-dimensional designs). The same applies in reverse where a design is first disclosed in the UK. The wording of the Trade and Cooperation Agreement does not help clarify this, since it requires the parties to provide for unregistered protection for a period of 3 years in their own jurisdiction – what happens if it had already been disclosed in the other beforehand? All of this gives rise to uncertainty for users, of both the UK and EU designs systems.

The system is currently complex. Removing the need for a design to be first disclosed in the UK to obtain Supplementary UK unregistered design protection would boost the protection available to designers who could then first disclose in the EU, or anywhere else in the world, and still obtain protection in the UK. However, in our view the most preferable solution would be for an agreement to be adopted bilaterally between the UK and EU so that UK designers could also first market their designs in the UK and still be eligible for Community unregistered design protection. Such reciprocal protection between the UK and EU would help to maintain balance and fairness. Otherwise, we would be concerned that an EU-based designer would have the opportunity to launch a product in its own territory and still be eligible for UK design protection, whilst the reverse would not be possible for UK-based designers.

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.

In theory, simultaneous disclosure could offer a solution to the issue identified above that it is apparently not possible for a designer to obtain both Community unregistered design right protection and Supplementary UK unregistered design protection, and it would be useful if this were to be clarified in legislation as it would remove an element of uncertainty when it came to enforcing designs.

It is unclear whether permitting simultaneous disclosure would require some nexus with the UK, such as disclosure on a website or via a live stream which was specifically targeted at the UK, or if disclosure on a global platform which is merely accessible from the UK would be sufficient. This should also be clarified.

A question also arises as to how ‘simultaneous’ a ‘simultaneous disclosure’ would have to be, especially in the light of potential technical issues such as transmission delays etc. A possible solution could be to introduce a legal fiction which would deem a disclosure to be simultaneous if it were to be made within 24 hours or similar. However, the impact of any such legislative clarification on the grace period would have to be addressed.

It would also be necessary to assess the specific impact on smaller entities, who may be more likely to rely solely on the unregistered design regimes (for example, due to cost constraints that may have prevented the filing for registered design protection) but may not be aware of the mooted simultaneous disclosure requirements or may not have access to the technical means to disclose in multiple jurisdictions simultaneously.

As set out above, another solution would be to remove altogether the requirement for a design to be first disclosed in the UK in order to obtain Supplementary UK unregistered design protection. However, in our view this should not be undertaken unilaterally without first seriously considering the consequences on UK industry.

E. FUTURE TECHNOLOGIES

The government is also keen to future proof the designs framework, ensuring the UK remains a world leading IP environment. Emerging and future technologies might affect how designs are created and used, particularly in digital environments. A future designs system must be flexible in the face of these technological developments and not exclude specific technologies. We seek views on areas where the current system could better meet the needs of a digital environment and future technologies.

Artificial intelligence, digital and dynamic designs

Advancement in technology is increasingly driving innovation in the designs sector. There are a number of areas where new technology is having an impact, including:

- the increasing use of AI tools to create designs;
- the development of dynamic designs;
- use of designs in a digital environment, including avatar content in online gaming and graphical user interfaces for mobile devices

We want to ensure that the designs framework encourages the development and use of AI tools for designers. We are also keen to ensure we have the correct balance of protection between human created designs and computer-generated designs. There are specific legal provisions on who is considered the creator of a design generated by a computer. This is the case for both registered designs and UK unregistered design rights. However, the supplementary unregistered design does not have such a provision. We want to hear from users of the system about whether there are benefits in continuing to protect computer generated designs. Alternatively, should the supplementary unregistered design be extended to protect computer generated designs. We also seek views on whether the current framework is considered fit for purpose.

A recent application of 3D printing is to make 4D printed products. This involves printing a three-dimensional object, which can then transform into different shapes. The transformation is in response to environmental stimuli. Such a time-dependent shape change after printing is referred to as the 4th dimension. The IPO has published guidance on the [protection of transformable designs](#). In most cases, 4D printed products could be protectable as a transformable design. We are interested in whether you consider some 4D printed products would be excluded from protection.

Another area where legislation may not meet the needs of an increasing digital environment is that of designs representations. This is because the IPO only accepts 2D representations of a design as part of the application process. This can cause issues for dynamic or animated digital content and graphical user interfaces (GUIs). For these kinds of designs, applicants need to provide a series of snapshots representing the animated sequence for which protection is sought. We are seeking views on whether applicants should be able to submit digital files enabling designs to be seen in virtual 3D and dynamically.

We would also like your views whether, in an era of increasing digital content, the ability to file a physical specimen is still relevant. Would there be any problems if we ended the ability to file physical specimens?

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

We believe that UKIPO should ensure the registration system remains fit for purpose for receiving and registering digital designs of varying formats as technologies progress in the future. This includes ensuring the application system accepts representations of varying formats (discussed re: 3D digital/video files below).

We recognise the commercial importance of graphical user interfaces (GUIs), icons, fonts and animations, as well as projected, holographic and/or virtual/augmented reality (PHVAR) designs, and accordingly recommends that these be capable of registration in and of themselves without requiring them to be placed on a physical article. Similarly, we recognise the commercial importance of interior designs, whether real or virtual, and considers that they should also be capable of registration in and of themselves.

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

The current requirement to represent a design using a maximum of 12 views of a design (when filing digitally) does not adequately cater for designs with a complex shape or surface decoration, dynamic designs (i.e. designs which include an element of movement) or designs which have multiple positions such as open or closed. It should be possible to file as many representations as may reasonably be required to fully disclose the design.

We suggest broadening the scope of formats accepted by the UKIPO for representation of digital designs, and by reviewing and remaining flexible new/alternative representation formats to ensure the design registration system keeps pace with developments in digital design technology.

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.

We welcome the possibility of filing dynamic views (e.g. 3D digital representations and video files) as an optional representation tool. Search tools and databases should be updated accordingly to reflect these kinds of representations and make them searchable. We do not encourage the use of specimens.

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

We acknowledge that Section 2(4) Registered Designs Act 1949 and Section 214(2) Copyright, Designs and Patents Act 1988 specifically provide that the person who makes the arrangements for the creation of computer-generated designs shall be taken to be the author / designer and therefore the first owner of registered designs and UK unregistered designs, respectively.

In our view, the provisions which provide that the person who makes the arrangements for the creation of a computer-generated design will be the author/designer are sufficient to address the situation where AI is used to assist in the process of creating a design.

F. BETTER REGULATION

There are number of areas where changes could improve the designs framework for users. We seek views on whether there are any other areas that would benefit from improvement.

Deferment provision for designs

Deferment of designs was introduced in 2006 to give applicants flexibility in respect of publication and reduce the risk of a design being copied before it is marketed. Currently an applicant may defer publication of their design for up to 12 months. If it is not published within the set timescale it is deemed to be abandoned. This provision is used to allow applicants to defer their application. This gives them the earliest possible filing date whilst maintaining the confidentiality of the design. We are seeking views on whether we should introduce a specific deferment provision, and whether this would improve legal clarity.

The deferment period is currently capped at 12 months, and we seek your views on whether this is adequate or whether it should be altered. For example, an 18 month deferment would align publication for businesses seeking to obtain both design and patent protection for a product. Alternatively, a 30 month deferment period would align the UK with Hague design systems and other international offices. However, it may be that the deferment period should be reduced. We may also need to consider if specific provisions for prior use rights or to deal with co-pending applications might need to be introduced. This would be particularly important if a longer deferment period and novelty searching was introduced.

The UK currently defers both publication and registration of a design application, and no information is published until the deferment period ends. This differs from some other international design systems, where basic information is made available at filing. Parties operating in the same field are then aware that they should monitor future design publications.

The government is seeking views on how well deferment of designs works in the UK.

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

In our view, it should be possible to defer publication of a design application for a period not less than 12 months after the date of application. The permitted deferment period should be up to 30 months after the date of application. The existence of varying grace periods (or none) in different jurisdictions requires provisions allowing secrecy of a design, for at least 12 months (many jurisdictions already provide in excess of this). The applicant may be required to pay a fee for deferment of publication along with the application.

Deferment periods are useful to enable designers to obtain a filing date and thereby preserve the novelty of a design and other intellectual property rights whilst giving the designer a period of time in which to further develop and refine the design. If necessary, such as where a design changes significantly during the development

process, deferred designs can be allowed to lapse and further designs filed without destroying the novelty of those later filed designs.

The differences between the lengths of deferment periods in different territories introduces unnecessary complexity into design filing programs, as the order in which designs are filed will be crucial to when they are first disclosed and therefore novelty is destroyed. Ideally, the length of deferment periods would be harmonised.

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

Publishing the basic details of a design serves to put third parties on notice that a design has been filed, even though they cannot see the content of the design. This is not particularly useful, as the scope of a design is determined by reference to the representations, but it would at least enable third parties to look out for publication. If design right holders are permitted to enforce deferred designs, it would be useful for them to be able to point to a register entry.

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

N/A

G. ENFORCEMENT

The UK has one of the best intellectual property regimes in the world. Nonetheless, we are aware that the cost of enforcing rights could be a barrier to enforcement, especially for individuals and SMEs. This is because they lack the resources to take a case of alleged infringement to court. This barrier may also be a factor for designers wanting to defend an allegation of infringement.

We are therefore seeking your views on the issues and barriers designers face when enforcing their rights and how enforcement can be made easier. We are interested in receiving evidence of the experiences small businesses and individual designers have had when enforcing their rights.

The [Intellectual Property Act 2014](#) introduced criminal sanctions for the intentional infringement of a registered design. The impact assessment prepared for this measure considered whether copying of unregistered designs should be criminalised. It concluded that to do so would be too complex due to the difficulty in determining which unregistered rights exist and who owns them. To encourage the registration of designs, criminal provisions were only introduced for those which were registered. The IPO also reduced filing fees for multiple applications to further incentivise registration.

In 2020 the government reviewed the impact of the availability of criminal sanctions for registered designs. The evidence showed that only a small number of criminal cases had been brought since 2014. Current government policy is that there is insufficient evidence to support the introduction of criminal penalties for unregistered design infringement. However, we are aware there a range of views on this issue, and we are open to hearing those views as part of this exercise. Introduction of any new criminal offences in future would need to be carefully considered, and based on detailed and robust evidence.

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

We considers the UK's enforcement framework, as it applies to designs, to be very effective. The UK's enforcement framework consists of a number of different fora and bodies, including: (i) trading standards; (ii) PIPCU; (iii) Intellectual Property Enterprise Court (**IPEC**), which is specifically designed for use by small and medium sized enterprises; (iv) Shorter Trials Scheme of the High Court; and (v) the general list of the High Court. The number of options means that proprietors can pick and choose how they enforce their design rights according to the nature of the parties and the nature and scale of the infringement in question.

One anomaly is the fact that it is only possible to bring claims relating to unregistered designs before the small claims track of the IPEC; it is not possible to bring claims relating to registered designs. As both registered and unregistered designs are unexamined rights, and therefore the validity of both types of right is likely to be tested, it is not clear why this distinction has been drawn. This is one area which could be reconsidered by the UK government.

The Courts have given significant guidance encouraging parties to conduct cases concerning registered and unregistered designs in a streamlined and cost-efficient manner. In particular, the Courts have given guidance to the effect that it should be possible to decide registered design cases in a few hours, and that evidence from the

designer about his or her subject intention is irrelevant, and evidence from experts is unlikely to be of assistance. Whilst it has not always been the case that trials have taken no more than a matter of hours, it certainly is possible as a recent trial in the IPEC concerning a claim for infringement of two registered designs was conducted in a little over an hour.

Ultimately, however, it should be recognised that the costs of the enforcement process are significant, particularly when compared to similar jurisdictions. As mentioned above, IPEC has assisted in making enforcement of unregistered designs more accessible, however, significant cost barriers remain.

This guidance helps to ensure that even those design cases that take place in the High Court, which has the most onerous procedural rules of the options outlined above, are run in a relatively streamlined way, with limited disclosure and without the need for a large number of witnesses.

A full range of preliminary and final relief is available to the proprietors of designs who successfully bring infringement actions before the UK courts, including: injunctions, damages inquiries / accounts of profit, orders for delivery up / destruction, declarations of infringement, publication and dissemination of judgments, and recovery of legal costs.

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

- We would welcome a reduction in the official fees with respect to the publication of designs previously deferred (£40 per design) where there are multiple filings made together - there are currently no reductions for multiple filings (as opposed to official fees for filing multiple design applications).
- Among the ways to help small businesses and individuals enforce their rights, we favour Alternative Dispute Resolution (ADR) services, provided that the ADR service is not offered within IP Offices. ADR services should fall outside the scope of IP Offices. This is essential to ensure the full independence of the ADR Service.
- Any mediation service, like the one currently offered by UKIPO for the resolution of disputes, including questions of infringement, should be kept independent from UKIPO.
- The UK could consider introducing an opinion service as the one under section 28A of the Registered Designs Act 1949. Section 28A provides for the UKIPO to provide an opinion service where it would give a non-binding opinion on questions of validity and/or infringement. The introduction of this service would assist parties to evaluate the strength of their claims or defences to enable the parties to settle the dispute without the need to incur the costs and time associated with contested legal proceedings. In our view, if introduced, the opinion service should not be offered within UKIPO and it should be independent from UKIPO.

Finally, the small claims track of the IPEC offers a very low-cost way to enforce unregistered designs. See our comments above as regards whether claims relating to registered designs should also fall within the ambit of the small claims track.

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

We do not have sufficient information as to the impact of the introduction of criminal sanctions for registered designs to draw clear conclusions. The publication of data and tracking of design infringement activity over time would help assess the effectiveness of the sanctions.

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

Although it is unlikely that criminal sanctions will be applied in a majority of cases involving unregistered designs, we see no justification for unregistered designs to be treated differently to registered designs for the purposes of criminal enforcement. While there are additional evidential issues in the assessment of infringement for unregistered designs, where the requirements for a criminal liability are established, the option for criminal action should be considered. This may have a deterrent effect on infringement and would likely lead to an increased awareness of the unregistered design system.