

## Response ID ANON-6TNE-VMC8-U

Submitted to Reviewing the designs framework: Call for views  
Submitted on 2022-03-22 15:48:10

### 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:

Creative industries, including product design.

8 How many people does your business employ?

Not Answered

### 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:

The current arrangements for obtaining registered design protection are satisfactory and should not be altered to introduce any form of formal examination or opposition procedure on the grounds of novelty (which might be termed absolute grounds for refusal) or individual character (which might be termed relative grounds for refusal). To do so would alter the basis for design protection and make the process time-consuming and expensive.

Design law is akin to copyright law, which explains the existence of unregistered, automatic, forms of design right such as the Supplementary Unregistered Design Right and unregistered UK design right which reward creativity and prize aesthetic or functional, useful creations. To introduce a detailed examination stage into the design registration process would change the basis of design protection to one more akin to the patent system.

Design is a vitally important industry both culturally and economically within the UK and anything which makes design protection more difficult to obtain will result in fewer design applications and a stifling of creativity – precisely the opposite of what the registered design system set out to achieve.

My experience of using the US system of design patents shows that a system based on examination would result in time-consuming and expensive applications to protect designs. I regularly advise small and medium-sized enterprises (some of them micro businesses) on design protection issues, whether in response to design infringement or as a means of deterring infringement. I am confident, based on my experience with design businesses who have filed US design patents, that the vast majority of small design businesses would not file design registration applications if they were as time-consuming and expensive as the US design patent system. Registered design protection would become the preserve of larger design businesses with sufficient resources to file applications.

Furthermore, there is a defence for third parties who wish to challenge the validity of registered designs. They can apply to the UKIPO to invalidate registered designs or raise invalidity as a counterclaim in infringement proceedings.

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

Please provide more detail below:

## Simplifying the designs system

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

Please add your views here:

The ability to claim under either or both of the UK design right and the SUDR is very useful in helping my design clients to try to obtain redress for what are plainly copies of their designs. Among my clients, it seems to be only larger SMEs and upwards who take advantage of the registered design system because of the expense of registering designs for a series of products and/or in the EU as well as the UK. These designers often do business in the EU and that has not changed as a result of Brexit, but they have lost their unregistered design rights in the EU for designs first disclosed in the UK. Also, many designers do not produce only one design at a time. They frequently produce a whole range of product designs, all of which they want to protect. The UK fees for registering designs are not high, but the costs in the EU are significantly higher, which has a real impact on many design businesses.

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:

As pointed out in the Call for Views, the design sector contributes over £80bn to UK GDP and creates thousands of jobs, yet the design sector has not been granted equal protection for its output to the protection accorded to other creative industries such as literature, music and film and television.

Legal protection for product designs was removed from copyright law in 1988, principally in order to prevent original equipment manufacturers from using copyright law to shut down competition in the spare parts market. Section 51 of the Copyright, Designs & Patents Act ("CDPA") prevents copyright from being enforced in a design document for a design which is the subject of UK unregistered design right ("design right") protection, also contained within the CDPA. Instead, purely functional designs like spare parts are protected by design right, which is short-lived by comparison with copyright and contains exclusions from protection which are designed to avoid monopolies being created in technically necessary features of products (such as the designs of interface and "must match" features). Design right also affords protection only to the shape and configuration of an article. Unless a design is for surface decoration or can be described as a sculpture or the notoriously uncertain category of work known as a "work of artistic craftsmanship", there is no protection available in design right or copyright law for other aspects of designs, such as their ornamentation, texture or materials. Such aspects of designs are dealt with by entirely separate legislation which is derived from EU law, which we turn to below.

Further, design right is not a monopoly. It achieves a balance between the rights of the owner and the alleged infringer by providing an innocent infringement defence, with a consequent limitation on the remedies available. A compulsory licensing provision in the form of the "licence of right" is also available in the second five years of the term for commercially exploited designs, which is ideally suited to the spare parts industry.

UK design is about much more than producing spare parts and other, purely functional designs. It is also about producing aesthetically pleasing products and products which combine form with function. UK law has retained, in the form of a national right, the unregistered Community design right, which protects any aspect of a design which the creator considers to form part of the design. This right is now known as the Supplementary Unregistered Design Right ("SUDR") in the UK. However, this right only lasts for three years from the disclosure of the design. Whilst it might be suitable for protecting ephemeral designs such as fashion articles, designers are forced to register their designs to obtain longer term protection, up to 25 years, for aspects of their designs other than shape and configuration (unless they are able to claim copyright protection).

The 25-year maximum term of protection of a registered design equates the term of protection to the protection previously given to industrially exploited artistic works under the now repealed limitation contained in section 52 of the CDPA. The repeal of section 52 brought many designs back into copyright protection and enabled the owners of works which were protected by copyright at the time they were created, such as the "Eames" chair, to enforce their rights once again. However, there is no equivalent form of unregistered protection for designs which are not protected by copyright. The Eames chair, if created today, would only be protected (without design registration) for a maximum of 10 years by design right once commercially exploited and a licence of right would be available in the second five years, yet designs of this calibre have longevity, being both desirable to consumers and an attractive proposition to manufacturers of replicas and look-alike products.

The obvious question which needs to be considered, therefore, is why creators of good product designs are not given the same level of protection as creators of copyright works. It devalues the contribution which the UK design industry makes to UK productivity and growth. Continental European jurisprudence is now challenging the assumption that three-dimensional articles which combine form with function are not protected by copyright (see, for example, the Cofemel and Brompton Bicycle cases and the IPEC's application of Cofemel in *Response Clothing v The Edinburgh Woollen Mill*).

Design law would therefore benefit from reform in order to increase the protection available to designers. Reform need not interfere with the need to ensure that designs of spare parts receive limited protection in order to avoid undesirable monopolies. Such designs are adequately protected by design right. In some respects, design law bridges a difficult gap between copyright and patent law, trying to protect designs which have both form and function. One way of achieving reform which does not upset this difficult balance or interfere with the current structure and which, at the same time, gives greater recognition to the value of design is to extend the term of protection under the SUDR.

Under the SUDR, a designer can claim protection for any aspect of a design which meets the requirements of being novel and having individual character (which is a more stringent subsistence test than the subsistence test for design right). A design may therefore be protected only for its shape and configuration or for its shape combined with other elements, such as colour or texture (Article 3 of the Community Designs Regulation (Council Regulation (EC) No 6/2002) ("CDR") defines a "design" as "the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation").

The SUDR, like design right, already contains important exclusions to prevent undesirable monopolies, namely the technical function and "must fit" exclusions in Articles 8(1) and 8(2), respectively. Article 8 CDR provides two exceptions which relate to spare parts. The substance of Article 8 has not been modified by The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Article 8 CDR states:

"Designs dictated by their technical function and designs of interconnections

1. A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.
2. A Community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function."

Article 8(2) is very similar to the spare parts exception in design right. There is no equivalent to Article 8(1) in design right.

Additionally, the SUDR contains the requirement that the design of a component part of a "complex product" must remain visible in everyday use of that product (Article 4). That requirement importantly excludes designs for non-visible spare parts from protection by the SUDR. Article 4 of the CDR states: "Requirements for protection

1. A design shall be protected by a Community design to the extent that it is new and has individual character.
2. A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:
  - (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and
  - (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.
3. "Normal use" within the meaning of paragraph (2)(a) shall mean use by the end user, excluding maintenance, servicing or repair work).

Accordingly, the statement in the Call for Views under Differences between unregistered design rights, "While the supplementary unregistered design does not provide for an exception to designs protection for spare parts, both design right and registered designs do", is incorrect.

If a product design is worthy of protecting because it meets the requirements of novelty and individual character and it is not excluded by one of the exclusions, it is, arguably, deserving of equal protection to a drawing, a piece of music, a book and so on.

Competition would not be stifled by increasing the term of protection for designs; on the contrary, it would be encouraged and new and better designs would be created as a result. It would also be a good way to reward innovation and demonstrate that the UK values the contribution of design to the UK economy.

The question has been asked whether UK design law is too complicated. It is certainly complex, but it has to deal with competing considerations and, as previously mentioned, achieve a balance between form and function which copyright law does not. A wholesale reform which dealt with all of these issues would be time-consuming and expensive and it would not necessarily result in a law which was less complex. Copyright and trade mark law, after all, are not simple. The danger of trying to simplify design law is that the protection it provides to the design industry becomes correspondingly weaker, thereby encouraging copying which is detrimental to the design industry as a whole.

There are also benefits to keeping the current structure, as has been demonstrated by case-law. In *Kohler Mira v Bristan*, the Claimant was unsuccessful in its claim of registered design infringement owing to the differences in the overall impression created by the designs in issue, but successful on its design right infringement claims because the Court was satisfied that copying had taken place in relation to the shape and configuration of the Claimant's designs.

Many designers are small businesses who cannot afford to engage a specialist design lawyer to advise them on protecting their designs by registration and frequently register designs themselves. By doing so, they risk prejudicing their rights if they do not represent their designs in the most favourable way possible (the "Trunki" litigation is a good example of this). It is also impossible to anticipate every conceivable infringement when deciding how to represent a design for registration purposes. As demonstrated by *Kohler Mira v Bristan*, design right provides important fall-back protection where a registered design cannot assist, allowing as it does a Claimant to specify the aspects of shape and configuration of a design which it claims have been copied.

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:

The definition of "design" in Article 3(a) of Council Regulation (EC) No 6/2002 by reference to "the appearance of the whole or a part of a product" arguably denies protection to certain design features of a product which are intended to have aesthetic appeal to the user in the course of normal use. For example, there have been arguments about whether the internal aspects of a chocolate-filled cookie should be protected (*Biscuits Poult SAS v OHIM – Banketbakkerij Merba (Biscuit)* (T-494/12) 9 September 2014) where the design aspects in question were clearly part of the aesthetic appeal of the design intended by the designer.

The definition of “product” by reference to an “industrial or handicraft item” in Article 3(b) of Council Regulation (EC) No 6/2002 is very broad and open to interpretation: “‘product’ means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs”.

In many cases, there will be no difficulty in saying whether an article is an “industrial or handicraft item”, but in other cases, the borderline will not be clear. For example, it is unclear whether the Directive was intended to cover a building or structure. Contrast symbols and typefaces which are expressly included in the definition of “product”. They are not necessarily physical articles (when appearing on computer screens, for example) and it seems anomalous to define them as “products”.

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:

It is too early to say how big the impact of these changes will be on the design industry as a whole. In my experience, design businesses who can afford to pay for design registration both in the UK and the EU are doing so in order to avoid losing unregistered design protection in the EU.

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:

It is difficult to see how, logistically, simultaneous disclosure could be achieved. Even with Internet technology, time delays are a known issue. What would be required is clarity around whether simultaneous means literally at the same moment in time or whether it would suffice to disclose a design in the UK and the EU on the same day in order to achieve protection under both the Supplementary Unregistered Design Right and unregistered Community design right systems. After all, the filing of a registered design application in two jurisdictions on the same date would be considered to be done at the same time for the purposes of receiving a filing date or meeting the requirement of novelty.

## Future technologies

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

Please add your views here:

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

Please add your views here:

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:

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

Please add your views here:

## Better regulation

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

Please add your views here:

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

Please add your views here:

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

Please add your views here:

## Enforcement

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

Please add your views here:

Please see answer to question 24.

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

Please add your views here:

Litigation is expensive and the luxury of the few, but this is the case whether litigating over IP rights or another dispute, such as a dispute about contractual rights. Even registered design infringement claims, which involve less evidence, are expensive propositions. The solution for the design industry, which comprises many micro businesses and SMEs, is to increase the deterrent factor created by unregistered design rights (on which many designers rely) by increasing the term of protection under the SUDR and by making deliberate copying of an unregistered design an unattractive proposition through criminal sanctions. This would result in less need for litigation. Copyright and registered design law contain criminal provisions for deliberate infringement and this should be extended to cover the deliberate copying of an unregistered design, whether it is protected by UK design right or the SUDR. Safeguards are already established within the criminal prosecution mechanism which would prevent abuse.

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

Please add your views here:

None at all. Most of my clients rely on unregistered designs and I have found that in registered design claims a settlement of the dispute has been easier to achieve because of the lack of arguments about innocent infringement which are raised by so many alleged infringers in unregistered design claims.

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:

Please see answer to question 24.