

## Response ID ANON-6TNE-VM63-9

Submitted to Reviewing the designs framework: Call for views  
Submitted on 2022-03-23 19:09:05

### Introduction

1 What is your name?

Name:

[REDACTED]

2 What is your organisation?

Organisation:

Marks & Clerk LLP

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?

Any other type of organisation

If you selected other please specify:

Patent Attorney firm

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

Other

If you selected other please specify:

IP services

8 How many people does your business employ?

250+

### Registered designs - search and examination

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

Please add your views here:

No changes needed. The fast procedure is a very attractive aspect of UK registered designs for most of our clients. However, the ability to use DAS (PDAS) codes in place of certified copies of priority documents would be widely appreciated.

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

Other

Please provide more detail below:

A pre-application AI tool could be useful for applicants.

## Simplifying the designs system

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

Please add your views here:

Our clients are happy with the extensive options available to them.

### 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:

Simplification if not reducing the scope of protection would make our client's understand the system better, but such changes at the expense of a reduced scope of protection would not be desirable.

### 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:

Greater clarity on animated designs or image sequences would be helpful, especially if it allowed more complex GUIs to be covered, including ones that can be interacted with, rather than just fixed-sequences.

### 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:

Determining where or how to make the first disclosure is now overly complex - with no clarity on where or how to make the disclosure for maximising global protection.

### 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:

Online disclosures should be considered a simultaneous disclosure everywhere.

## Future technologies

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

Please add your views here:

There is an immediate disadvantage associated with the uncertainty of design protection for electronic reproductions of a physical object and that is that it is not clear (or indeed rather uncertain), if the sharing of the digital twin of a physical design constitutes infringement of the rights in the physical design. This makes a huge difference in a world where anybody can manufacture the design using 3D printers and is possibly exempted from an infringement finding by the private non-commercial use exceptions. In such a world a reliable way of preventing sharing of files is crucial. This really requires a clarification that design protection covers CAD files and/or surface files and that their sharing constitutes infringement.

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

Please add your views here:

It is often possible to create the required protection via multiple design embodiments, but having the option to protect both an initial design and a variety of transformed designs therefrom in a single design embodiment would be useful.

### 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:

A clarification that design protection covers CAD files and/or surface files and that their sharing constitutes infringement would be good. L

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

Please add your views here:

The ability to file 3D CAD files in place of 2D design drawings would be useful. It would also be useful to be able to file video files (e.g. for animated designs). GIFs, MP4, MOV, WMV or AVI file compatibility, plus DWG file formats for images/3D files would be useful. For registration of an animated design, at present this has to be done by a sequence of snapshots, which is quite limiting. Widening the filing options would improve the options for

securing protection for more complex designs.

Also, protection for (and protection against) electronically reproduced designs (e.g. NFTs or in game premium items) should be expanded. Protect against electronic monetisation (i.e. in game purchasing) of representations of protected physical designs is currently much more difficult than for real life reproduction of those physical products. Design protection for a physical product should also cover an electronic reproduction thereof, and vice versa.

## Better regulation

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

Please add your views here:

The deferrment process is important to prevent inadvertant disclosure of an invention. 12 months is typically long enough, but the difference relative to the Hague/EU system confuses clients. Extending the available period to align with the 30 month of those systems would be sensible.

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

Please add your views here:

nothing...

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

Please add your views here:

The 12 month grace period is good.

## Enforcement

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

Please add your views here:

Very good, save for electronic reproduction of physical designs.

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

Please add your views here:

Providing clearer routes for a finding of an infringement for digital twins or electronic reproductions of physical designs.

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

Please add your views here:

Has never come up in a real situation.

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:

Further changes don't seem to be necessary.