



Designs in the UK

Proposal to amend the marking provisions for registered designs

In 2014, the Government sought views on proposed changes to the Registered Designs Act 1949. The proposal was that the legislation be amended to provide registered design owners with the option of marking a product with the address of a website which links the product with the relevant registered design numbers as an alternative way of providing notice of the rights. The Government response to this call for evidence was published in August 2015.

The response document provides a summary of what respondents said about the proposal to introduce the option of webmarking for registered design rights. This document provides a summary of the key points raised by respondents and the Government's commentary on these issues.

In view of the positive response to the proposal presented, the response document indicates the Government's intention to bring forward changes to the relevant UK design legislation to allow webmarking for registered designs.

Responses to the Call for Evidence came from Appleyard Lees, Creative Barcode, Dean International IP Limited (t/a Dean International Patent and Trade Mark Consultants), Design Council, Dyson Technology Limited, Fieldfisher, the IP Federation, the Institute of Trade Mark Attorneys and the Intellectual Property Lawyers' Association. The outcome reflects what we proposed in our policy paper No. 11/14, in which the IP Federation welcomed the changes introduced by section 15 of the Intellectual Property Act 2014 on the marking of patented products and asked for these new measures to be extended to registered designs.

Consultation on IPO's new Design Opinions Service

On 19 March 2015, the Government launched a consultation seeking views on the detailed implementing regulations for the Design Opinions Service introduced by the Intellectual Property Act 2014. Comments are sought on the scope and procedures proposed for the service as well as the draft regulations and associated forms.

The members of the IP Federation fully support the proposal to introduce an Opinions Service which deals with questions of infringement and validity of UK and Community registered designs. However, we do not support the proposal to provide opinions relating to UK unregistered design rights (UDRs).

To expand on this, we fully support the proposal to introduce an Opinions Service which deals with questions of infringement and validity of UK and Community registered designs. The subsistence and ownership of a registered design are quickly and easily verified and relevant case law sets out the principles by which infringement must be assessed. Importantly, there is no requirement for copying to be established when considering infringement of a registered design. We believe that, in many cases, a useful opinion can be provided on the basis of documents and facts which are easy and obvious to requesters to provide, namely the registered design and the alleged infringement or non-infringement (for an opinion relating to infringement) and the registered design and the prior art (for an opinion relating to validity). The proposed Design Opinions Service will, we believe, provide a useful mechanism by which parties contemplating litigation relating to UK and Community registered designs may be assisted in making that important decision, or reaching a settlement without resorting to the courts. The Patent Opinions Service has played a useful role

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in relation to patents and we expect that the same would be true of a Design Opinions Service for registered designs.

However, we *do not* support the proposal to provide opinions relating to UK unregistered design rights (UDRs). We are concerned that, if the proposed Opinions Service were introduced for UK UDRs, the IPO would frequently have to make very significant assumptions about whether the UK UDR in question actually subsists at all before contemplating any question of infringement or validity. This is because qualification for UK UDR is not automatic, and because the commencement and term of the right is difficult to determine (even the GOV.UK website doesn't get it exactly right!). We believe that many requesters, particularly SMEs, will be unaware of the requirements for qualification, the events which trigger the commencement of the UK UDR and the duration of the UK UDR. Without that knowledge, many requests for an opinion based on UK UDR will be insufficient to allow any authoritative opinion to be issued. Moreover, infringement of a UK UDR can only occur if the relevant design is copied. It is difficult to see how the contemplated Opinions Service can possibly assess whether copying has indeed taken place within the procedure set out in the draft Regulations. It is even more difficult to see how the IPO can deal with the issue of features of the asserted design which are excluded by reason of their being commonplace without seeing evidence on that point.

We believe very firmly that opinions based on multiple assumptions will *not* be good for UK businesses. If a requester secures an opinion which turns out to be fundamentally wrong because an assumption is later found to be inaccurate, that requester may have been encouraged to take action which should never have been taken, costing the requester - and probably a third party - unnecessary time and money. Because of the complex nature of UK UDRs, we believe that parties contemplating litigation based on UK UDRs should be encouraged to seek advice from qualified legal advisers who will be better placed to extract all relevant information from the relevant party before providing appropriate legal advice.

Many of the above comments relating to UK UDRs do not apply to Community UDRs. Most of the provisions relation to Community UDRs, other than commencement and duration, mirror those of Community registered designs. Importantly, there is no qualification requirement for a Community UDR, although the requirement for copying to have taken place in order to infringe applies here too and presents the same challenges. Whilst we prefer that the proposed Opinions Service be confined to questions relating to UK and Community registered designs, we accept that opinions relating to Community UDRs can serve a useful purpose, provided that any assumptions relating to the question of whether or not copying has taken place are made clear. On that basis, we have no objection to the proposed Opinions Service dealing with questions relating to Community UDRs.

See our policy paper no. 7/15 for our response to the specific questions set out in the consultation.

Transitional provisions for the repeal of section 52 of the CDPA

The repeal of section 52 of the Copyright, Designs and Patents Act 1988 (CDPA) will remove a permitted act in law which reduces the term of copyright protection for artistic works that have been industrially manufactured. On 28 October 2015 the Government launched a consultation on the revised transitional arrangements for the repeal of section 52 of the CDPA. This new consultation follows the July 2015 revocation of the Government's previous transitional provisions.

We responded to the previous year's consultation by means of our policy paper No. 10/14, indicating that the potential impact on UK Industry of the repeal of section 52 CDPA remains to be seen. The IP Federation commends the IPO on launching this consultation at this stage, and urges that any further proposed changes in this area are subject to a consultation process involving users of the IP system. It is crucially important for businesses (large and small) to be made aware of the proposed transitional provisions in good time in advance of the new law coming into effect (through targeted IP awareness workshops and education campaigns, for example), and for the subject provisions to be sufficiently clear so that users can understand the effect of the proposed legislative changes and operate competitively with sufficient certainty in a complex business landscape of IP rights.

David England, 15 December 2015