

Consultation on IPO's new Design Opinions Service

Introduction

The Federation represents IP intensive companies in the United Kingdom - a list of members is attached. Our member companies are extensively involved with IP in Europe and internationally. Not only do our companies own considerable numbers of IP rights, both in Europe and elsewhere, but they are affected by the activities and IP rights of competitors. They may be either plaintiffs or defendants in IP related court actions, here and elsewhere.

The consultation

On 19 March 2015, the Government launched a [consultation](#) which seeks 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.

Any comments may be sent to opinionsconsultation@ipo.gov.uk. The consultation closes on 15 May 2015.

IP Federation response

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 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 question relating to Community UDRs.

The questions

Turning to the specific questions set out in the consultation:

Scope of the Design Opinions Service (regulation 5)

Question 1 Do you agree that the IPO should offer opinions on both UK and Community designs? If not, why?

Yes, we agree that the IPO should offer opinions on both UK and Community designs, but only registered designs. We oppose, for the reasons set out above, the inclusion of UK UDRs. We prefer, for the reasons set out above, that Community UDRs be excluded.

Question 2 Do you agree that the IPO should offer opinions to requesters irrespective of a UK connection, such as place of domicile of rights owner or location of infringement?

Yes, we agree that the IPO should offer opinions to all requesters, irrespective of whether or not they have a UK connection.

Question 3 If opinions requests should not be available to those without a UK connection, on what basis should they be limited especially in view of our intention to allow anonymous requests?

N/A

Specific matters on which an opinion may be sought (regulation 6)

Question 4 Do you agree that opinions on UK registered and Community registered and unregistered Designs should be available in respect of all the invalidity grounds set out in relevant legislation? If not, why?

Yes, we agree that opinions on UK and Community registered designs and Community UDRs should be available for all invalidity grounds - although we very much doubt that some of the grounds will ever be used.

Question 5 Do you agree that opinions on UK unregistered designs should be available in respect of all the grounds set out above? If not, why?

We do not agree that opinions relating to UK UDRs should be available at all for the reasons set out above.

How the service will operate

Question 6 Do you have any comments on the contents of a request and the form to be used to request an opinion?

Opinion request form: there are a few punctuation errors; note (d) is very unclear - we suggest simply asking for the names of all owners of the right in question, even if that means the requester repeating his own information; note (e) needs to say whether the related proceedings need to be in the UK or not; in note (e), it may be easier for SMEs if the form requested all infringers and their act of infringement, e.g. selling, importing, manufacturing, etc.; section 6 may be better split into two parts; the warning at the top of the back of the form should be on the front. We think that detailed guidance should be given on what information, facts and evidence needs to be included in the statement for each type of request, possibly even a template having sections with headings to assist requesters to make sure that they provide the correct information, especially in the case of UDRs (if included in the system).

Question 7 Do you agree that the fee for a designs opinion should be £200?

We agree that the fee should be £200. If it transpires that significant numbers of vexatious requests are being made, the fee could be increased to deter this.

Question 8 If the fee for a designs opinion was significantly more than £200, for example £2000, what effect would that have on demand for the service?

If the fee were £2000, demand would be severely reduced. We do not support this level of fee.

Appeals (regulations 13, 14 and 15)

Question 9 Are we right to limit appeals to only those circumstances where there is no other avenue to pursue the matter? If not, why?

We agree that appeals should be limited to cases where there is no other avenue available.

Question 10 Are there additional circumstances in which an appeal could be required and for which no other avenue is available?

We cannot think of any.

Question 11 Do you have any comments on the form to be used to request an appeal?

Appeal request form: we think the term "immediately after the date of the opinion" should be clarified; section 5 - we think the reference to note (f) should be to note (g); the warning at the top of the notes page should be on the main form before the signature; the notes specifying that the form and statement must be filed in duplicate are messy and unclear; notes (d) and (g) are repetitive; as before, guidelines for what information and/or evidence to include need to be made available.

Miscellaneous provisions

Question 12 Do you have any further comments on the proposed service or on the draft regulations?

The draft regulations are very poorly worded indeed. They need a thorough revision to correct many typographical and grammatical errors. In our view, they should also be recast so as to exclude UK UDRs and, preferably, Community UDRs.

Conclusion

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).

IP Federation
14 May 2015



IP Federation members 2015

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed below. The CBI, although not a member, is represented on the Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

AGCO Ltd
Airbus
ARM Ltd
AstraZeneca plc
Babcock International Ltd
BAE Systems plc
BP p.l.c.
British Telecommunications plc
British-American Tobacco Co Ltd
BTG plc
Caterpillar U.K. Ltd
Dyson Technology Ltd
Element Six Ltd
Eli Lilly & Co Ltd
Ericsson Limited
ExxonMobil Chemical Europe Inc.
Ford of Europe
Fujitsu Services Ltd
GE Healthcare
GKN plc
GlaxoSmithKline plc
Glory Global Solutions Ltd
Hewlett-Packard Ltd
IBM UK Ltd
Infineum UK Ltd
Johnson Matthey PLC
Merck Sharp & Dohme Ltd
Nokia UK Ltd
Pfizer Ltd
Philips Electronics UK Ltd
Pilkington Group Ltd
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