



EVOLVING THE UK DESIGNS FRAMEWORK

The past couple of years saw a great deal of activity concerning the planned revision of the EU designs system and the adjustment of design rights in the UK and the EU to the UK's departure from the EU. The focus in 2022 has shifted to exploration of opportunities to improve the domestic UK design system.

Early in the year, the UK IPO published a call for views on the current designs framework in the UK. The call for views covered both registered and unregistered rights, as well as the impact of new technologies and enforcement. The IP Federation submitted a written response and has continued to engage with the UK IPO as it moves to the next phase of consultation.

One of the most important issues that was raised in the call for views was the possibility of extending criminal sanctions to unregistered designs. The IP Federation is strongly opposed to such an extension. The IP Federation recognises that there is a place for criminal law in IP infringement where there is a clear public interest in criminality being punished, for example, where infringement involves deception of the public and/or fraud (such as in counterfeiting). The current law in regard to trade mark infringement or copyright infringement or both, deals with this adequately already. The fundamental problem with extending such measures to unregistered designs is that third parties cannot know with certainty whether any particular design is or has ever been subject to protection. This, coupled with the fact that the term is uncertain and that a legitimate right to use the design in question may exist, makes criminal sanctions wholly inappropriate. If criminal sanctions are introduced, the effect of this will be that businesses will err on the side of caution and refrain from bringing legitimate products to the market. This will stifle innovation in the UK and reduce legitimate choice for UK consumers.

Other issues relating to unregistered designs covered by the call for views included simplification of the current regime, overlap with copyright and disclosure requirements for qualification.

Regarding potential simplification, the IP Federation expressed the view that, whilst generally being in favour of international harmonisation and simplification of IP laws, the UK has a world-leading IP system, and so harmonisation at the expense of eroding that would not be in the interest of UK industry and should be considered carefully.

Regarding the potential overlap with copyright, the IP Federation considers that, as far as possible, there should be a demarcation between patents, designs and copyright. In particular, the IP Federation's view is that technical subject matter should be the sole purview of patent protection. Registered design legislation and supplementary unregistered design legislation both include exceptions for technical subject matter. Such safeguards are not necessarily explicit in copyright legislation, and recent evolution of EU copyright law through decisions by the CJEU in cases such as *Cofemel* (C-683/17) and *Brompton Bicycle* (C-833/18) have led to questions over whether subject matter that was intended to be protected by unregistered designs would necessarily already be protected by the much longer-lasting copyright. The UK now has the chance to make a clear break from these worrying developments by legislating to exclude technical subject matter from copyright

protection, which would provide those UK industries developing new technologies with greater certainty.

Turning to the issue of disclosure requirements to qualify for unregistered design protection, the IP Federation observed that these are presently complicated in that they vary between the different rights. In the digital age the concept of “first disclosure” in a given territory has little practical meaning or effect. Public disclosures anywhere in the world rapidly become available to the relevant circles in the UK. Therefore, removal of the requirement for disclosures to be within the UK, or at least clarification of the effect of simultaneous disclosure in multiple territories including the UK, would provide much-welcomed certainty for UK businesses.

The issues touched upon in the call for views in relation to registered designs included assessment of options for examination and opposition. The IP Federation recognises the harm to legitimate business and innovation that can be caused by attempted enforcement of registrations that are clearly invalid. On the other hand, the IP Federation also recognises the benefits of a simple, fast and low-cost registration procedure for fostering increased use of registered designs and the consequent benefits to innovation. Therefore, the IP Federation supports the introduction of a two-tier registration system where the current registration system is maintained but examination is required prior to enforcement. Similarly, the IP Federation is in favour of an opposition period following publication but only where this could be achieved in a fast and low-cost manner. The primary aim would be to remove clearly invalid registrations and especially those that seek to take advantage of a pre-existing design.

The UK Government has now responded to the call for views. We were pleased to see that many of the issues raised will be subject to a public consultation.

Outside of the UK, whilst (at the time of writing) the anticipated draft legislation from the Commission regarding proposed changes to EU design law has yet to materialise, other initiatives have begun to advance. In particular, the annual meeting of the World Intellectual Property Organization General Assemblies agreed to move forward with a Design Law Treaty. A diplomatic conference for the adoption of the Treaty is expected before the end of 2024.

The coming few years look likely to see significant changes in both the domestic and international designs frameworks, and the IP Federation looks forward to continuing to represent the views of UK industry on all fronts.

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