



Mr Allan James
Acting Divisional Director of Trade Marks & Designs
Intellectual Property Office
Concept House
Cardiff Road
NEWPORT NP10 8QQ

15 July 2013

Dear Mr James

Intellectual Property Bill 2013–14: Part 1 – Design

Thank you for your time and input at the Marks and Design Forum (MDF) meeting held at the IPO on 10 July 2013.

This is to follow up on the discussions. I am able to confirm the position of the IP Federation (list of members attached) on the following.

1. Criminal Sanctions for Registered Design Infringement (Clause 13, IP Bill)

The IP Federation has submitted separately its Policy Paper (No. 10/13) to you in this regard.

As you are fully aware, we continue to oppose strongly the proposed introduction of criminal sanctions in this area.

2. Appointed Persons at Appeal for Registered Designs (Clause 10, IP Bill)

The IP Federation maintains that it should not be possible for a dispute involving registered design to be heard by the Appointed Person if at least one of the parties wants to be in the Court.

The current proposal is that only the Appointed Person at Appeal can decide as to whether to transfer proceedings to the Court.

3. Unregistered Design Right (UDR) qualification – CDPA SS. 217 to 221

The present reciprocity provisions on UDR in the CDPA 1988 Act are well considered. At present, a non-EU company, say a US company using US designers, does not usually enjoy UK UDR for its designs created outside the EU. Your proposal would apparently mean that their US-created designs were always protected provided only that the US company had an EU subsidiary or branch doing substantial business. For functional designs, this would create a strategically unlevel playing field, with UK manufacture of copies of US-created designs being an infringement, while US manufacture of UK-created designs would not be an infringement.

The IP Federation would appreciate clarification from the IPO in this area. We would request that an appropriate amendment is made to the proposed IP legislation to ensure that UK business can operate on a level playing field with non-UK business in this area.

The IP Federation is the operating name of the Trade Marks, Patents and Designs Federation
Registered Office 5th floor, 63–66 Hatton Garden, London EC1N 8LE

Email: admin@ipfederation.com | Tel: 020 72423923 | Fax: 020 72423924 | Web: www.ipfederation.com

Limited by guarantee Registered company no: 166772

4. Unregistered Design Right (UDR) – functional designs

The IP Federation restates its proposal of completely eliminating functional designs from UK UDR, so as to correct the misalignment, in relation to functional articles, between (a) UK UDR and (b) UK Registered Design, Community Registered Design, and Community UDR. In the IP Federation's view, UDR for functional designs

- (a) provide disproportionate protection for minor technical improvements to the detriment of innovation and competition; and
- (b) create an unlevel playing field compared with the rest of the world to the disadvantage of UK engineering manufacturing.

Yours sincerely

Dr Bobby Mukherjee CPA, EPA
IP Federation President

Copy by e-mail: Sean Dennehey



IP Federation members 2013

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. Its Council also includes representatives of the CBI, and its meetings are attended by IP specialists from three leading law firms. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

AGCO Ltd
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
Delphi Corp.
Dyson Technology Ltd
Element Six Ltd
Eli Lilly & Co Ltd
ExxonMobil Chemical Europe Inc
Ford of Europe
Fujitsu Services Ltd
GE Healthcare
GKN plc
GlaxoSmithKline plc
Hewlett-Packard Ltd
IBM UK Ltd
Infineum UK Ltd
Johnson Matthey PLC
Merck Sharp & Dohme Ltd
Microsoft Limited
Nokia UK Ltd
Pfizer Ltd
Philips Electronics UK Ltd
Pilkington Group Ltd
Procter & Gamble Ltd
Renishaw plc
Rolls-Royce plc
Shell International Ltd
Smith & Nephew
Syngenta Ltd
The Linde Group
UCB Pharma plc
Unilever plc
Vectura Limited