



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

31 May 2013

Dear Mr James

Criminal sanctions for Registered Design infringement

At the recent IPO Trade Mark & Design Discussions meeting, the subject of criminal sanctions for Registered Designs infringement was discussed.

The IP 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 they own considerable numbers of IP rights, but they are affected by the activities and IP rights of competitors.

As you may be aware, the IP Federation is against the introduction of criminal sanctions for Registered Designs infringement even if the requirement is made that there must be direct copying of the design. The IP Federation members are concerned that unjustified allegations of infringement may be made causing distress and unjustified expense for legitimate businesses.

Should the IPO be unwilling to completely remove the criminal sanctions from the IP Bill, please may we suggest that the wording of the section be amended to restrict the offence to one in which there has been deliberate intent to deceive the purchaser of the product? A copy of the proposed wording is attached.

Should you wish to discuss the proposed wording or require clarification of the wording itself or other aspects, please do not hesitate to contact me.

Yours sincerely

Tim Frain
Chartered Patent Attorney
Vice-President, IP Federation

Copy by e-mail: John Alty; Sean Dennehey; Mike Foley; Simon Haikney; Michele Hambridge; Janette McNeill; Bill Trott; Lisa Vango; Duncan Wearmouth

RDA 35ZA (Offence of unauthorised copying etc. of design in course of business)

(1) A person commits an offence if—

(a) in the course of a business, the person copies a registered design so as to make a product exactly or substantially to that design **with intent to deceive the purchaser of the product as to the origin of the product and/or the origin of the design of the product**, and

(b) the person does so—

- (i) knowing, or having reason to believe, that the design is a registered design, and
- (ii) without the consent of the registered proprietor of the design.

(2) Subsection (3) applies in relation to a product where a registered design has been copied so as to make the product exactly or substantially to the design.

(3) A person commits an offence if—

(a) in the course of a business, the person offers, puts on the market, imports, exports or uses the product, or stocks it for one or more of those purposes,

(b) the person does so without the consent of the registered proprietor of the design, and

(c) the person does so knowing, or having reason to believe, that—

- (i) a design has been copied without the consent of the registered proprietor so as to make the product exactly or substantially to the design, and
- (ii) the design is a registered design.

(4) It is a defence for a person charged with an offence under this section to show that the person reasonably believed that the registration of the design was invalid.

(5) It is also a defence for a person charged with an offence under this section to show that the person did not infringe the right in the design.

(6) In this section “registered design” includes a registered Community design; and a reference to the registered proprietor is, in the case of a registered Community design, to be read as a reference to the holder.

(7) A person guilty of an offence under this section is liable—

(a) on conviction on indictment, to imprisonment for a term not exceeding ten years or to a fine or to both;

(b) on summary conviction in England and Wales or Northern Ireland, to imprisonment for a term not exceeding six months or to a fine not exceeding the statutory maximum or to both;

(c) on summary conviction in Scotland, to imprisonment for a term not exceeding 12 months or to a fine not exceeding the statutory maximum or to both.



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