

Proposal to Amend the Marking Provisions for Registered Designs

Introduction

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.

Section 15 of the Intellectual Property Act 2014

On 1 October 2014 section 15 of the Intellectual Property Act 2014 came into force to introduce a new measure as to how proprietors could mark patented products.

Section 15 of the Intellectual Property Act 2014 amends section 62(1) of the Patents Act 1977 to provide for the marking of products with a relevant internet link. The internet link references a posting on the internet where details of the relevant patents are listed. The internet link must be accessible to the public free of charge and must clearly associate the product with the relevant patent numbers.

IP Federation proposal to extend section 15 to registered designs

The IP Federation welcomes the changes introduced by section 15 of the Intellectual Property Act 2014 on the marking of patented products and would like these new measures extended to registered designs.

At present a person found to be infringing a registered design will be considered an "innocent infringer" if they can show they were unaware, and had no reasonable grounds for supposing that the design was registered, section 24B(1) of the Registered Designs Act 1949. However a person shall be deemed to have been made aware that the design was registered by marking of the product with the word registered or an appropriate abbreviation thereof accompanied by the registered design number, section 24B(2).

Extending the new marking provisions to registered designs would alleviate the practical problem of marking products with the relevant registered design numbers. Instead of listing the numbers of all the relevant registered designs on the product the proprietor could opt instead to refer to a single web address which links to a site which contains the details of all the relevant designs. This reduces the burden on the proprietor who no longer needs to produce and check stickers that are being applied to products or produce and change moulds on production lines for these products.

The main advantage of using a website is that it is much easier and cheaper for the proprietor to update a webpage with the numbers of the relevant registered design registrations as they expire or are allowed to lapse. This

not only reduces the burden on businesses and individuals who own registered designs but also makes it easier for third parties to access up-to-date information about the design registrations that are relevant to a particular product.

This is particularly important as a proprietor must ensure that up-to-date information about the design registrations is available. Anyone falsely marking a product with an expired design registration or with the wrong registered design number is subject to the financial penalties provided for by section 35 of the Registered Designs Act 1949.

Extending the new marking provisions introduced by section 15 of the Intellectual Property Act 2014 to registered designs would benefit all those working in the design industry. Indeed, until the virtual marking provisions recently brought in for patents are extended to registered designs, the accepted benefits of virtual patent marking cannot be realised by IP owners and third parties because manufacturers will still need to mark their products with respect to registered designs, and third parties will need to look for information in separate places. The economic benefits of virtual marking will not be realised until the burden of physical marking is completely removed. Furthermore it would be extremely beneficial if proprietors could refer to a single internet link which lists details of all the relevant registered rights, patents and/or registered designs, pertaining to a particular product. A further advantage is that the introduction of these provisions would also simplify marking across territories. The IP Federation therefore proposes the following amendments to section 24B of the Registered Designs Act 1949:

24B Exemption of innocent infringer from liability

- (1) In proceedings for the infringement of the right in a registered design damages shall not be awarded against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the design was registered.
- (2) For the purposes of subsection (1), a person shall not be deemed to have been aware or to have had reasonable grounds for supposing that the design was registered by reason only of the marking of a product with—
 - (a) the word “registered” or any abbreviation thereof, or
 - (b) any word or words expressing or implying that the design applied to, or incorporated in, the product has been registered,unless the number of the design **or a relevant internet link** accompanied the word or words or the abbreviation in question.
- (2A) The reference in subsection (2)(b) to a relevant internet link is a reference to an address of a posting on the internet –**
 - (a) which is accessible to the public free of charge, and**
 - (b) which clearly associates the product with the number of the design.**
- (3) Nothing in this section shall affect the power of the court to grant an injunction in any proceedings for infringement of the right in a registered design.

IP Federation
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IP Federation members 2014

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
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
Procter & Gamble Ltd
Renishaw plc
Rolls-Royce plc
Shell International Ltd
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Syngenta Ltd
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