



## Design Law – What Awaits in 2024?

For two years the IP Federation has been actively engaged in championing the views of UK industry in design law through debate and submissions with various stakeholders and legislative bodies . Finally, some of the revised legal landscape is beginning to come into focus and the future challenges more apparent.

At the end of the 2023, it was announced that the Council of the EU and the European Parliament had reached a provisional agreement on the first substantial review of the 20-year-old EU Design Law. Two of the most notable changes amongst the proposals are infringement provisions associated with 3D printing and digital transformation, as well as the permanent introduction into the law of the Repair Clause. It is proposed that only the owner of an EU registered design shall have the right to create, download, copy and share software recording the design for the purposes of making the design, thus curtailing efforts to avoid infringement via digital means. The introduction of the Repair Clause seeks to enshrine in the law the extent to which EU design right holders can prevent the use of spare parts of an identical appearance for the repair of a complex product. Interestingly, the proposed clause seeks to balance the interests of design owners, consumers and the replacement parts industry by deviating from the ruling by the CJEU in *Acacia vs Audi & Porsche* (joined cases C-397/16 and C-435-16) by narrowing the exclusion to “must-match”-only replacement parts of complex products. The formal adoption by both the Council and Parliament of the proposals is expected in early 2024.

The development of design laws overseas will continue in 2024 when WIPO’s diplomatic conference to conclude and adopt a Design Law Treaty is set to take place in November. Broadly speaking the treaty aims to provide at least a degree of international harmonisation to simplify obtaining design protection outside of the UK.

Turning attention closer to home, since 2022 the UK IPO has been seeking external opinions on the current functioning of both registered and unregistered design rights in the UK, with the aim of providing a legislative framework that ensures the business of design is appropriately supported and encouraged. However, Government work on the then REUL (Retained EU Law) Bill slowed progress on the designs law review. Subject to the timing of a general election, the government is planning to consult throughout 2024; indeed, informal consultation on key topics of the review has already commenced. The IP Federation is pleased to have been invited to participate in this consultation.

As reported previously, the design review is multifaceted with key topics of focus being given to simplification, suitability of criminal sanctions for unregistered rights, disclosure of unregistered designs and increasing the value of registered designs. The informal consultations have afforded the

Registered Office 2<sup>nd</sup> Floor, Viaro House, 20-23 Holborn, London EC1N 2JD

Email: [admin@ipfederation.com](mailto:admin@ipfederation.com) | Tel: 020 7242 3923 | Web: [www.ipfederation.com](http://www.ipfederation.com)

Limited by guarantee Registered company no: 166772

UK IPO an opportunity to test their internal understanding of the feedback from the public consultation and for key stakeholders, including the IP Federation, to provide further guidance on the consultation points as well as practical examples of current and future outcomes of legislative efforts.

One question posed in the consultation concerned the introduction of criminal sanctions into unregistered design law. The IP Federation strongly rejected this idea in its consultation response and in its submissions to the Parliamentary Undersecretary of state for AI and IP, on the belief that criminal law should only be used for IP infringement when there is a clear public interest in punishing criminal acts, such as when infringement involves lying to the public and/or cheating them (for example, in counterfeiting). The uncertainties for third parties associated with unregistered design protection including the existence, validity and length of protection all render criminal sanctions a thoroughly unsuitable remedy. Indeed, rather than protect the efforts of UK designers, criminal sanctions are more likely to reduce design innovation in the UK.

Rather than seeking to broaden and amplify infringement sanctions, the IP Federation believes increasing legal certainty by using registered designs will be significantly more beneficial to all users of the design system regardless size – be it large scale industry or individual designers. In particular, the IP Federation knows the harm to legitimate business and innovation efforts that can be caused by trying to enforce registrations that are clearly invalid. Whereas a simple, fast and low-cost registration process encourages greater use of registered designs and the benefits innovation in design. Therefore, the IP Federation supports the introduction of a two-tier registration system where the current registration system is kept but examination is needed before enforcement. Similarly, the IP Federation is in favour of an opposition period after publication assuming the process is fast and inexpensive. The main aim of both provisions would be to remove clearly invalid registrations, especially those that try to take advantage of a pre-existing designs.

Over the coming year, the IP Federation will seek to lobby for the introduction of improvements into a revised UK Design Law that improves certainty such as a two-tier registration system, clarity in disclosure to ensure in the age of digital disclosure unregistered design rights are not lost, whilst urging resistance to the introduction of criminal sanctions into unregistered designs. To the extent that an unofficial anthem for Design Law in 2024 is needed Bob Dylan's *The Times They Are a-Changin'* comes to mind, and the IP Federation will proudly vocalise the views of UK industry.

Robert Carlin, Chair of IP Federation Copyright & Design Committee