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The Chartered Institute of Patent Attorneys

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IPO Design Opinion Service Consultation

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We welcome the Designs Opinion Service, which we have long championed for the reasons set out by the Minister in the Foreword to the Consultation. We also generally support the aim of alignment with the equivalent Patent Opinion Service. We agree that the previous Impact Assessment remains appropriate to these proposals. Our responses to the detailed questions are listed in the Annex.

Beyond these, we would make a few general comments.

A - "Copying" is an ingredient of infringement of both UK Unregistered Design Right and Unregistered Community Designs. In giving Opinions on infringement of unregistered rights, we think it might be preferable for the IPO to limit itself to considering the similarity between designs and the acts proposed to be done, without having to investigate the issue of copying. We therefore suggest that 6(1)(a) and 6(2)(a) be amended to replace the bracketed "(if done)" with "(if done as a result of copying without consent)". This would have no effect on Opinions for registered rights, where copying is irrelevant.

B – Thought should be given to ensure that the rules are apt to cover:

1. UK National Registered Designs
2. Community Designs registered under Regulation 6/2002
3. International Designs designating the EU
4. International Designs designating the UK nationally (in future)

C – Make it clear in Rule 7(2)(b) that "proceedings" may be present or past, and clarify what they mean (to a lay person, the word is not limited to legal proceedings).

D – "The owner" needs clarifying in two respects. Firstly, where there are joint owners, all should be served with all papers. Secondly, with unregistered rights, the person initially identified as "owner" by the referrer may in fact not be such. The true owner(s) may wish or need to enter the proceedings. We would suggest modifying the interpretation in Rule 2 to refer to "the or each ..." and introducing an additional possibility for unregistered designs – "... and any person subsequently found by the registrar to own the design in whole or part ..."

E – Opinions can be given on expired registered rights. Should not the same apply to unregistered rights? Allowing this would remove from the registrar the burden of checking whether an unregistered right has expired, which is difficult and unnecessary.

F – Bearing in mind that unrepresented parties often provide insufficient or inappropriate evidence, we wonder whether Rule 9(1) should clarify that the Registrar shall not issue an Opinion where it appears that there is insufficient evidence to do so? This could then be coupled with advice to seek representation if that is necessary.

G – Is "a copy" necessary under Rule 7(a), and are duplicates necessary under Rule 7(3), if electronic filing is used? Perhaps add a para (5) saying that "The Registrar may make provision for the content of requests filed electronically"?

Minor typographical issues:

- 6(3) – "the registered Community design" should be "a registered Community design".
- 13(1) – "the the"
- 8 – "documnet"

ANNEX – RESPONSES TO SPECIFIC QUESTIONS

<p>1. Do you agree that the IPO should offer opinions on both UK and Community designs? If not, why?</p>	<p>Yes. Provided that the Opinion does not result in revocation, we are not persuaded that Community law precludes this. Many UK designs are protected also by Community Unregistered Design Right, and omitting these is therefore at best only half a job. As the substantive law is similar, the additional burden is no greater. As to copying, see our comments above.</p>
<p>2. Do you agree that the IPO should offer opinions to requesters irrespective of a UK connection, such as place of domicile of rights owner or location of infringement?</p>	<p>Yes. UK consumers benefit from imported goods, and it is to their benefit that importers should be able to take prudent advice before entering the UK market. However, there might be benefits in allowing small UK entities a lower fee, justified by the fact that the registrar can judge “smallness” of a UK entity with greater ease than it can a foreign entity.</p>
<p>3. If opinions requests should not be available to those without a UK connection, on what basis should they be limited especially in view of our intention to allow anonymous requests?</p>	<p>N/A. We do indeed think this would be impractical; requests might be made through a UK proxy in any event.</p>
<p>4. Do you agree that opinions on UK registered and Community registered and unregistered Designs should be available in respect of all the invalidity grounds set out in relevant legislation? If not, why?</p>	<p>Yes in general, subject to an overriding discretion to refuse to give an Opinion in a particular case. As to “because the owner is not the proprietor”, we think the ground should be available, but only where there has been a <u>prior</u> adjudication by the relevant Court as to ownership. We agree that the Registry should not investigate entitlement themselves.</p> <p>However, Opinions on “relative” ground (which can be invoked only by a party who can wield an earlier right) should perhaps only be given where the requester can be identified as that party.</p> <p>In particular, as to conflict with an earlier copyright work, we think the Registry should exercise considerable caution, because (a) this would involve a right with which the Registry (and the IPO in general) has little experience, (b)</p>



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	investigating copying is unsuitable to a written procedure and (c) copyright disputes come close to ownership disputes, see OHIM Appeal Decision R 64/2007-3 at para 19)
5. Do you agree that opinions on UK unregistered designs should be available in respect of all the grounds set out above? If not, why?	Yes. However, we note that this jurisdiction will overlap somewhat with that under s246 CDPA. It may be necessary to provide clarity to applicants as to the different effects of the two procedures.
6. Do you have any comments on the contents of a request and the form to be used to request an opinion?	It seems to lack any method of indicating that an opinion on an unregistered design is sought. We suggest adding a fourth tickbox under section 5, so that there would be one for registered and one for unregistered designs. More generally, we think our members will find this form suitable, but we wonder whether the unrepresented parties who at present use the registry might benefit from a more fundamental redesign, specific to designs rather than generic to patents.
7. Do you agree that the fee for a designs opinion should be £200?	See below. However, there may be some logic in aligning opinion fees concerning validity alone with the corresponding fees for invalidation (£50) and reference of a UDR dispute (£65). Further, we think there might be merit in a differential fee. Where a party is an individual or a company who is entitled to claim Total Exemption status at Companies House or satisfies some other criterion of “smallness” in the UK, and is not anonymous, and is prepared to declare that they are not acting for or with another party who does <u>not</u> satisfy these criteria, the fee could be £200; for others it could be higher.
8. If the fee for a designs opinion was significantly more than £200, for example £2000, what effect would that have on demand for the service?	A higher price will have some effect in reducing demand. For unrepresented parties, the impact on demand might be high but we are not in a position to estimate this. For represented parties, we think the impact would be modest, as £2000 is comparable to the cost of representation. £2000 is however the maximum that should be charged at present. If a fee higher than £200 is

	contemplated we suggest that £1000 is closer to the mark.
9. Are we right to limit appeals to only those circumstances where there is no other avenue to pursue the matter? If not, why?	Yes.
10. Are there additional circumstances in which an appeal could be required and for which no other avenue is available?	We are not aware of such.
11. Do you have any comments on the form to be used to request an appeal?	The form should include a space for Representative. Otherwise, a party without a UK/EU address has no guidance, and the Registry will contact the applicant not their representative (where one is appointed).
12. Do you have any further comments on the proposed service or on the draft regulations?	We think the periods may be rather short. For example, as designs have not previously been searched, one or both parties may need to search prior art as part of framing a response. We suggest allowing them to be extended to 2 months.



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