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CIPA Comments/ Response on Draft Examination Guidelines

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The Chartered Institute of Patent Attorneys (CIPA) is the professional and examining body for patent attorneys in the UK, representing virtually all the 2,000+ registered patent attorneys in the UK, whether in industry or in private practice. Total membership is over 3,500 and includes trainee patent attorneys and other professionals with an interest in intellectual property (patents, trade marks, designs and copyright). CIPA represents the views of the profession to policy makers at national, European and international level, with representatives sitting on a range of influential policy bodies and working groups in the UK and overseas.

We support the provision of an online Designs Manual, and are grateful for the opportunity to comment on its contents. In general, we think the detailed guidance and examples in Section 11 relating to representations will be invaluable to applicants.

Our general point is that it is important to clarify the relationship between the Manual, on the one hand, and the existing Design Practice Notices which are as follows:

| Number | Title |
|--------|---|
| 1/16 | Guidance on use of representations when filing Registered Design applications |
| 1/09 | New procedure relating to convention country priority claims in design applications |
| 6/06 | Colour in design applications |
| 5/06 | Changes to the Registered Designs Rules (etc) |
| 4/06 | Facilitating the restoration of lapsed design registrations |
| 3/06 | Ending the withdrawal of some registered designs from public inspection |
| 2/06 | Allowing Multiple Applications |
| 1/06 | Ending Novelty Examination |
| 2/04 | US priority documents in support of UK design applications |
| 1/04 | Filing requirements for design applications |
| 6/03 | Colour in design application |
| 5/03 | Designs dictated by their technical function |
| 4/03 | Requirement of novelty and individual character |
| 3/03 | Divide-outs. |
| 2/03 | Applying to register part of a product. |
| 1/03 | Component part of complex product visible in normal use. |

List of DPNs

We point out the links below and suggest that the DPNs be incorporated into, and then explicitly repealed in favour of, the Manual once its content has been finalised.

We have seen, and support, the comments of the IP Federation. Our detailed comments are as follows:

1.04 add “or is a design of an interconnection”

We strongly disagree with para 1.05. It is correct as regards Section 1D and Schedule 1, and should be confined to those grounds. As regards Sections 1 and 1C, the equivalent text should read “In order to be deemed acceptable for registration, a design must not consist entirely of elements which correspond to those aforementioned in Sections 1 and 1C.

2.02 – As indicated below, we think paras 2.18-2.19 should follow under “appearance”.

2.03 – Should say “the design of just part of a product”, the statutory language, not “part of a design”. Note the link to DPN 2/03.

2.04 – Note link to DPNs 6/06 and 1/16. As to “... do not fall under the definition of a design, as set out in the RDA...”, this is a policy interpretation, which does not appear literally in the RDA. Perhaps re-word. Also, point out that “where filed in greyscale, the tonal contrast may form part of the design.”

2.05 – Note OHIM appeal case R 1009/2006-3 *Sabine Decoodt*, and OHIM’s Notice (approved in that case): “According to Article 37(1) CDR and the explanations given in the Examination Guidelines, an “ornamentation” is an additional and decorative element capable of being applied to the surface of a variety of products without significantly affecting their contours. (OHIM Newsletter 5-2005).” This might be a better approach than the 2D/3D analysis of the draft Guidelines. We think it could be partly three dimensional, like the “cock beading” in *Mark Wilkinson Furniture v Woodcraft Designs* [1988] FSR 63 or the writing in a stick of rock (referred to by the Court of Appeal in *Lambretta v Teddy Smith* [2004] EWCA Civ 886, [2005] RPC 6).

2.08 replace “which are not visible” with “which are wholly invisible” – partly visible designs are not excluded. The Draft Guidelines should perhaps indicate at this point that this ground is not examined. Refer to paras 3.09 – 3.10 below. Note the link to DPN 1/03.

2.12 – “Screenshots” suggests that applicants need to file the whole screen, which differs from longstanding practice allowing registration of icons (i.e. parts of screens, elements of GUIs). Also, it appears to us that line drawings should be an acceptable representation of GUI elements, if the novelty lies in their shapes rather than their colours.

2.13 – We strongly disagree that a moving screen interface could be considered a “computer program”. We think the Court of Justice decision in Case C-393/09 BSA makes it clear that GUIs are not computer programs in the sense of EU law. We are also doubtful that it could “constitute an attempt to protect the functionality of a product”, as stated. A growing number of countries protect dynamic icons and we think the UK would be ill-advised to take a hostile position absent any authority on the point. We think it advisable to delete this paragraph altogether.

2.14 – We are unaware of the authority for this definition of “get-up”. In particular, the bikini example appears likely to confuse. We support the notion of registering multiple separate items used together as a single design, but it might be better to approach this as a matter of “product” than of “get-up”.

2.18 - We agree that “ideas” and “concepts” are unprotectable. We do not agree that this is because they are not a “product”. The Commission’s Green Paper indicated that the reason for the adoption of the term “appearance” as a definition of “design” was to exclude protection for concepts. See EU Green Paper,¹ para 5.4.3.3 p59. Note also General Court Case T-68/11, *Kastenholz v OHIM* at para 72 contrasting “appearance” and “idea”, and *PMS v Magmatic*² at para 57 contrasting “idea” or “conception” with “design”.

¹ Green Paper on the Legal Protection of Industrial Design, Commission 1991, 11/F/5131/91-EN http://ec.europa.eu/internal_market/indprop/docs/design/green-paper-design_en.pdf

² [2016] UKSC 12, [2016] WLR(D) 126

2.19 -We think this scenario would normally be a “lack of unity” objection, not a “not a design” objection. Since design applications contain images, they are usually incapable of protecting ideas or concepts, whatever the applicant might think, so no rejection by the Registry is required.

3.02 – Not only is there no novelty examination (note link to DPN 1/06) – the Registry is unable to examine novelty and individual character at the examination stage even where prior art is submitted by a party, or is sitting on the Examiner’s desk.

3.03 – Add “or in Court,” after “Tribunal”. Note link to DPN 4/03.

3.04 – At this point, perhaps add a link to the various databases which cover designs extending to the UK, e.g. the Registry design search, Designview, eSearchPlus, Hague Express, and WIPO’s Global Design Database.

3.09 – Note link to DPN 1/03.

4.01 – 4.13. We agree.

Sections 5 & 6 – We think it would be very desirable to keep these sections “in lock” with those of the Trade Marks Manual. Perhaps in future a common module could be developed which deals with both together.

7.05 – Add mention of the fact that the Registry will object on other grounds also, e.g. if they cannot understand what the indication means, if it tries to claim technical function, if it is immoral etc.

7.06 – We do not think the Registry is in a position to guarantee applicants that the indication “is solely for the purposes of the application process”. Although it does not limit the scope of protection, it could have effects on validity. We think the point is currently open (see the disagreement between the UK Court of Appeal and OHIM’s Board of Appeal in *Green Lane v PMS*³ at paras 51-52).

7.07 – Perhaps add at this point that the applicant may use the description for explaining e.g. dashed lines. Note link to DPNs 2/03, 1/04, 1/16.

7.08 – Add reference to the practice where specimens are filed following *Hadley v Sloggett*,⁴ i.e. requesting replacement representations for publication but keeping the specimen.

8.03 – perhaps mention the statutory test i.e. identity of the design is retained?

8.05-8.07 – Note link to DPN 3/03.

Section 9 – Note link to DPNs 2/04 and 1/09.

Section 10 – Note link to DPNs 1/04 and 1/16.

10.01 – We are not sure of the basis for the “7 representations” limit (see also 10.23). We would not favour such a limit as it would remove one of the few substantial advantages of UK Registered Designs over Registered Community Designs.

³ [2008] ECDR 15, [2008] EWCA Civ 358, [2008] FSR 28

⁴ [2003] EWHC 2361 (Pat)

10.06 – Note link to DPNs 6/06 and 1/16.

11.01 – We think this should be “Additionally or alternatively”. Where applicants use a “non-verbal” or visual disclaimer, they run the risk that the Courts may misinterpret it unless they explain it in words.

11.05 – We agree that it is best if the disclaimer is clear from the representations alone, but we would not for that reason discourage the use of verbal disclaimers in addition, to increase certainty.

11.13 – In view of the *Trunki* case,⁵ we think it is essential that visual disclaimers using colour should be accompanied by a verbal explanation (this might appropriately be seen as a description of the visual disclaimer rather than a verbal disclaimer in its own right).

12.10 – Perhaps there should be a chapter on the Appointed Person appeal process. Again, this (and material on Hearings generally) could usefully be made common with the Trade Marks Manual. It might also be mentioned that there is no fee for an Appointed Person appeal.

Section 13 – If, as we think, the UK is still using an old version of the Locarno Classification then this should be indicated. Perhaps also an Annex with the UK’s “three level” implementation of Locarno (available through the design search page).

Professor David Musker
Chair, CIPA Designs & Copyright Committee
15 April 2016

⁵ *PMS v Magmatic*, cited above