Law Society IP Law Committee and IPLA
Joint Design Response to the
Consultation on changes to the UK designs framework

16 December 2025

The Law Society

The Law Society is the independent professional body for solicitors in England and Wales. We are run by our members, and our role is to be the voice of solicitors, to drive excellence in the profession and to safeguard the rule of law.

As the body representing solicitors and with a statutory public interest role, part of the Law Society's overarching purpose is to safeguard the rule of law in the best interests of the public and the client. We are driven by our core objectives to promote access to justice, safeguard the rule of law, promote diversity and inclusion, the international practice of law and to support our members' businesses. We welcome the opportunity to respond to the UK Intellectual Property Office ("**IPO**") consultation on design law.

The Intellectual Property Lawyers' Association (IPLA)

The IPLA is a representative body for law firms across England, Scotland, Wales and Northern Ireland with substantial practices in intellectual property ("**IP**") litigation, and who wish to promote improvements in IP law and practice. Its membership comprises around 65 law firms, which collectively conduct the vast majority of IP litigation in the UK.

Member firms act for clients ranging from the smallest start-ups to the largest multinational businesses, and represent IP rightsholders and traders across all sectors of industry. Collectively, the IPLA members bring deep and wide-ranging experience across all areas of IP law. Accordingly, the IPLA is well placed to provide informed and constructive comments on the issues raised in this consultation.

General observations

It is a truth universally acknowledged that the UK design protection regime is overly complicated. There is, however, less complete agreement on how that complexity is to be rectified. The current consultation provides a good start, but we are concerned that it ought not also be the endpoint, either of proposals put forward, or discussion of those proposals.

Our concerns stem from the need for the design protection regime to work as a complete system – with the risk that pulling on one thread in the hope of aiding simplicity creates unintended complexity elsewhere in the system. All aspects of the system must sit together and (alongside other IP rights such as copyright and trade marks) must be compliant with the UK's international obligations, and, preferably, not create greater complexity for the UK's designers (and design practitioners) practising outside the UK.

Our members are IP practitioners who are users of the design protection and enforcement system on behalf of clients, involved in clearing designs for use in the UK, protecting designs through registration and otherwise, and enforcement (as both plaintiff and defendant). Our

members also teach design law at university level, and sit as part-time judges hearing design cases in the IPEC (small claims track and multi-track) and the High Court. Our members are therefore well versed in all practical, academic and judicial aspects of the design regime in the UK. Many also have experience of other jurisdictions, from having practised there, or from helping UK clients with protection or enforcement in the EU and/or around the world.

In addition to the more detailed comments that follow in answer to the questions posed, we wish to make the following more general comments:

1. The clarity, speed and low costs of the design rights system are core benefits. Any changes to the system will be of concern if they add delays to the registration process (e.g. with opposition periods) and/or increase design application fees (e.g. to cover relative ground examination/searches).

2. The views expressed in this response reflect answers that our respective organisations felt able to express collectively, but it is clear there are many differing views even within our members to some of these answers. In this response, we highlight where we were unable to reach consensus and where the views expressed may have only been agreed by one of the organisations.

3. Given the need for all aspects of the system to fit together, we would encourage the Government to undertake a thorough review, along the lines of the Hargreaves Review, steered by an independent expert. This review should encompass all aspects of design law, as well as the overlap with other IP rights including copyright and trade marks. Some of the aspects of the current proposals are economic and/or policy questions for government: resolving those issues will help in formulating a system that works across industries.

4. It is essential that any reforms maintain the UK's compliance with its international obligations. We advocate for the reforms to take into account the recently agreed Riyadh Design Law Treaty, so that the UK's domestication of its accession can proceed rapidly.

5. Many (if not most) UK designers also wish to monetise their designs outside the UK. We see real advantage for them (and for our members, the practitioners who advise them) on maintaining, where practicable, harmony with the EU-wide regime. The EU has recently adopted significant practical reforms, which are evolutionary and largely reflect current practice. Unless there is an express reason of benefit to the UK and UK businesses not to adopt any of those reforms, we advocate for the UK to do so in order to keep the UK in line with its nearest neighbour. For example, we consider the amendments to the EU definition of "design" (including animated designs) and "product" to be appropriate for adoption, as is the use of the ⓓ sign as a practical demonstration of rights in the design. Any such alignment should be balanced so as not to undermine existing IP protections in the UK.

6. Given that microbusinesses are the vast majority of design businesses in the UK, resources and IP knowledge are limited, and any changes to the design right system must not deter such businesses from accessing justice because of the high costs of litigation, time and/or increased complexity. Small businesses will prefer a design system where costs for obtaining design protection, in particular, are low.

7. The UK reforms should also reflect, as closely as possible, practice and procedure under the Hague Agreement, of which the UK is a member. Again, this is in the interests of designers (particularly individual designers and SMEs) who are most likely to use the Hague Agreement unassisted by an IP practitioner. Deferment is an

example of an area that could readily be harmonised as between the UK, EU and the Hague Agreement.

8. The EU reforms have carefully removed gendered language from the EU Design Regulation (EU) 2024/2822 ("**EUDR**") and EU Design Directive (EC) No 6/2002 ("**EUDD**"), and we call for the UK to do likewise. For example, if the notion of "work of artistic craftsmanship" (s4(1)(c) Copyright Designs and Patents Act 1988 ("**CDPA**")) is to be retained in copyright law, we suggest it be modernised to, for example, "artisanship" (although there is a concern this might have a different meaning, in which case "an artistic craft work" might be used).

9. We also urge reforms that do not require UK designers to choose between first disclosing in the UK or the EU (or elsewhere). The UK will inevitably suffer if UK designers are encouraged to wait for Paris Fashion Week (for example), rather than disclose at London Fashion Week.

10. We are conscious that it could be difficult to simplify the UK system while preserving pre-existing IP protection. Any proposal that results in the erosion of the current scope of protection for unregistered rights, including copyright, should be supported by a comprehensive impact assessment.

11. Transitional provisions can ensure that currently existing rights are not lost – but simplification of the system will be limited if all types of protection are kept in their current form. The Law Society advocates for the amalgamation of the 3-year Supplementary Unregistered Design ("**SUD**") right with the 10-15 year unregistered design right ("**UDR**"). The Law Society had mooted a duration of 7 years in the 2023 consultation, and also possibly even different periods for different sectors. The Law Society now acknowledges the impracticalities of a sectoral approach to the duration of the right and, accordingly, does not now recommend that.

12. IPLA members are split between the Law Society position and a position that avoids any loss of pre-existing rights purely for simplification purposes. The clear view from both organisations is that 3 years is too short (with the right having expired by the time any litigation is concluded) and something nearer to 7 years, or perhaps 10 years (a period mentioned in TRIPS), being more appropriate.

13. Both organisations believe the right should be available from the first disclosure worldwide of a design, without any residency requirement.

14. We support changes in the law to address bad faith registrations. We urge caution prior to wholesale reform to attempt to eliminate the small percentage of designs which are apparently filed in bad faith. Wholesale searching (or even searching in undefined cases) will slow down legitimate registrations, and increase costs. We suggest consideration of other tools to limit illegitimate filings, such as, for example, limiting to IP practitioners with the right to represent third parties before the IPO.

15. The Law Society advocates for registered and unregistered design law to be the same, other than where that is impossible (registration v disclosure, monopoly v copying, duration). This would greatly aid the simplicity of the system for designers and practitioners. This is currently the position as between registered designs and SUDs. IPLA members are split on this issue. While such a proposal would provide for a simpler system, it would be at the expense of loss of existing protection. Consequently, we restate our request for a comprehensive impact assessment in the event that the government favours a proposal that results in the erosion of the current scope of protection for unregistered rights.

16. Whilst there is discussion in the consultation about the IPEC, we urge ongoing consideration of the three relevant legal territories, keeping in mind the tribunals in Scotland and Northern Ireland. We had previously been sceptical about the idea of allowing registered and/or unregistered design right cases to be brought in the small claims track of IPEC. Whilst we have seen fair, sensible and reasoned judgments coming from that court in other IP cases, we would only support such a change if the IPEC SCT administration was more IP focused and the judges for such cases had genuinely relevant design law experience. Design law cases are not suitable for judges inexperienced in this area of law. Judgments from these cases need to be routinely published.

17. We are also not in favour of introducing a criminal offence of unregistered design infringement and propose criminal liability should be removed for registered design infringement.

18. Finally, we recommend that the Patents Court be renamed the Intellectual Property Court and that the Intellectual Property Enterprise Court be renamed the Intellectual Property Streamlined Court or something that more clearly identifies its purpose and status. The word "Enterprise" has no clear meaning in this context.

We commend the IPO on its consultation. We consider this to be an important next step in the reform process.

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Section A: Search, examination, bad faith and opposition/ observation

1. **Have you/your business experienced anti-competitive filings?**

   The clients for whom our member firms work have experience of such filings. There are evidently bad faith or anti-competitive design applications being filed in numerous jurisdictions around the world. A particular issue is the registration in the UK (and historically the EU) of designs that pre-exist elsewhere in the world by entities that are not economically linked to the creator of those designs with a view to seeking, by registration, an unfair monopoly in respect of those designs in the UK. This can include the attempt to obtain a registration certificate to use for the purposes of an online platform takedown, and in essence illegitimately remove a competitor from the market.

2. **If yes: How many times has this happened to you in the past 2 years?**

   Our member firms will have had clients to whom this has occurred on multiple occasions, but we cannot give an average across all our member firms.

3. **Was the anticompetitive filing for (tick all that apply):**

   All of the options will have occurred to the clients of our member firms, i.e. each of:

   - A copy of my product e.g. used your marketing material, pictures from your website, or copied representations from your design registration.
   - For a generic or well-known product.
   - A re-filed application for a previously invalidated design.
   - Other images of the copied products, i.e. not copied images, but rather new photographs a copied product.

4. **How did you address the issue (select all which apply).**

   All of the options will have been used by the clients of our member firms, i.e. each of:

   - Removed my online listing due to a takedown notice.
   - Appealed the takedown notice with the online platform.
   - Applied to IPO to invalidate the design.
   - Sought legal advice from an IP attorney.
   - Sought advice from a trade body or membership organisation.
   - Did nothing.
   - Other.

5. **Did this have a financial impact on your business?**

   Yes, it will have caused the clients at least to incur legal costs and likely a loss of sales revenue.

6. **If yes, how much did it cost your business?**

   If the client instructs one of our members, it will likely be spending around £10,000 in pre-action steps (e.g. a cease and desist letter). A cancellation action might just fall into that range of spend, but probably more likely £10,000 - £25,000 if it is

contested. If litigation is required, then the costs will exceed £50,000 and could be much higher.

Section A1: Search and examination

7. **Do you agree that the "do nothing" option should be discounted?**

Yes.

8. **Please rank the options (most preferred/least preferred/no preference):**

Some of the key advantages of the current UK registered design system are speed and low cost, which are particularly important for SMEs and in certain business sectors where there is a greater turnover of products (e.g. fashion, toys).

Preferred option is Option 1 (Introduce powers to make it clear that the IPO can carry out a search). However, if examiners are to have the option of undertaking searches, these should preferably:

(a) be limited to novelty-only checks using whatever AI tools can assist (to limit time/effort) to identify completely identical designs; and

(b) not be routinely done but only sparingly, e.g. where the examiner has good reason to believe the design clearly lacks novelty and may have been filed in bad faith.

We would not want any such searches to slow down the registration process as a whole or to increase costs. In particular, if any prior disclosure was made clearly by the applicant within the one-year grace period, i.e. falling within the exception of s1B(6)(c) Registered Designs Act ("**RDA**"), then no objection should be raised.

The process needs to avoid becoming overly complex, in particular we would not wish to see a search process turning into a debate, perhaps involving evidence, about whether the prior disclosure was made by the applicant or someone connected with them.

Least preferred option is Option 2 (Introduce a two-stage system). If a search is introduced as a matter of routine, we believe it should be limited to a simple AI-powered novelty search. In that event, given how it could be automated, we question whether it would necessarily need to give rise to an additional fee. Alternatively, it could trigger a smaller additional fee if the request for the search is made at the time of application and a higher fee if requested later. However, this might lead to a situation whereby applicants that do not pay extra for the search will be perceived as doubting their own design's novelty, which could peer-pressure applicants to have the search done as a matter of routine. This might be avoidable if there is no initial fee for the search.

Our overall preference would be to have no searches done at the application stage and instead have a quick, easy and very low cost first stage challenge option, e.g. like an *inter partes* review or post-grant review of a USPTO patent but only based on novelty and one piece of prior art provided by the challenger.

Limited searching

9. **If limited searching was introduced, which designs should be subject to search (select all that apply)?**

- **Designs which IPO knows are the same as another e.g. re-filing a previously invalidated design.** Yes.
- **Applications to register generic products/designs.** Yes, but then need to clarify what is generic.
- **Designs which an examiner suspects may be anti-competitive.** Yes, but only if the examiner "reasonably suspects" or perhaps has "compelling grounds to suspect" it may be anti-competitive.
- **Other (please specify).** Designs suggested by a third party on the basis that they own an earlier design/right and the filing is an anti-competitive/bad faith filing in light of that earlier design/right.

10. **To what extent do you agree or disagree that limited searching would help combat the number of anticompetitive filings?**

- Agree.

11. **If better search tools become available to allow a search to be carried out quickly, do you think IPO should extend searching to other design applications?**

- No.
- We do not prefer that searches become routine as it will slow down the registration process, which is currently a real advantage of the system.
- Even with improvements in AI-driven search tools, it seems inevitable they will not be able to pick up all prior unregistered designs everywhere. As a result, having systematic searching for all applications risks giving a false sense of security to owners that their design registration is incontestable when it may in fact be invalid.

12. **If limited searching is reintroduced, would it provide you/your business with:**

- Both a benefit/opportunity and a challenge for our members' clients. The former being fewer anti-competitive filings and potentially stronger rights, but the latter being greater cost, more uncertainty and delay.

13. **If limited searching is reintroduced, would the impact on you/your business be:**

- Both some positive impact and some negative impact for our members' clients, for the same reasons as above.

Two-stage system

14. **To what extent do you agree or disagree that limited searching would help combat the number of anticompetitive filings?**

- Agree.

15. **If this option was introduced, should the pre-enforcement examination be limited to an assessment of novelty or should it include individual character?**

- Search should be limited to novelty, with what is new being considered also by reference to s1B(2) RDA (i.e. checking for identical designs or designs whose features differ only in immaterial detail).

16. **If this option was introduced, to what extent do you agree that litigation should be able to start prior to the search and examination, while allowing the defendant time to see results prior to filing their defence.**

- Agree, since the search must not hold up litigation, e.g. interim injunctions. Perhaps have the option for a defendant to be able to provide one piece of prior art for the purposes of the novelty check, which the examiner has to review together with whatever is the outcome of their own AI search.

17. **If a two-stage system is introduced, would it provide you/your business with:**

- Both a benefit/opportunity and a challenge for our members' clients. The former being fewer anti-competitive filings and potentially stronger rights, but the latter being greater cost, more uncertainty and delay.

18. **If a two-stage system is introduced, would the impact on you/your business be:**

- Both some positive and some negative for our members' clients, for the same reasons as above.

19. **Please provide any additional information or evidence relevant to search and examination. In particular we would like to hear about:**

We have seen the answer from CIPA on this question and agree with what they say, in particular about the five concerns they raise. However, we would not be in favour of adopting the Australian bifurcated system (registered/certified designs), which has many detractors amongst the Australian profession.

Some sort of post-registration search or opinion service from the IPO could have benefits in enforcement, without being obligatory. In particular, if registrants seeking to enforce their rights or potential defendants facing the threats of an infringement claim had the option of submitting the relevant design registration for a paid-for non-binding and (initially) confidential validity opinion, it could speed up the resolution of disputes on an amicable basis. The Australian approach of a third party paying half the search/examination fee and the applicant the other half, or the latter forfeits the application if not paid (as raised in CIPA's submission) is interesting and may be worth considering. Any opinion issued could be shared on a without prejudice save as to costs basis by the party relying on it to try to reduce the debate around validity that an unexamined right will necessarily have. Using AI-based search tools, the opinion would need to be available within a reasonably short period, e.g. two weeks.

Whether or not the above option is adopted, we believe it would be helpful to create expedited and low cost IPO post-registration invalidity proceedings for clear/straightforward cases (or when there is clear evidence of bad faith).

Section A2: Bad faith

20. **To what extent do you agree or disagree with the proposed approach to introduce an explicit bad faith provision for designs?**

- Agree.

21. **To what extent do you agree or disagree with each of the following? A bad faith provision would allow IPO to address:**

- **Applications for well-known products.** Agree.
- **Applications where another company's product photographs are used by a third party to seek protection.** Agree.
- **Applications which are re-filed for previously invalidated designs.** Agree.
- **Anti-competitive applications more generally** Generally agree, but less certain.

22. **If a bad faith provision is introduced, would it provide you/your business with:**

- **A benefit/opportunity** – Yes.
- **A challenge** - Don't know.

23. **If a bad faith provision introduced, would any impact on you/your business be:**

- **Positive** – Yes.
- **Negative** – No.

24. **Please provide any additional information relevant to bad faith.**

- The government could consider creating an equivalent to s32(3) Trade Marks Act 1994 ("**TMA**") (declaration of bona fide intent to use) to require applicants to confirm (in effect) they know of no prior novelty-destroying design such that a false statement in that regard renders the application made in bad faith.
- Query whether that could only apply to national applications or whether it could be extended to Hague Convention filings (although the equivalent has been incorporated into Madrid trade mark filings).
- The wording needs to be simple so that lay applicants can understand what they are signing up to. It will be hard to do this when seeking to cover off self-disclosure during the grace period and/or the concept of novelty generally. The alternative might be a declaration just to flush out the anti-competitive filing making the following statement, if falsely given, grounds to challenge the registration on bad faith: "*I confirm that I am either the proprietor of the design or have acquired rights in the design such that I believe I am entitled to file it*".
- The advantage of a general "bad faith" ground is that it would be wide enough to cover other potential misuses of the registration system. There is already an extensive body of case law on bad faith in the area of trade marks that could likely be applied by analogy.
- If such a provision is adopted, it would again be helpful to have an expedited, low cost invalidity procedure for straightforward novelty cases, or when there is clear evidence of bad faith. It would also be helpful to have a mechanism

to deal with multiple bad faith applications – i.e., a bad faith actor who files to register a large number of bad faith designs. This could perhaps be done through a single application form, or perhaps a discounted fee structure.

- A further option is to require applicants to be represented at the IPO by qualified and regulated professionals. If applications could only be filed by the applicant themself or a regulated professional, the number of bad faith filings would likely very materially decrease.

Section A3: Observation and Opposition

25. **Please rank the options in order of preference (1=most preferred, 4=least preferred):**

- Most preferred is Option 0 (Do nothing), provided it is combined with the option of a much cheaper and quicker cancellation process at any time (i.e. with no window of time to apply, as with oppositions) where there is clear lack of novelty or bad faith. The other options are not desirable. (Option 1- introduce a post-registration opposition period for designs ("registered at risk"); Option 2 – Introduce a pre-registration opposition period for designs; and Option 3 – Introduce an Observation Period).
- Consideration should be given to the IPO having the power, to be exercised sparingly and perhaps if notified of a bad faith design post-registration, to re-examine a registration at any time and without the third party having to take action (similar to the power the IPO has and occasionally uses for trade marks).
- The delays that arise in relation to trade mark oppositions (time to fix a hearing (12 months) and for delivery of decisions (8 months)) show that the IPO already has insufficient capacity to handle the current volume of trade mark disputes. As a result, there is a concern that introducing oppositions for designs will exacerbate the situation and create potentially material delays in a regime that is presently very quick.

26. **In your opinion, would these options provide an effective tool to address potentially anticompetitive or otherwise invalid designs being registered?**

- Options 1, 2 and 3 would not be cost-effective or beneficial overall, not least since a two-month period is too short for third parties, most of whom will not be monitoring the register, to react.

27. **How likely would you be to use the following options if introduced? (very likely, likely, neither likely nor unlikely, unlikely, very unlikely).**

- All of these assume prior rights owners will have a watch in place, but that's unrealistic for the vast majority of them (being SMEs) and perhaps even prejudices in favour of large rights owners. To have much impact, it would require a system of notifying prior registered design owners of potentially conflicting designs. But that adds a major burden to the system. It is better to stick to cancellations at any time (i.e. no deadline) while creating the fast-track option mentioned above.

28. **To what extent do you agree or disagree with the government's view that a two-month period for opposition or observation strikes the right balance between the needs of applicants and third parties?**

- Strongly disagree.

29. **Would publishing a design before registration cause you or your clients any problems if introduced?**

- Yes since it forces publication and does away with the deferral process, which has lots of benefits.

30. **Would publishing a design before registration cause you any problems when filing in other countries?**

- Again, yes if it undermines the deferral options, e.g. in EU and Switzerland.

31. **If an opposition or observation period is introduced, would it provide you/your business with a benefit or challenge: [to conclude after considering above]**

- Due to the small time windows within which these options are proposed to be exercised, we believe they all pose challenges to those that might want to rely on them.

32. **If an opposition or observation period is introduced, would any impact on your/your business be:**

- For the same reasons as above, possibly negative and at best neutral. The concern will be that an unchallenged application that is actually filed in bad faith may embolden the applicant.

33. **Please provide any additional information relevant to opposition or observation**

- The Paris Convention priority system protects against novelty-destroying disclosures during the priority period. Pre-registration publication in the UK would not affect the ability to claim priority in other jurisdictions.
- We do not consider it necessary or appropriate to introduce an opposition procedure for registered designs. Very few IP offices worldwide have such a procedure. Design watching is currently extremely expensive and available to few, so it may be difficult for impacted parties to become aware of the publication of designs for opposition purposes in a timely manner unless the IPO undertakes the watching and notifies potential opponents of possibly conflicting applications (which we do not advocate for costs reasons).
- The introduction of opposition periods would delay all applications for registered designs, at least doubling the time to registration. There could also be abuse from an opposition system: designs could be strategically opposed in order to delay them becoming enforceable rights. That could, for certain business sectors, mean the difference between effective design protection and no real protection at all, particularly given backlogs in hearings/Tribunal proceedings.
- In reality, the possibility to invalidate registered designs that are improperly granted is adequate in practice and is widely understood by all involved in the UK design legal ecosystem. It also has the advantage that the issue of validity is being considered by designers with direct experience of the relevant design field (and their advisers), rather than examiners who may have no such experience.

34. **Several options for addressing anticompetitive filings have been set out above. Do you (select appropriate) think:**

- **It would be useful to users to have different ways of addressing anti-competitive behaviour** Yes.
- **Having different ways to address anti-competitive behaviour would unnecessarily complicate the legal framework?** They don't have to.

35. **Which options should be introduced (please tick all that apply)**

- **Search and examination** Yes.
- **Bad faith** Yes.
- **Post-registration opposition** No.
- **Pre-registration opposition** No.
- **Pre-registration observation** No.

Section A: Assessment of impacts

36. **Do you agree with our assessment of the impacts as set out in Annex 2?**

- Yes.

37. **Are there any impacts which we have not been included but should be?**

- Yes.

38. **Please supply any relevant information which you consider would be useful and help us assess the impacts of the options.**

- Whilst there is a lack of reliable and low-cost design search and watching tools that SMEs can access (or might even get to know about), we believe caution should be exercised in introducing changes that assume such tools are in widespread use or soon will be. If the IPO were able to follow the EUIPO's example in making any search technology it develops available for third parties without charge, then the position could change. But that would require a major investment by the IPO.

Section B: Deferment

39. **To what extent do you agree or disagree with the proposal to introduce an 18-month deferment period:**

- Disagree. Our members' strong preference would be to align with the EU 30-month period, which is the maximum period permitted by the Hague system.

40. **To what extent do you agree or disagree with the proposal to start the deferment period from the earliest date of the application?**

- Agree.

41. **To what extent do you agree or disagree that both registration and publication should be deferred?**

- Strongly disagree. We do not see a benefit that encourages design innovation in the UK by allowing for deferral of the registration just because the publication is to be deferred. The benefit of the latter without the former is that a designer can protect parts of a more complex design and use the deferral system to further deter would-be copyists. By having the registration for the whole product published immediately and then choosing to defer publication of registrations relating to particular parts of the product leaves a would-be copyist unsure about which parts can more safely be copied and which may be the subject of the unpublished registered design. It is an extra deterrent benefiting the designer of novel designs with distinctive character (or parts thereof). However, it only works if an enforceable registered design can exist before it is published. That arises under EU law and should be mirrored in UK law, namely infringement by copying an unpublished but registered design (see Article 19.5 EUDR).

42. **In your opinion, which information should be published about a deferred design (please tick all that apply):**

- The EUIPO limits the particulars which are published for deferred designs to the design number, filing date, registration date and the names of the applicant and the representative, if any. We consider that the priority date and the addresses of the applicant and (where applicable) representative could also be added, but would caution against including details regarding Locarno class or subclass, as that could give away details of the design filing that the owner may wish to avoid by requesting deferment.

43. **Anything else (please state)**

- No.

44. **To what extent do you think it would be useful to extend prior use provisions?**

- We agree that it is fair to protect a truly innocent person using a design that they have not copied and which then turns out to be registered, which they could not have known about before it was published.
- This should be aligned with the rights of prior use set out in Article 22 EUDR.

45. **Would extending prior use provisions provide you/your business with:**

- Don't know if it would provide a benefit/opportunity and/or a challenge.

46. **Would the impact on your/your business of extending prior use provisions be:**

- Don't know if it would provide a positive or negative impact.

47. **Please provide any additional information relevant to the government's proposal for a formal deferment provision in designs law.**

- Aligning the UK design deferment period with the EU's 30-month term (and the maximum available under Hague) would streamline portfolio management and better serve businesses operating across both markets. The significant disparity between UK and EU deferment deadlines creates

unnecessary complications, forcing businesses to withdraw UK applications and refile later, resulting in additional costs, administrative burden and risks. The impact assessment should quantify these costs and compare them against the benefits of harmonisation.

Section B: Assessment of impacts

48. **Do you agree with our assessment of the impacts as set out in the annex?**

- Don't know.

49. **Are there any impacts which we have not been included but should be?**

- Don't know.

50. **Please supply any other relevant information which you consider would be useful to help us assess the impacts of the options.**

- None.

Section C - Graphical User Interfaces and Animated Designs

51. **Do you register animated designs/GUIs?**

- Yes, our members do so on behalf of their clients.

52. **If yes, how many animated designs/GUIs have you registered in the last 12 months maybe n/a**

- Don't know.

53. **If yes, do you think the current system is fit for purpose for registering animated designs/GUIs?**

- No. We have seen the submission of CIPA and agree with their response to this question.

54. **Do you agree that "do nothing" should be discounted?**

- Yes.

55. **Do you think the current definition of a design within the RDA meets the needs of applicants who want to protect animated designs and GUIs?**

- No. We have seen the submission of CIPA and agree with their response to this question.

56. **Do you think the current definition of a product within the RDA is adequate?**

- No.

57. **Would you be in support of the UK amending the definition/s of a product and/or design?**

- **Product** – Yes.

- **Design** – Yes.

58. **If yes, do you think we should make similar changes to the EU?**

- Yes. We have seen the submission of CIPA and agree with their response to this question.

59. **Would you be in support of the UK extending the rights in a registered design to prohibit creating, downloading, sharing or distributing to others any medium or software which records the design, (similar to the EU)?**

- Yes.

60. **Should IPO accept file formats which show movement and animation?**

- Yes.

61. **Should IPO accept 3D computer-aided design file formats?**

- Yes.

62. **If yes, which file types should we accept? Please tick all that apply**

- All currently available file types.
- We do not support the use of an exhaustive list. Instead, in line with the EU reform, we propose that the legislation allow for generally available technologies. The IPO could update a list from time to time, according to technological advances in formats.

63. **How problematic do you feel the following would be when protecting a design using a video or CAD file format?**

- **Claiming priority** Somewhat problematic.
- **Displaying the registered design on the register** Not problematic.
- **Displaying the registered designs on the registration certificate** Somewhat problematic.
- **Certified copies** Somewhat problematic.
- **Visual disclaimers** Very problematic.

64. **Would any potential issues claiming priority be overcome by being able to file a sequence of still images alongside a video or CAD file?**

- Yes, but only if video or CAD file is filed as additional information.

65. **Under our Public Sector Equality Duty, we do not expect any significant equality impacts from this change.**

- Don’t know.

66. **If no, please share any relevant evidence or concerns.**

- n/a.

67. **Would you find it useful to file a description to describe an animation or transition?**

- Yes.

68. **Do you think that such a description should be published as part of the registration:**

- Yes.

69. **Do you think that the scope of protection of a design should be assessed in light of the optional description?**

- Yes, but it should only be an interpretative aid, as it is under EU design law. It can narrow a monopoly but cannot expand it.

70. **What would the impact be of allowing a description to be filed as part of an application?**

- **Understanding the register** Easier
- **Carrying out due diligence** Easier
- **Filing in the UK based on a foreign priority**. No change
- **Filing abroad based on a UK priority**. Don't know.

71. **Which options do you think we should introduce?**

- Additional guidance.
- Amend the legal definitions of a design a product.
- Increase the file formats available to users.
- Publish description as part of the registration.

72. **Please provide any further comments you wish to make about protecting animated designs and graphical user interfaces**

<u>On Practical Filing Considerations</u>

- The current requirement to represent animated designs and GUIs through sequences of static images is inadequate for capturing dynamic elements that constitute the design's individual character. OBJ, STL and X3D are widely-used 3D file formats supported by most CAD software. MP4 and WebM are standard video formats suitable for animated designs and GUIs.
- Current practice shows that major tech companies which are regular design applicants use dotted lines for visual disclaimers. However, it is often not clear what they tried to protect. This practical uncertainty demonstrates the need for clearer guidance on disclaimer practice. Rule 6 of the Registered Designs Rules 2006 permits applicants to use disclaimers to limit the scope of protection granted to particular aspects of a design, with applicants having a choice of how best to show disclaimed elements through graphic effects such as blurring, colouration or broken lines, or through explanatory text. The current flexibility is valuable but would benefit from clearer best practice guidance to ensure consistent interpretation. The guidance in the common practice of the EU IP Network CP6 is helpfully clear. Adding this as a practice note or in the Manual would help applicants make fewer errors.

- Clearer guidance on how GUI elements contribute to overall impression would improve certainty and clarity relating to the validity and unity of the design. The question is about the scope of protection and how the overall impression is assessed in practice, particularly whether icons, text and other elements play a role. This uncertainty affects filing strategy and enforcement decisions. When making the comparison, it is important to compare like with like and ignore additional material such as branding that appears in the allegedly infringing product but not in the design being enforced, though where branding is included in the registered design it should be taken into account in assessing the overall impression because it forms part of the design.
- Guidance specific to GUI assessment (which we know has already partly been developed, at least in terms of the registrability/unity of design) would assist both applicants and the IPO in determining appropriate scope of protection. Where there is limited design freedom, small changes will create a different overall impression on the informed user, whereas where there is a lot of design freedom, small changes will not be sufficient to create a different overall impression. This principle is particularly important for GUIs where design freedom may be constrained by user interface conventions and technical requirements.

<u>On definitions</u>

- Unless there is an express reason of benefit to the UK and UK businesses not to do so, including undermining existing IP protections in the UK, any revisions to the design systems should preferably align with the recent EU reform in relation to the new definitions of designs and products. Amending both definitions would provide comprehensive protection for digital designs whilst maintaining harmonisation with the EU system. Maintaining divergent design protection strategies in the UK and EU creates unnecessary complexity, uncertainty and increased costs for businesses operating in both markets. Changes should apply to both registered and unregistered designs.
- Clearer definitional boundaries would assist applicants in understanding what aspects of their digital products qualify for design protection. For example, it could be clearer that GUIs, even for interactive or animated interfaces where functionality and appearance are closely intertwined, do not fall within the unprotectable computer program term.

<u>On priority</u>

- Priority claiming presents challenges because foreign offices may not accept video or CAD files, requiring conversion to static images. Display on the register can be addressed through embedded viewers. Visual disclaimers are particularly problematic for video and CAD formats where specific elements cannot easily be marked as disclaimed. Filing both static images and dynamic files would enable priority claims based on the static images whilst preserving the benefits of video or CAD representation for the UK registration. This hybrid approach accommodates current international practice whilst enabling more accurate representation.

Overall

- Revisions should preferably align with the recent EU reform in relation to the new definitions. Comprehensive protection for GUIs, animated designs, icons and other digital design elements is needed. A comprehensive approach combining definitional amendments, expanded file formats and optional descriptions would provide more robust and flexible protection for digital designs.

Assessment of impacts

73. **Do you agree with our assessment of the impacts as set out in the annex?**

- Don't know.

74. **Are there any impacts which we have not been included but should be?**

- Don't know.

75. **If yes, please briefly explain which additional impacts should be included.**

- n/a.

Section D: Computer-generated designs

76. **Do you agree that the existing computer-generated designs provisions should be removed?**

- No. This is not least since those provisions (s 214 and s263 CDPA) relate to authorship and ownership (and are helpful in that regard) rather than to subsistence and registrability.

77. **Please explain your answer and provide relevant evidence.**

- We have seen the submission of CIPA and we agree with their response to this question.
- The protection encourages innovation using AI, which is a positive thing. However, the provisions need to be reformed to ensure that they are not contradictory when it comes to 'originality' in unregistered designs and also, so it is clear where the line is as to what counts as being 'computer generated'.
- However, if following this consultation, the protection for computer-generated provisions is removed, an express provision should be included in the legislation making it clear what exactly is being removed to avoid any confusion.

78. **If the existing computer-generated designs provisions are retained, do you agree that an equivalent provision should be introduced for supplementary unregistered design law?**

- Yes.

79. **Do you agree that the same approach for protecting computer-generated designs without a human author should be taken for registered designs, supplementary unregistered designs and UK unregistered designs?**

- Yes.

80. **If not, why not?**

- n/a.

81. **Have you ever knowingly relied on the existing computer-generated designs provisions to protect your designs?**

- Don't Know.
- We are aware of some businesses relying on these provisions and believe that there will be a desire to increasingly rely on the provisions due to the opportunities to use AI and other software to generate content and designs.

82. **Would you be impacted if the existing computer-generated designs provisions were removed?**

- Yes.

83. **If you think you would be impacted by removal of the existing computer-generated designs provisions, please provide evidence to support this:**

- We have seen the submission of CIPA and we agree with their response to this question.

84. **Do you think there is conflict between the computer-generated designs provision in UK unregistered design law, and the requirement for UK unregistered designs to be original?**

- Yes, there potentially is a conflict because for a design to be original there needs to be a level of minimum human effort or skill so as to incorporate the author's own intellectual creation. This will not always be present with computer-generated designs, particularly when AI has been used to do the majority of the work, potentially even to draft the prompt which is then, without further human review and amendment, used to instruct the AI software to create the design.
- This conflict has been highlighted in the recent High Court judgment in *J Mac Safety Systems Ltd v Q Deck Safety Systems Ltd [2024] EWHC* confirming that the originality requirement in s213 CDPA for UKUDR is the same as that applying to s1(1) CDPA for copyright, i.e. the EU *Infopaq* test which necessarily needs a human giving intellectual input.

85. **Do you think that the computer-generated designs provisions should be reformed to address this issue, or for any other reason?**

- Yes.

86. **Please explain your answer, including how the provisions should be reformed if you chose 'yes', and provide relevant evidence:**

- If any element of the UDR is retained, the law needs to be reformed to clarify:

- What will be considered 'original' in the context of unregistered designs that are computer-generated. There are cases where it seems fair for computer-generated designs to be deemed 'original', for example, where AI has been used and there has been significant refinement of the product that the AI has produced or where significant time has been spent producing a unique and highly detailed prompt for the AI software. However, cases where a very simple prompt has been used and the product of the AI has been unchanged, it seems less clear where the minimum level of skill or effort is.
- The meaning of 'computer-generated' as distinct from 'computer assisted'. s263(1) CDPA defines the former by reference to the design being "*generated by computer in circumstances such that there is no human designer."* If the term is still be used at all, it should now preferably specifically address designs created using AI for the writing the prompt and/or generating the design.

- If UDR is to be ended, such that only SUD remains, then this conflict goes away as there is no originality test for the latter.
- While the Law Society advocates for the removal of UDR protection, the IPLA membership remains split. As there is divergence of stakeholder views, we recommend that any government proposal that may reduce the scope of unregistered rights be preceded by a comprehensive impact assessment.

87. **Should the IPO collect information about the use of AI in the creation of a registered design as part of the application process?**

- No. We consider that even AI-generated designs should be protected by registered or unregistered rights so long as they meet the novelty and individual character test. If that were to be the position going forward, the information is irrelevant. Even if the UK chooses to deny design protection for computer-generated designs, simply answering in the positive whether a design was created using AI will not, alone, determine its registrability. More information would be needed, which would bog down the application process.
- The question would also be irrelevant if UDR is to be ended, as we propose.
- The reality is that designers are already using AI widely and this is only likely to increase. To ask applicants if AI has been used at all in the creation of their design will increasingly yield positive answers but it is unclear what is then to be done with that information. There may also be many varying degrees of AI involvement in a design. The question could leave many unsure how to answer it since they may not know to what extent someone in a design team used some software that might have involved <u>some</u> element of AI. They will not understand the difference between computer-assisted and computer-generated.

88. **If yes, do you think supplying this data should be mandatory?**

- n/a.
- It may not be possible to gather this for Hague filings anyway and there would then be an unworkable disparity between Hague filings designating the UK and national applications.

- If supplying the information is optional, it seems likely that those making applications would not choose to share this information, especially if the use of AI is information that is made available to the public.

89. **What information do you think should be collected and why? If you think it should be mandatory to supply this information, what would be the appropriate sanction for not supplying it or supplying it incorrectly, if any?**

- n/a

Section E: Miscellaneous Changes

90. **Do you agree that an express provision should be introduced to allow an objection to be raised to matter prohibited in law contained in a design application?**

- Yes.

91. **If not, why not?**

- n/a

92. **Do you agree that the registrar should be able to object to both substantive and formalities issues in the same examination report?**

- Yes.

93. **Do you agree that the that time limit for responding to both types of objections should be harmonised at 2 months?**

- Yes.

94. **If not, why not? Limited text box?**

- n/a

95. **Do you agree that the filing of a physical specimen as part of a registered design application should be disallowed?**

- Yes.

96. **If not, the reason is that:**

- n/a

97. **Do you agree that the registrar should be allowed to share an application before publication for the purpose of carrying out his statutory duties?**

- Yes.

98. **If not, why not:**

- Appropriate safeguards should ensure sharing occurs only for statutory purposes and that confidentiality is maintained, especially during any period of deferred publication.

99. **Do you agree with the proposal to introduce a provision to allow the registrar to raise objections to matters coming to his attention after an opposition period, should the government introduce one in future?**

- Yes, if used sparingly (subject to the above that we do not support an opposition period).

100. **If not, why not?**

- We do not agree with introducing an opposition period.

101. **Do you agree that warrant of validity and liability provisions should be similar across trade marks, patents and designs?**

- Yes.

102. **If not, why not?**

- n/a

103. **Do you agree that the Registered Designs Act 1949 should be amended give the registrar of designs the power to rectify the designs register?**

- Yes.

104. **If not, why not?**

- n/a

105. **Do you think the power should be limited or have safeguards? For example, limited to rectifying specific issues (eg only entitlement/ownership) or in particular circumstances (eg only unopposed requests, or with agreement of both parties)**

- Yes, the power should be limited to unopposed requests or situations where both parties agree, with specific provisions for correcting clear errors. Contested rectification matters involving substantive rights should be resolved by courts or tribunals with full procedural protections.

106. **Should the Act be updated to reflect that representations for currently registered designs are made available online?**

- Yes.

107. **How important is it to you to have access to historical design records (important, neutral, unimportant).**

- Important.

108. **Please provide reasons or your answers**

- Historical records support invalidity proceedings/allow competing designers/market participants to know where they stand.

109. **Should the registrar be able to direct forms for any purpose relating to the registration of a design and any other design proceeding?**

- Yes.

110. **If not, why not**

- n/a

111. **Please rank the options for dealing with designs priority claims in order of preference:**

Option 0: Maintain current practice (do nothing). Second preferred.

Option 1: Only require details of a priority claim. Do not require a declaration of identicalness or a priority document. Least preferred.

Option 2: Require details of a priority claim and a priority document whenever a priority claim is made, once the IPO has joined WIPO DAS for designs. Most preferred.

An issue with both Options 0 and 1 is that they can make it very difficult for a third party to assess the validity of any asserted priority claim, due to there being no copy of the priority document on the file wrapper. This makes it very difficult to assess the effective priority date for the design registration in question. It is considered that this requirement for third party certainty should take precedence over the convenience of the Applicant who, currently, , is not required to provide such evidence of their priority claim as part of the initial application process.

The current Option 0 approach is also considered open to interpretation as to what is considered sufficiently 'identical' for the purposes of the declaration of identicalness (for instance, is the omission of a view from the priority document, or a correction to one of the lines from the views of the priority document, still considered 'identical' as far as this declaration is concerned?)

The selection of Option 2 is thus considered not unduly limiting to Applicants, on the added assumption that the UK design registry is committed to its intentions on acceding to the WIPO Digital Access Service ("**DAS**") as soon as possible.

112. **If the IPO introduces searching for designs, do you agree that the IPO should be able to request a copy of the priority document where the validity of the priority claim is relevant to the novelty or individual character of the design being examined?**

- Yes.

113. **Please provide any additional information relevant to priority claims.**

- We have seen the submission of CIPA and consider their suggestions raise interesting ideas that should be considered and discussed more widely.

Section F: Simplification of unregistered designs and overlap with copyright

- We are conscious that it could be difficult to simplify the UK system while preserving pre-existing IP protection. Any proposal that results in the erosion

of the current scope of protection for unregistered rights, including copyright, should be supported by a comprehensive impact assessment.

- The Law Society advocates that it would be preferable to simplify the protection of designs in the UK, preferably with one registered and one unregistered design right, with the qualification, subsistence, ownership and validity provisions aligning for both. To the extent any existing rights are to be abolished, suitable transitional provisions need to be implemented so that existing rights holders are not prejudiced and traders can have a clear understanding of when rights expire.
- IPLA members are split between the Law Society position and a position that avoids any loss of pre-existing rights purely for simplification purposes.
- The overlap with copyright, in particular in relation to works of applied art, gives rise to complicated questions to which we do not have answers. We believe this needs to be the subject of more consideration and analysis, in particular impact analysis, before specific recommendations regarding reform of copyright law in this area are then made. The present interpretation of copyright law runs the risk of rendering unregistered design law somewhat redundant, in particular as regards attempts to limit to the duration of unregistered rights to a period shorter than protection for designs protected by registration.
- The views expressed in this response reflect answers that our respective organisations felt able to express collectively and we have highlighted where our respective organisations were unable to reach consensus. It is clear there are many differing views even within our organisations to some of these answers, further supporting the need for a comprehensive review before substantive amendments are made to the scope of unregistered rights and copyright.

114. **Do you agree that the options above should be discounted?**

- Yes

115. **If not, which option do you think we should consider further:**

- **Abolish SUD and retain design right.** No. Doing so may put the UK in breach of Art 247.1 of the EU-UK Trade and Cooperation Agreement.
- **Abolish unregistered designs and extend copyright.** No. We do not advocate any legislative changes that change copyright protection and abolish unregistered designs without first conducting a comprehensive impact assessment and, ideally, a detailed review along the lines of the Hargreaves Review, steered by an independent expert.
- We note that, now that the UK is no longer part of the EU, s52 CDPA could be reinstated to reduce copyright protection for artistic works exploited industrially. There is a divergence of views between the Law Society and the IPLA on whether such reinstatement must necessarily retain the 25-year cap on duration. The Law Society suggests that a different (and possibly shorter) cap could be considered, perhaps to align it with, or perhaps just closer to, the duration of whatever unregistered design rights are to exist in future.
- The reinstatement of s52 could potentially be further justified in light of Article 23 EUDD, which it might be argued has restored Member States' discretion to determine the conditions under which copyright protection subsists in designs. The position on that is unclear but, if that is the effect, then this legislative development would effectively supersede the CJEU's decision in

Flos v Semeraro Casa e Famiglia SpA (C-168/09). That was the case that led to the repeal of s52 in the first place (because it forbade different copyright protection being given to different types of work, i.e. the shortened duration for artistic works).

- For the avoidance of doubt, we are not necessarily advocating for the reinstatement of s52 CDPA. We simply highlight that the UK can now consider doing this unilaterally, as it is no longer in the EU, and might also consider whether to reinstate it as it was or with a different cap on duration.
- **Keep the system the same and provide improved guidance** No

116. **Which of the following is more important to you:**

- It is not a binary choice between maximum protection and maximum simplification. Considerable simplification should be a goal but without prejudicing existing rights holders and ensuring the new rights can arise in most, if not quite all, circumstances where previously protection would have arisen.

117. **Rank the options in in order of preference**

- Preferred option is **Option 2 (Consolidate the unregistered designs framework (maximum protection)**
- Next preferred is **Option 0 (Do nothing and maintain the current system)**
- Then **Option 1 (Retain supplementary unregistered design, abolish design right (maximum simplification))**

118. **Would harmonising the following aspects make it easier for you to use the system?**

- **Qualification requirements** Yes.
- **Term of protection** Yes.

119. **Do you agree that a single qualification requirement should apply to both aesthetic and functional aspects of a design?**

- Yes, although we consider this dichotomy to be false. Design law protects the appearance of a product or part of a product – without reference to aesthetics. Features of a design **solely** dictated by technical function are not protected. But it is not right to say that there are separate requirements for aesthetic and functional aspects of a design.

120. **Do you agree that a single term of protection should apply to both aesthetic and functional aspects of a design?**

- Yes, but see above.

121. **If term of protection is harmonised, how long should it be (please choose preferred option):**

- We had differing views amongst our organisations. The clear view was that 3 years is too short (with the right having expired by the time any litigation is concluded) and something nearer to 7 years, or perhaps 10 years (a period mentioned in TRIPS), may be more appropriate. However, the conclusion was that this needed more careful investigation and analysis of the

reasonable period of time during which a designer should be able to profit from their design and the needs of fair competition to meet reasonable consumer demand.

- The choice of 15 years as the longstop for UDR dates back to when the maximum duration of registered designs was 15 years, i.e. the intention had been to align the two. On that logic, the current period of duration for unregistered designs could potentially be justified at 25 years. The Law Society and IPLA have differing views on this, with the former inclined to think it should be less than 25 years. However, that duration may appear less excessive when compared with the 70-140 years of additional protection that copyright can provide to designers and their descendants.

122. **To what extent should unregistered design be harmonised or consolidated?**

- **Harmonise some legal provisions but keep separate regimes** While this would not address the widespread call for simplifying the system, it is the least likely to result in loss of IP protection.
- **Create a single right which is harmonised in some respects but where different provisions may apply to aesthetic and functional aspects of a design** Any such approach would need to avoid creating more confusion and blurring of lines as between the two types of designs.
- **Create a single right where the same provisions apply to both the aesthetic and the functional aspects of a design** The Law Society and some IPLA members see merit in creating one single right that protects the same designs that can be the subject of registration, i.e. aligning unregistered rights with the SUD. This has the advantage of harmonising UK law more closely with EU law, which will be simpler for business, including UK exporters. Given the lack of consensus within the IPLA on this point, we advocate for a comprehensive impact assessment before to any proposed changes that might affect the scope of protection.

123. **Do you agree that the SUD legal framework should apply to a new consolidated unregistered design, if introduced?**

- Yes, provided that it also adopts the latest EU reforms made by the EUDD and/or Regulation (EU) 2024/2822 (which amended the EUDR)

124. **Do you agree that the repair/spare parts provisions should be harmonised across all different types of design protection?**

- While our members see the benefit of harmonisation, they are not aligned on this point because of the potential erosion to current protections. Our organisations are reluctant to see any loss of rights for designers, but The Law Society, and not the IPLA, considers that this should not be ruled out completely. The Law Society's view is, however, that, if there is to be any loss of rights at all, suitable transitional provisions should be put in place so as to minimise the commercial prejudice to designers..

125. **If yes, we should use the provisions currently used for:**

- Supplementary unregistered designs, but reflecting the latest EU reforms, including Art 19 EUDD.

126. **Do you think that design protection for a component part of a complex product should be limited to features which are visible in normal use.**

- The members of our organisations are not aligned on this point.
- Clearly this amounts to a removal of protection for functional, non-aesthetic designs (so which do not attract copyright) for component parts of complex designs that are not on show when used, e.g. the underside of a car's floor pan.
- Our organisations are reluctant to see any loss of rights for designers.

127. **Do you think that design protection for any product should be limited to features which are visible in normal use.**

- No. In this respect, we prefer to see alignment with Recital 16 EUDD. The "visible whilst in normal use" expression was introduced so as NOT to provide design protection for spare parts for automobiles, in order to encourage competition in that market. It should not be extended to other designs.

128. **How important to you is the ability to protect the internal configuration of a product?**

- This is something better answered by our members' clients. However, good design merits protection. How a product is configured, even if not a visible part, can have involved very skilful design which has value (perhaps just in reducing manufacturing costs or the volume of materials used). There may well be good reasons to want to prevent a competitor from using those designs.
- We believe the summary in the consultation document is not correct. There is nothing in current registered design law or SUD law which says the internal configuration of a product (e.g. a chicken coop) is not protected, so long as they are not component parts of complex products (i.e. spare parts). So, the internal appearance of a fancy ice-cream cake is protected, as is the design down the centre of a stick of Brighton rock.

129. **Are there any elements of the design right regime which you think should be used in a consolidated right, rather than going fully with SUD regime?**

- Potentially but we have divergent views amongst us.
- Rather than adopting the SUD as it presently exists, we would prefer to see adoption also of the new reforms implemented into EU unregistered design right.
- Consider also adopting the innocent infringer regime of UK unregistered design right (s.227(1) CDPA).

130. **Please provide any additional comments in relation to simplification of designs here:**

- n/a.

131. **Do you find the number of legal instruments relating to design law confusing?**

- We do not but our members' clients do.

132. **Do you think the government should consider consolidating designs law into a single piece of legislation?**

- Yes

133. **Please provide any additional comments in relation to consolidation of designs law here**

- It would be preferable to have one single Designs Act, covering both registered and unregistered designs.
- Such reform should preferably not be done in isolation from reform of the CDPA and the protection given to product designs under copyright law. That needs a focused review and analysis of the market and legal needs.
- Consideration should also be given to the protection that is supposed to be available for 3-dimensional shapes as trade marks. The reality is that UK judges and the IPO are very reluctant to accept that such marks can be and are validly registered. The threshold for validity is set so high (with "reliance" being the *de facto* test) that few, if any, such marks are registered or survive challenge. In addition, if the shape has been the subject of registered design protection, it can currently disadvantage the owner of that right when seeking to secure trade mark protection for the shape or enforce that right if granted, e.g. inviting invalidity challenges that the shape gives substantial value to the goods (s3(2)(c) TMA – see *London Taxi v Fazer-Nash* [2017] EWCA Civ 1729 Floyd LJ at para 73 and the first instance decision of Arnold J [2016] EWHC 52 (Ch) at para 214-215]. In practice, s3(2)(c) TMA causes considerable confusion and it is unclear what harm it is seeking to prevent. Consideration should be given to abolishing it as a ground for invalidity/challenge.

134. **Do you think there is still confusion about items protected by copyright and design rights following recent case law?**

- Yes. The consultation appears to presume that the *Waterrower* judgment is definitive of the legal position. Many consider that it may not be and that another court, in particular an appellate court, may revisit the test. In particular, it remains open for a senior court to rule that the EU test of originality and the CDPA categories of protected works can be reconciled. (Note that the consultation gave the wrong link for the *Waterrower* case. The link was to the judgment dismissing the summary judgment application here, instead of the IPEC judgment at [2024] EWHC 2806 (IPEC) which is here.)
- For now, it is wholly unsatisfactory to be weighing up a multitude of amorphous facts to determine if copyright subsists, e.g. the creator's (artistic) intention, how much craft and how much artistry must the creator be exercising to meet the requirements, whether those skills must exist in one person or can arise from a separate team of one or more artists and one or more crafts people, whether a shape might be a sculpture, and whether it has aesthetic or eye appeal. In particular, trying to ascertain whether a designer intended to "produce something of beauty which would have an artistic justification for its own existence" as distinct from a "commercial development…with a design of aspirational sensory impact" adds unnecessary complexity to the law and denies protection for designers in the UK when it would be given in the EU.

- Any future review of copyright law in this area should not only revisit the appropriateness of the closed list of types of work in s4(1) CDPA but also the duration of copyright for works that can be protected by design rights.

135. **Are there other changes to the copyright framework which could be considered under Option 4?**

- Yes. An alternative is to adopt the EU approach of not having an exhaustive list of categories of copyright protected works so that, provided the originality threshold is met (of an author's own intellectual creation), a work will merit protection. Aesthetics and an artist's intentions then do not come into play. However, this calls into question the need for an unregistered design right system if the duration of copyright protection were to remain at life + 70 years. It is that duration and the lowering of the threshold to qualify for copyright that has arguably led to a loss of equilibrium between the various rights.
- We do not recommend changing s4(1) CDPA without that being a conclusion based on a comprehensive review of copyright law, with some focus on these works of applied art.

136. **Are there exceptions in the copyright framework which could be added, amended or removed to provide more balance in the system to add to Option 5?**

- Possibly. We refer to our response at 115 above regarding s52 CDPA.
- It would be preferable to align the defences to design right claims to those of copyright where relevant. This is in line with the reforms made by Art 18(1)(e) EUDD.

137. **Do you prefer:**

- **Option 3 - Make no changes to copyright legislation** No.
- **Option 4 - Amend copyright legislation** No.
- **Option 5 - Update copyright exceptions** Yes.
- None of these.

138. **Please provide any additional comments in relation to copyright here:**

- In terms of the update of exceptions, see our response above at 115 regarding s52 CDPA. In addition, we agree that a spare-parts exception should be introduced to align it with design law. We do not see the need to amend s62.
- Given the complexity of this issue, the Law Society and IPLA consider that a separate consultation on the overlap between designs and copyright is needed.

<u>Section G: Post-Brexit issues relating to unregistered designs</u>

- We note that the consultation makes an assumption that "*A single disclosure does not give rise to [UCD and SUD] protection in both territories.*" This is arguably an overstatement. It later says that there is uncertainty, and that the issue is "*untested in the courts*". We agree with that.
- We have seen the initial remarks of CIPA and agree with their careful and helpful analysis. In addition, we note that Article 110a para 5 sentence 2 of

the EU design regulation has been deleted in the new reforms. It was that wording that had led some (including the German Supreme Court) to conclude that first disclosure within the EU was the pre-requisite to creation of the EU unregistered design right. That might potentially lead the CJEU to reach a different conclusion now. As a result, we would not wish the UK to take a position that might even push the CJEU back towards the German Supreme Court's interpretation.

- In any event, we consider that, whatever position has been adopted in the EU, that should not determine the position we adopt in the UK as regards the geographic disclosure parameters to qualify for UK unregistered design rights going forward.
- The reality is that the UK's past attempts to secure reciprocity through its unregistered design right law have failed. It seems clear that whatever position the UK adopts now will not change the EU's position. Furthermore, UK designers are bound to see more value in securing rights in the larger EU market if forced to choose between that and doing what is needed to secure protection in the UK.
- Accordingly, it would seem preferable, and considerably simpler, if the UK right were to be created upon first disclosure anywhere in the world and its duration measured from then.

139. **Do you agree that the options above should be discounted?**

- Yes.

140. **If not, which option do you think we should give further consideration to:**

- **Seeking reciprocal recognition of disclosure with the EU**. No, see above how that has failed in the past.
- **Allowing any disclosure abroad to give rise to SUD** Potentially yes, but only if it is not obscure (i.e. it would not come to the attention of relevant people in the UK). The advantage of this is that a UK designer who first disclosed their design not in the UK will be protected and can have rights to enforce against a third party that saw the design in that third country and launches their own copy in the UK before the designer does. The designer should not have to launch in the UK in order to trigger an enforceable right. The designer should have the option to pursue a claim based on an unregistered UK right in any event.

141. **Do you agree that the options to seek reciprocal recognition of disclosure with the EU and allowing any disclosure abroad to give rise to SUD should be discounted?**

- We agree that seeking an agreement on reciprocal disclosure with the EU is unlikely to be viable. However, this could be something to raise in discussion at the Trade Specialised Committee (under UK-EU TCA). This would also potentially rule out disclosures elsewhere in the world being relevant, which might not be what the UK would want (eg if other countries offer design protection where disclosure occurs in the UK).
- Since copying is a requirement for infringement, there may be less concern about allowing <u>any</u> disclosure abroad to give rise to SUD.
- Whatever option is chosen, it would seem beneficial to aim for a regime that encourages or at least does not discourage UK trade shows / disclosures.

142. **Please rank the options in order of preference (1 = most preferred, 5 = least preferred)**

- **Option 0 - Do nothing** 3.
- **Option 1 - Unilaterally recognise simultaneous disclosure in law** 2.
- **Option 2 - Introduce a grace period** 5 (seems too complex, see below).
- **Option 3 - Creation of SUD following first disclosure anywhere in the EU** 4 (unless EU confirmed that the converse was true for its unregistered EU design).
- **Option 4 - Creation of SUD following first disclosure anywhere in the world** - 1.

143. **If a simultaneous disclosure provision is introduced into UK law, should we recognise simultaneous disclosures made in:**

- Anywhere in the world.

144. **What should constitute simultaneous disclosure:**

- **At exactly the same time** Yes, if reasonable allowance is made for slight delays in electronic transmission. Essentially, live simulcasting or disclosure on the internet/online should be treated as simultaneous.
- **Within the same hour** No.
- **Within the same day** No.
- **Within a longer period of time (please specify)** No.
- Don't know/N/A

145. **Do you think a grace period should be introduced for unregistered designs?**

- Don't know. This may require further review and analysis. It would seem preferable to have a single date to have to work with, namely when the design was first made available anywhere. It is then clear when the right arose and from when the duration runs. As noted above, we do not believe a designer should have to launch/disclose in the UK against a third party's copy in order to have an enforceable right.
- The introduction of a grace period may be impractical as it may be unclear when the relevant disclosure was made so the date of commencement of protection (and the consequential validity of the UK right) may be in question.

146. **If the government introduces a grace period for unregistered designs, how long should this be?**

- Don't know. We think any grace period would add unnecessary complexity to the system.

147. **If we allow disclosures abroad to give rise to SUD, should we recognise disclosures:**

- Anywhere in the world.

148. **To what extent are you concerned about asymmetry i.e. other jurisdictions not reciprocating any measure the UK introduces?**

- Unconcerned.

149. **Please provide any further relevant information which you think will help us assess which option to take forward.**

Section H: Call for evidence on criminal sanctions for design infringement

150. **E1: For the infringement of registered designs rights, what has been your experience of the typical costs, duration, remedies sought, and outcome associated with pursuing an infringement dispute?**

- Costs: Above £50,000 if litigating. But potentially under £10,000 (and even £5,000) if just sending a cease and desist letter and resolving out of court.
- Duration: 12-18 months, but potentially within a month or so if addressing out of court.
- Remedies sought in a court action:
  - Damages
  - Account of profits
  - Delivery up or destruction of infringing items
  - Final injunction to prevent infringement in the future
  - Publication of the judgment
  - Interim remedies
- Remedies not sought: criminal sanctions.
- Outcome:

151. **E2: Have you experienced or made any changes in business practices since the introduction of criminal sanctions for the infringement of registered designs?**

- No.

152. **If yes, has this been:**

- n/a.

153. **Please provide further information if possible**

- With so few criminal design cases brought, our members will have had very limited, if any, exposure to such cases and their clients even less so. Since liability arises only from knowing infringement, the typical honest and conscientious UK business is likely to operate on the basis that it does not set out to infringe third party rights or engage in slavish imitation. This does not mean they all do prior design right searches, and many do not. This is because the search tools have material limitations and clearance advice comes heavily caveated.

154. **E3: Have criminal sanctions for the infringement of registered designs been providing an effective deterrent effect, in your experience?**

- No. In our experience, it does not appear to be considered when making design decisions.

155. **To allow government to assess impacts, please provide evidence to support your answer.**

- There is very little evidence available. We have seen the answer submitted by CIPA to this question and welcome their analysis. We agree with the points made by CIPA.

156. **E4: Have you experienced any negative impact linked to the introduction of criminal sanctions for the infringement of registered designs?**

- No.

157. **If yes, please provide supporting evidence.**

- n/a.

158. **E5: Do you have evidence or experience of the current prevalence of unregistered design infringement?**

- No. Our members will represent both design right owners and alleged infringers. The number of cases going to court are not indicative of the number of disputes arising that involve design rights. In our experience, many assertions of infringement are made, notably less than of trade mark or copyright infringement, but most are resolved amicably by negotiation or the claim is just not pursued. The latter may happen for multiple reasons, but the costs of pursuing claims can be prohibitive, not least because of the complexity of the law in this area.
- UK unregistered design right is perhaps more commonly the subject of UK litigation but that does not mean it is more commonly relied upon (indeed, it may well be litigated because it is confusing and difficult such that settlement is hard to reach). In our experience, the SUD is relied on more frequently in certain sectors, such as fashion and jewellery design. The difficulty with it is its short duration. UK registered designs are relied on when SUD has expired.

159. **E6: How do you currently address infringement disputes for unregistered designs?**

- Legal proceedings: Intellectual Property Enterprise Court's multi-track, High Court Chancery Division.
- Out of court: Negotiation.

160. **E7: What are the typical costs, duration, remedies sought, and outcome in currently available litigation routes for an infringement of unregistered designs?**

- Costs: Above £50,000.
- Duration :12-18 months.

- Remedies sought: Damages, Account of profits, Delivery up or destruction of infringing items, Final injunction to prevent infringement in the future, publication order, Interim remedies.

161. **E8: If a criminal offence is introduced for infringement of unregistered designs, should any adaptations to that offence be made to reflect the different context of unregistered designs?**

- We are strongly against the introduction of criminal offences for unregistered design rights. These are complex rights in which the outcome of an infringement claim can often be extremely hard even for intellectual property practitioners of many years' experience to predict. It would be wrong to expose business directors and designers to possible criminal conviction in relation to an unexamined right with no ability to undertake prior clearance searches where what is claimed can be adjusted up to the end of a trial (i.e., unlike registered designs it is not fixed in time, nor on a publicly available register).

162. **E8a. What conditions of intentional copying do you believe would be necessary for a criminal offence?**

- We do not support any criminal offence for unregistered design right infringement.

163. **E9: Please provide any further evidence and/or information on the prevalence of unregistered design infringement and its impacts.**

- Its prevalence is hard to gauge. Its impact can be material, but the remedies of injunctions and financial compensation are the only appropriate ones to impose. Imprisonment and fines are not appropriate, unless health and safety have been deliberately put at risk in connection with a design infringement, in which case other laws will have been broken.

164. **E10: Do you have evidence from other jurisdictions that having criminal sanctions for the infringement of registered or unregistered (or equivalent) design protection reduces instances of infringement?**

- No.

165. **E11: Do you have any concerns about the possible introduction of criminal remedies for unregistered designs?**

- Yes. Considerable.

166. **If yes, please provide further information**

- Given the considerable uncertainty surrounding design law and the challenges already faced by general non-IP specialist Chancery Division judges in deciding design cases, we consider it would be unhelpful to extend that difficulty to judges in the criminal courts who will have little or no experience of the complex law in this area.
- Proving that the accused was aware that the unregistered design existed can be difficult (see *Cantel Medical (UK) Limited v ARC Medical Design Limited* [2018] EWHC 345 (Pat)).

- We have seen CIPA's submission in response to this question and we support their position. In particular, we share their reservations about criminal sanctions even for registered designs. We believe consideration should be given to repealing that criminal offence for the very sound reasons given by CIPA.