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**A consultation response from the Chartered Institute of Patent Attorneys (CIPA) on
2025 Designs Consultation**

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The Chartered Institute of Patent Attorneys (CIPA) is the professional body and approved regulator for patent attorneys in the UK. Founded in 1882 and incorporated by Royal Charter in 1891, CIPA is one of the oldest intellectual property organisations in the world. With almost 5,000 members, including 2,900 Fellows (Chartered Patent Attorneys), 1,000 student members and 700 paralegal members, CIPA is the largest IP membership body in the UK. CIPA's Royal Charter covers IP practitioners with expertise in patents, trade marks, designs, copyright and all other forms of intellectual property. CIPA is governed by its elected Council, in whose name this consultation response is made.

Chartered Patent Attorneys work in private practice firms and in-house, in creative industries. CIPA's members provide the full spectrum of IP advice to small, medium and large businesses, both to IP rights holders and those accused of infringement. Chartered Patent Attorneys advise on and file thousands of registered design applications at the UKIPO each year, for all types of UK and non-UK businesses and individuals.

Our members are therefore well aware of the hurdles faces by UK businesses in the designs protection system. This experience comes from both the clients they regularly represent, as well as from pro bono advice provided to smaller UK businesses and persons. CIPA's members provide expert pro bono advice to individual innovators and small businesses, often start-ups, through the IP Clinics service. Over a thousand individuals benefit from this support annually.

This consultation response has been crafted through wide engagement with CIPA's members, ensuring that the broadest possible range of views are included, from members helping new entrepreneurs small businesses navigate the IP landscape, through to member in-house and in private practice advising international businesses with their IP strategies. In making this response, CIPA has tried to provide a balanced perspective from IP professionals and the beneficiaries of the IP system.

Yours sincerely



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Key elements of CIPA's response to the consultation

SECTION A - Search and examination, Bad faith, Observation and Opposition, Information on the existence of a right in a registered design (DF21 search): Our preferences for managing the anticompetitive filings include the introduction of discretionary pre-filing search for novelty and individual character by the UKIPO (including on Hague design applications). Parties should also be able to seek an opinion on infringement alongside an application for invalidation of a UK registered design, and the invalidation process should be accelerated considerably.

SECTION B – Deferment: We consider that deferment provisions should be implemented with a maximum deferment period of 30 months from the priority date, in line with EU registered designs.

SECTION C – Graphical User Interfaces And Animated Designs: We consider that UK registered design legislation should be updated to clarify that GUIs and animated designs can be protected, either by amending the legislation in a similar manner to recent EU law changes, or by further expanding the definition of a product and design in the legislation.

SECTION D - Computer-generated designs: We consider that the existing computer-generated designs provisions should be retained, since they provide clarity as they are. We consider that definitions of computer-generated or computer-assisted designs in legislation are likely to just lead to substantial lack of clarity and litigation on the topic. Alternative solutions should be sought to allay concerns over the possibility of mass AI generated design filings.

SECTION E – Miscellaneous Changes: We broadly agree with the UKIPO's proposals, and have additional proposals we consider would make the designs system more effective in the UK. Joining the DAS system should be a priority.

SECTION F - Simplification of unregistered designs and overlap with copyright: We see benefit in maintaining forms of protection roughly equivalent in their subject-matter to the current Supplementary Unregistered Design and UK Unregistered Design protection. However, we consider that various elements of unregistered designs could be harmonised to bring clarity (such as to property in and ownership of designs; the acts of infringement; the defences; the acts initiating unregistered design protection; and the term of protection).

SECTION G - Post-Brexit issues relating to unregistered designs: We favour the creation of SUD following first disclosure anywhere in the world, since it will (a) allow UK designers to freely choose where to launch their designs without losing protection in their home market, and (b) meet the UK's TRIPs obligations.

SECTION H - Call for evidence on criminal sanctions for design infringement: We are strongly in favour of there being no criminal sanctions for design infringement and consider that the existing criminal offence for registered design infringement should be repealed. Unregistered design rights are uniquely unsuited to criminal sanctions, such consideration is at an inopportune time given the proposals of Section F, criminalisation could affect SMEs the most and there is no evidence to suggest that criminal sanctions provide improved protection or speed of justice. There are clear actions that can be taken under civil law to improve the difficulties and expenses of enforcement invoked by SMEs in favour of criminal sanctions.

SECTION I - Call for evidence on inclusion of claims made under the Registered Designs Act 1949 within the Intellectual Property Enterprise Court's small claims track: We think that registered designs should be part of the SCT, particularly to aid smaller businesses and litigants in person. We consider that this would significantly reduce costs for such parties.

We would also highlight that whilst the current low application fees are very useful for all applicants (including UK and foreign entities), they could potentially be the cause of a number of issues raised in this consultation. We recommend that consideration be given to increasing the filing fees, particularly for the 2nd and onwards design in each application.

Section A - Search and examination, Bad faith, Observation and Opposition, Information on the existence of a right in a registered design (DF21 search)

Have you/your business experienced anti-competitive filings (YES/NO)?

Yes, CIPA members act on behalf of businesses who have experienced anti-competitive filings.

If yes:

- How many times has this happened to you in the past 2 years?

CIPA's members have acted on behalf of many businesses who have suffered from anti-competitive filings in more than 10 matters.

Was the anticompetitive filing for (tick all that apply): All apply to our members

- 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

How did you address the issue (select all which apply). All apply to our members

- 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

Did this have a financial impact on your business? (Y/N) Yes

If yes, how much did it cost your business?

CIPA's members have represented all sorts of businesses, many find that the cost to their business of being unable to sell stock on Amazon is so small that it would not justify the cost of engaging our members to conduct invalidity proceedings, i.e. the lowest band of less than £10K.

Others engage our members and end up taking court action, spending well into the top band of greater than £50K on irrecoverable legal fees alone, before the cost in damages and lost management time is even considered.

It should not be forgotten that £1 in £5 spent online is reckoned to be spent on Amazon and that even if the victim of a nefarious takedown successfully reinstates their product it affects their ranking and hence future sales making total loss very difficult to quantify.

Section A1 Search and examination

- Option 0 - No change to the current system
- Option 1 - Introduce powers to allow the registrar to carry out a search
- Option 2 - Introduce a two-stage system, where a design can be partially registered without search, and a full search and examination is required in order to enforce a design

Do you agree that the “do nothing” option should be discounted? (Y/N/don’t know)

Yes, we largely agree that doing nothing should be discounted.

Questions:

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

Option 1 - Introduce powers to make it clear that the IPO can carry out a search Most preferred

Option 2 - Introduce a two-stage system Least preferred

Limited searching

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 (although it is unclear what would be regarded as generic)
- Designs which an examiner suspects may be anti-competitive. Yes
- Other (please specify) Designs where a third party draws attention to prior art or apparently anti-competitive behaviour (in the event that legislation allows for searching to be carried out after registration).

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

- Strongly Agree

Whilst limited searching is no panacea, as examiners are likely to be unfamiliar with the state of the art in many fields and unable to spot a “generic” design, limited searching could certainly help deal with some anticompetitive filings and thereby reduce the number.

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? (yes, no, don’t know) No. It is largely considered that automatic registration is preferable to routine searching.

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

- A benefit/opportunity (yes, No, don’t know) Yes
- A challenge (yes, No, don’t know) Yes

Limited searching would provide both benefits and challenges to the businesses that CIPA represents

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

- Positive (yes/no/don't know) Yes
- Negative tick (yes/no/don't know) No

Two-stage system

To what extent do you agree or disagree that a two-stage system would help combat the number of anticompetitive filings?

- Agree

We agree that a two-stage system would help combat the number of anticompetitive filings. The reason this is not the preferred option is largely down to concerns about unforeseen issues.

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 for novelty and individual character

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

We agree that litigation should be able to start prior to the search and examination, if Option 2 is introduced. One of the main reasons we see limited searching (Option 1) as a better option is concern that two-stage search and examination would delay litigation, particularly obtaining preliminary injunctions, for legitimate filers.

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

- A benefit/opportunity (yes, know, don't know) Yes
- A challenge (yes, know, don't know) Yes

The introduction of a two-stage system appears likely to offer both benefits and challenges to the businesses our members represent.

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

- Positive (yes/no/don't know) Yes
- Negative (yes/no/don't know) No

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

- Any impacts the current system has had on your business.
- Any impacts you anticipate the options set out above would have on your business

As outlined in CIPA's response to the designs survey, the 'thicket' of invalid design registrations, due to the low application fees, creates significant costs for other UK businesses. For example,

if such businesses want to launch a product, they have to sift through a large number of registered designs, knowing that many of them will be invalid. This significantly increases downstream costs for UK businesses. Indeed, since so many registered designs are invalid, and due to the difficulty of searching them, many UK businesses entirely ignore registered designs from a clearance perspective, making the registered design system somewhat redundant as it lacks any significant deterrent element. In addition, we are aware of the use of invalid registered designs in takedown notices on online marketplaces by applicants who have, in many cases in bad faith, obtained registered designs that clearly lack novelty or individual character.

It is our stated position that in an ideal system, there would be a high likelihood of all (enforceable) design registrations being valid.

However, on balance, we are concerned that the introduction of the proposed two-stage system, may “throw the baby out with the bathwater”, this is illustrated by the following concerns:

1. DELAY - Although we can see that it is intended to maintain simple and cheap registration, there is a concern that a “partially registered” design may be of no real value, and as such the optional second stage may effectively become mandatory, which could overwhelm the UKIPO, resulting in delays to designs being fully registered and enforceable (even if litigation is allowed to start before the search and examination procedure has been completed).
2. INCONSISTENCY - We are also concerned that the system is “bifurcated”, with decisions in examination by the UKIPO not necessarily being taken into account by e-commerce sites when considering infringement. One can imagine that an anti-competitive applicant may argue that the scope of their design is narrow when responding to a UKIPO search opinion, in order to distinguish from prior art, but then asserting the design against the very same prior-art product in an e-commerce takedown notice.
3. DIVERGENCE FROM EUROPE - There is a concern that divergence from the current system, which is familiar and relatively harmonised with Europe adds complexity/cost
4. COST – The introduction of a two-stage system would add additional cost for legitimate filers, who would need to pay an official fee (presumably of tens to hundreds of pounds, before they could force competitors to take their products off the market).
5. MISSION CREEP - Another concern is that overzealous examination could lead to legitimate designers not being allowed “their day in court”, so that validity can be properly assessed with evidence from experts.

If the two-stage system is introduced despite these concerns, we agree with the proposal that the applicant or a third party should be able to request examination. In our view third parties should be allowed to submit prior art too. The UKIPO might also consider the Australian approach under which a third party is only required to pay half of the examination fee, then if the applicant does not pay the other half (e.g. because they know the design is invalid, or of little commercial interest), it is automatically revoked, without requiring examination to actually take place – this would reduce the burden on the UKIPO.

In the event that a two-stage system is introduced, it is considered that it is absolutely imperative that examination occurs rapidly.

We would also strongly suggest that parties could seek an opinion on infringement along with validity, either in a two-stage system or as part of the current process for applying for invalidation of a UK registered design. This could avoid a so-called “angora cat” problem, with parties making different submissions as to scope when arguing for validity and infringement. (i.e. when arguing for validity, the proprietor says their design is very small: the cat with its fur smoothed down, cuddly and sleepy; the scope of the design is narrow, minor differences like colour etc. are important. However, when asserting infringement, the fur bristles, the cat is twice the size with teeth bared and eyes ablaze; minor details like colour are not taken into account in asserting the design against e-commerce competitors.) If the UKIPO would pronounce on both infringement and validity this issue could be managed.

Furthermore, an opinion on infringement provided alongside validity could be used by online marketplaces to reinstate listings, such as if a registration is found valid but the opinion is that there is no infringement.

Again, *if* the two-stage system is implemented, we would also suggest a departure from the Australian approach, by allowing applicants to request certification on filing, before registration, in order that an application where publication is deferred and there is sufficient time for examination to occur before publication, could emerge fully registered, certified and ready to enforce (as is the case in USA, for example, where all applications are examined and only published once granted).

We are not wholly sold on the “partially registered” terminology. This is unfamiliar to users of international systems, and design law is already one of the least harmonised parts of IP. Consideration could be given to the Australian terms of “registered” and “certified” and the law should be altered to only allow enforcement of certified designs.

Overall, we anticipate that option 1 would have a positive impact on our clients in the UK creative industries, but that option 2, whilst useful in dealing with anti-competitive filings, which on the UKIPO’s analysis account for 9% of filings, might have unforeseen negative consequences for the 91%.

One option might be to legislate for the possibility of a two-stage system (option 2), alongside limited searching (option 1) and an infringement opinion service. Option 1 could be brought into force immediately, but option 2 only started in the event of after a successful long term pilot scheme.

Section A2: Bad faith

Questions:

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

- Agree

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. [Strongly agree]
- Applications where another company's product photographs are used by a third party to seek protection. [Strongly agree]
- Applications which are re-filed for previously invalidated designs. [Strongly agree]
- Anti-competitive applications more generally [Agree]

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

- A benefit/opportunity (yes)
- A challenge (don't know)

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

- Positive (yes)
- Negative tick (no)

Please provide any additional information relevant to bad faith.

We prefer option 1, limited search, as set out in section A1.

In the event that Option 1 of Section A1 is introduced, bad faith provisions would appear unnecessary, because an examiner would be able to refuse a design filed in bad faith (for any of the reasons outlined above) on grounds of lack of novelty, at least without needing to assess whether an invalid design was filed in bad faith, or not.

The requirement to show bad faith (i.e. dishonest intent), seems a potentially unnecessary barrier to invalidation.

Section A3: Observation and Opposition

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

- Option 0 - Do-nothing (2)
- Option 1- introduce a post-registration opposition period for designs (“registered at risk”) (3)
- Option 2 – Introduce a pre-registration opposition period for designs (4)
- Option 3 – Introduce an Observation Period (1)

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

- Post-registration opposition (No)
- Pre-registration opposition period (No)
- Observation period (Yes)

How likely would you be to use the following options if introduced? (very likely, likely, neither likely or unlikely, unlikely, very unlikely).

- Post-registration opposition unlikely
- Pre-registration opposition period unlikely
- Observation period unlikely

In all cases, we believe uptake will be extremely low, if the government’s proposed two-month period is introduced. On the other hand, we believe that with a much longer period, the possibility of observations as a lower-cost, faster, alternative to invalidity proceedings (at least in relation to novelty), could provide a major improvement in dealing with anti-competitive design filings.

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

Would publishing a design before registration cause you or your clients any problems if introduced (Don’t know)?

Would publishing a design before registration cause you any problems when filing in other countries (NO). [Assuming we can still defer publication (with a commensurate delay in registration after the opposition/observation period), we cannot see any issues]

If an opposition or observation period is introduced, would it provide you/your business with a benefit or challenge:

- Post-registration opposition (don’t know)
- Pre-registration opposition period (don’t know)
- Observation period (don’t know)

In all cases, the devil is in the detail – we think a short period for opposition or observations would make it virtually irrelevant; a longer period would provide benefits and challenges, benefits to victims of anti-competitive filings, but potential challenges to the legitimate filers.

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

- Post-registration opposition (don't know)
- Pre-registration opposition period (don't know)
- Observation period (don't know)

See our reply immediately above

Please provide any additional information relevant to opposition or observation

Of all of the options to deal with anti-competitive filings and the quantity of invalid designs on the register, the proposal of a short opposition/observation period seems the weakest.

Even amongst CIPA's client base of sophisticated UK design-led companies, monitoring competitors' designs is rare. Moreover, in our experience anti-competitive designs tend to be filed not by major competitors, but more often by fly-by-night companies or counterfeiters who it is difficult to keep track of.

We struggle to see what benefit any of these options have over the current invalidation procedure – the official fee for invalidation is already just £48, so clearly the lion's share of the cost for parties is in attorney fees. Reducing the time available to invalidate (by introducing a 2-month deadline for opposition/observations) is only likely to increase costs based on the principle of "fast, cheap and good – pick two".

However, if the proposed observation period were overhauled, with observations on novelty allowed for the entire duration of a design, or a longer period set for example at 2-3 years, or perhaps best-off set at 5 years, to align with the date of the first renewal fee, we see potentially significant advantages.

One proposal would be to introduce limited searching and maintain the current invalidity procedure for determining novelty and individual character, but allow a 5-year period for observations only based on novelty.

It is considered that examiners could very rapidly decide on lack of novelty and revoke an invalid design within days or weeks on the basis of such observations. This is the kind of time period needed to deal with anti-competitive takedowns.

Not including individual character as a ground for third party observations, would avoid difficult decisions in which the examiner is required to take on the mantle of the informed user and make somewhat subjective decisions.

In the event that the UKIPO opts for opposition/observations and not the alternative of Section A1 or Section A2, we believe consideration should be given to:

1. Providing a courtesy service alerting owners of similar designs to the publication of new designs. It should be noted that the irrelevance of the title to the scope of protection would make this an extremely challenging with current technical limitations.

2. Additionally providing an opinions service, akin to that of S74A, under which the target of a potentially anti-competitive design (and other parties concerned by potentially legitimate designs) can seek an opinion on BOTH whether their design infringes, and whether a design is valid, with similar provisions for revocation of clearly invalid designs.
3. Substantially increasing the opposition/observation period.
 - An observation period with a long time limit might be a good approach, allowing a cheap way for parties on the receiving end of take-down notices to draw attention to potentially relevant prior art for a meaningful period, not one so short that the anti-competitive filer could just wait it out.

Combination of options

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? (No)

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 Yes – but based on our proposal above, with a much longer period – long enough that an anticompetitive filer cannot typically just wait-out the observation period before filing a takedown.

We are encouraged that the government is keen to do something. One suggestion preferred by a significant proportion of CIPA's Copyright and Design Committee is for a combination of:

1. limited searching, considering novelty and individual character (Option 1 of A1, to screen out obvious anti-competitive filings)
2. a long (e.g. 5 year) observation period for novelty-only, (a modified version of Option 3 of A3) with a very fast turnaround in revocation (preferably days or at most 2-3 weeks to allow victims of anti-competitive takedowns based on clearly invalid filings that slip through the net to obtain a rapid response)
3. a change to the invalidity procedure, to significantly accelerate the time until decision where evidence is supplied that a takedown has been filed against an applicant for invalidity and to issue decisions in default, if the applicant does not indicate an intent to defend the invalidity action within a short timeframe. Furthermore, the invalidity procedure should be changed so as to be much more similar to EU invalidation proceedings and EPO oppositions, where witness statements are rarely filed. Instead, it should suffice to simply provide a statement of grounds, which includes references to prior art filed alongside the statement of grounds. This would make the procedure much easier for applicants to understand.
4. introduction of an opinion service to provide a formal position on (non-) infringement, conducted by a senior examiner, which can be provided to an e-commerce company to support a request for re-listing
5. ideally, the option to combine an opinion on infringement with a decision on validity, to avoid anticompetitive filers making inconsistent arguments on scope when arguing for validity and infringement.

Section A4: Information on the existence of a right in a registered design (DF21 search)

Questions:

- Have you ever used the DF21 service? Yes
- If so, please explain how you use the DF21 service in your role.

Our members use the DF21 service

(a) alongside commercial searches for clearance.

(b) to find prior art for invalidity actions (again alongside commercial searches).

(c) In relation to clearance, it is considered that a DF21 search might be valuable as a defence to an allegation of criminal registered design infringement, as evidence of acting innocently, in good faith, seeking to find out if a design is registered.

We would draw attention to the fact that no such due diligence could be carried out in respect of unregistered designs, since they cannot be found on any register.

- How many DF21 searches have you filed in the past 5 years? We suspect that CIPA members have been involved in filing a significant proportion of the DF21 searches.

What were your main reasons for using this service (tick all that apply)?

- To know if identical designs exist
- For due diligence
- Another reason (please specify) see our answer above as to how we use the DF21 service in our role.

What do you think is included in a DF21 search (tick all appropriate):

- Identical designs on the UK designs register

Section A: Assessment of impacts

Do you agree with our assessment of the impacts as set out in Annex 2? (Yes)

Are there any impacts which we have not been included but should be? (Don't know)

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

We have set out various concerns about potentially unforeseen impacts in the text above. It is noted that Annex 2 indicates that search and exam option 2 is expected to have a negative NPV (i.e. an overall cost). We believe it is appropriate to remove the cost to “illegitimate” filers from the analysis, to focus on the positive impact on society overall.

We note the concern in part B that *Any increase in fees for applicants could lead to barriers for entry*. As we submitted in response to the Designs Survey, we consider that increasing fees may in fact offer a net benefit we previously stated:

We think it highly unlikely that true designers of valuable products would not file a design registration for an official fee of twice that of the current level; if a designer is not willing to pay £100 rather than £50, then their design cannot be of sufficient quality or value to warrant protection. Similarly, allowing additional designs in the same application for a mere £2 each, whilst the fee for invalidity stands at £48, before legal costs, seems imbalanced.

A fee increase might prevent people from just ‘having a go’ with a registration that they know is likely invalid. We consider that substantial thought should go into increasing the fees beyond their current level, recognising that the low fees have brought problems to UK businesses, in the form of design registration thickets

It is noted that the aim is to crack down on “illegitimate” filings. One impact that does not appear to have been considered is that “mission creep” may occur, with examiners issuing more and more objections, potentially raising objections to applications filed by legitimate filers, whose designs would be considered novel and to have individual character by the informed user, but which to the untrained eye may appear very similar to an earlier design.

Any such impact would be negative and in light of the relative paucity of court decisions on validity of registered designs, the UKIPO should be extremely cautious not to develop an unduly punitive approach which is not supported by case law interpreting the legislation.

Finally, in relation to *International considerations*, we believe consideration will need to be given to impact on International agreements. At present, the UKIPO’s membership of the Hague system is on the basis that it is a “non-examining” office. Australia, whose system the government sees as a template is not a member of the Hague, so cannot be used as a template. China, whose post-registration “Patent Evaluation Report” system is similar to that proposed, is an examining office. On the other hand, Brazil, which also has an optional post-grant examination system (which in practice seems essential before enforcement) is NOT an examining office.

On that basis, it may be that no change is required, even if the UK did have to become an examining office in order to introduce the most preferred option, we are of the view that that requirement should not trump the positive impact on legitimate design filers.

Of course, it would be necessary that any changes to the search/examination procedure apply to Hague registrations too, so appropriate the provisions should be implemented.

SECTION B – Deferment

Length of deferment

We agree to increase the deferment period but consider that the deferment period should be 30 months from the priority date (rather than 18 months).

We are in favour of having an explicit deferment provision in the legislation and increasing the deferment period to **30 months** from the priority date.

For designs in particular, designers often wish to keep their designs secret until they are ready to be launched. A 30-month deferment period would allow applicants to protect their design from competitors whilst developing their marketing strategy and preparing the product for launch. However, the system should allow applicants the ability for their designs to be published sooner than 30 months if they so wish.

The period of 30 months would bring the UK's deferment period inline with the EU deferment period.

The period of 30 months would also be inline with the maximum period allowed by the Hague system, of which the UK is a member. If the UK deferment period is set to less than 30 months then this would disadvantage Hague users wishing to make use of a longer deferment period whilst seeking protection in the UK under the Hague system (under the Hague system, the deferment of publication will be the shortest period for the countries which are designated in the application).

The potential to defer publication for 30 months would not be out of line with other countries, for example:

- China - deferred examination for 36 months, and examination comes before publication on grant, so effectively a delay of at least 3 years from filing before publication
- Japan - deferred publication of 3 years from the registration date, so again a delay of at least 3 years from filing before publication
- USA - no publication of the application until grant. US designs typically have a pendency of 26.7 months (with a standard deviation of 9.9 months) – i.e. an average of 26.7 months without publication

We disagree with the proposal to introduce an 18-month deferment period as consider that this should be a 30-month deferment period instead.

Commencement of deferment period

We strongly agree with the proposal to start the deferment period from the earliest date of the application

As noted, above, the 30-month deferment period should start at the earliest date of the application (at the filing date or the priority date, if there is one).

Therefore, we strongly agree with the proposal to start the deferment period from the earliest date of the application.

Deferment of registration and publication

Under the current practice, the UKIPO defers both the registration and publication of a registered design together (since the design is published as soon as possible after it is registered).

UK law also sets out that acts done between the application date and the date the registration certificate is issued cannot be pursued for infringement.

The EU system limits the right to take infringement action in the deferment period to instances where the design has been copied by a third party (see Art. 19.3 EUDR). There is a potential benefit to this.

Consider a scenario where a designer has made a design public at a trade show but the designer forgets to tell their attorney to publish the UK design. In that case, a third party could copy the design and not be pursued for infringement before the design application is published.

We neither agree nor disagree that both the registration and publication should be deferred. However, if the deferment period is increased, consideration should be given to introducing a corresponding provision in UK law to the EU provision which allows action to be taken for instances where the design has been copied by a third party before the design has been published.

Information which should be published about a deferred design

We suggest that the UKIPO publish the same details as the EUIPO. Companies often apply for protection in both these jurisdictions and then there is no difference in terms of what can be viewed on each register by third parties.

- A. Name and address of applicant YES
- B. Name and address of representative YES
- C. Filing date YES
- D. Priority date YES

Prior use and co-pending applications

Prior use provisions should not be extended to the deferment period.

This is inline with the position of the EUIPO, where prior use provisions are only available to somebody who used a registered design before the application date (or priority date, if there is one)

Therefore, it would not be at all useful to extend the prior use provisions.

SECTION C – Graphical User Interfaces And Animated Designs

Do you register animated designs/GUIs?

Yes

If yes, how many animated designs/GUIs have you registered in the last 12 months

CIPA's members have registered more than 50 animated designs/GUIs in the last 12 months.

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

No

The UKIPO will object to a design application for an animated graphical user interface where there are no common features between views. We do not see sufficient basis in the Registered Designs Act or case law to be so restrictive as to what is and is not an acceptable animation or GUI. The UKIPO is also out of step with many jurisdictions across the world, which leads to confusion and gaps in registered design portfolios.

We are also concerned that there is no case law to guide applicants or examiners on this issue.

Discounted Options

Do you agree that “do nothing” should be discounted?

Yes

Designers put significant creativity and effort into designing animations and graphical user interfaces and we feel that such creativity and effort should be protected in the UK. The current system is not fit for purpose in this respect.

Option 2 – Amend legislation

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

In our experience, the UKIPO will object to a design application for an animation and/or a graphical user interface where there are no common features between views.

For example, we understand that the UKIPO would reject an application showing a series of different sports participants (e.g. showing, for example on a waiting screen for a ticket booking website, a sequence of a tennis player followed by a cricket player followed by a football player) because they do not have common features.

The basis for the rejection is that multiple products are shown. In our view the product is the animation as a whole, showing the different sports participants, and there is no legal basis to require common features between views. Therefore, we consider that existing legislation should

already provide protection for such an animation or a GUI, since the applicant in effect decides that the product is the series of different sports participants by filing a design with all of their images included.

However, since the UKIPO does not appear to be of this view, then we consider that the legislation does not meet the needs of applicants who want to protect animated designs and GUIs.

Therefore, the legislation should be clarified to ensure that it is clear that the design of such animations and GUIs can be protected. In the sportsperson example, the designer will have put significant creativity and effort into thinking of and designing the look of the sequence of sports participants, and we feel that such creativity and effort should be protected.

[Do you think the current definition of a product within the RDA is adequate?](#)

No

Design protection in the UK should be, and is, available for non-physical products. The legislation should be amended to clarify this.

[Would you be in support of the UK amending the definition/s of a product and/or design?](#)

- [Product – Yes](#)
- [Design – Yes](#)

For the reasons discussed above.

[If yes, do you think we should make similar changes to the EU?](#)

Yes

Making the same changes to UK law as the recent changes to EU registered design law by Regulation 2024/2822 would be the most practical and simplest way of updating the law to meet the needs of applicants who want to protect animated designs and GUIs.

In our experience British businesses, for the sake of practicality and convenience, want more consistency between the UK and EU in terms of what is protectable from a design registration perspective. If there is inconsistency, it only adds to the costs of the legal advice they require when trying to protect their designs, and can result in gaps in IP portfolios.

[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

It would seem appropriate to extend registered design protection to prohibit creating, downloading, sharing or distributing to others any medium or software which records the design.

Option 3 - Allow users of the designs registration system to file different file formats

Should IPO accept file formats which show movement and animation?

Yes

The current system is too restrictive.

File formats which show movements and animation may be better for illustrating a design which contains movement and animation, and may be better for showing how the frames of an animated design constitute one single design.

Furthermore, aligning with the recent changes to EU registered design law by Regulation 2024/2822 would be the most practical and simplest way of updating the law to meet the needs of applicants in this respect.

As discussed above, in our experience British businesses, for the sake of practicality and convenience, want more consistency between the UK and EU in terms of design protection.

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

Yes, for the same reasons as discussed above with respect to file formats showing movement and animation.

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

- OBJ, STL, X3D, DWG, SWF, MPEG, WMV, MP4, WebM, Other – please specify

All

And for other, add PDF, 3D CAD files such as STEP and IGES files.

How problematic do you feel the following would be when protecting a design using a video or CAD file format? (Not problematic, Somewhat problematic, Very problematic, Don't know)

- Claiming priority - Somewhat problematic
- Displaying the registered design on the register - Somewhat problematic
- Displaying the registered designs on the registration certificate - Somewhat problematic
- Certified copies - Somewhat problematic
- Visual disclaimers - Somewhat problematic

Other (please specify)

It is fair to say that allowing a design to be protected by video or CAD will raise some new issues if, but we feel that none of these issues are insurmountable.

Claiming priority - Somewhat problematic

Filing a UK design application containing a video and claiming priority to an earlier application containing a sequence of still images may result in an invalid priority claim.

Similarly, filing a foreign design with a sequence of still images and claiming priority to a UK design application containing a video may also result in an invalid priority claim.

Both problems can be mitigated by adapting filing strategies, such as filing a video as a first design and a sequence of still images as a second design.

Displaying the registered design on the register - Somewhat problematic

The designs register will need to be updated to allow for the display of videos.

The designs register should not require specialist or paid-for software to a third party to view a video or a CAD file. The designs register must allow third parties to reasonably carry out due diligence.

Consideration should be given as to whether there should be a reasonable time limit on the length of a video which represents a registered design. Otherwise, when carrying out due diligence, a third party may be forced to spend many hours watching video files when reviewing a competitor's design registrations.

Displaying the registered designs on the registration certificate - Somewhat problematic

Digital registration certificates could display a video or have a link to the video on the designs register.

Certified copies - Somewhat problematic

Digital certified copies could display a video or have a link to the video on the designs register. Paper certified copies are more problematic, and design law would need to be updated to accommodate for this.

Alternatively, as mentioned above, an applicant could file a video as a first design and a sequence of still images as a second design.

Visual disclaimers - Somewhat problematic

Adding a visual disclaimer to a video is significantly more difficult than adding a visual disclaimer to a still image, but it is achievable.

It may be rather difficult or time consuming for a third party to view a visual disclaimer in a video when carrying out due diligence if the video is too long.

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

Filing the sequence of still images together with the video would provide support for a priority claim in both territories which do and do not allow video to be filed in a registered design application.

In practice, it may be that the still images would have to be filed as second design to ensure a valid priority claim.

Under our Public Sector Equality Duty, we do not expect any significant equality impacts from this change. Do you agree (Y/N/don't know)

Yes

Option 5 - Publication of an additional description filed alongside stills/video clips

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

Yes

As discussed above in response to "Option 2", in our experience, registered designs to animations or transitions are regularly rejected for relating to multiple designs. Allowing the filing of a description may provide a way for applicants to explain the design to the examiner, which may result in fewer objections and more registrations.

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

Yes

If a description has a limitation on the scope of protection conferred by the registered design then it should be published, for at least the sake of third-party certainty.

Do you think that the scope of protection of a design should be assessed in light of the optional description? (Y/N/don't know)

Yes

As discussed above in response to "Option 2", in our experience, registered designs to animations or transitions are regularly rejected for relating to multiple designs.

If a description can be used to overcome this objection by for example stating that the images all constitute a progression through one animation or progression through a graphical user interface, then it would necessarily have to have a limitation on the scope of protection.

What would the impact be of allowing a description to be filed as part of an application (Easier, no change, harder, don't know)

- Understanding the register - easier

- Carrying out due diligence - harder
- Filing in the UK based on a foreign priority. - easier
- Filing abroad based on a UK priority. - easier

Understanding the register - easier

The provision of a description may assist third parties in understanding the scope of protection conferred by the registered design.

Carrying out due diligence – harder

Due diligence would take longer, because description would need to be reviewed in addition to the images. However, third parties would have more certainty on the scope of protection conferred by the registered design, so there would be a benefit.

Filing in the UK based on a foreign priority. - easier

Other countries and territories, such as the EU, readily allow design protection for complete animations and graphical user interface progressions.

When filing such an application in the UK based on a foreign priority, an applicant will almost certainly receive an objection that the application relates to multiple designs. Currently the only way to address this objection is to divide the single application into multiple separate design applications, each containing one or a few frames of the animation or screens of the graphical user interface.

There is a concern that this practice may cause the priority claim to be invalid.

Consequently, if a description can overcome this objection, then the priority claim will be valid, and so filing in the UK based on a foreign priority is easier.

Filing abroad based on a UK priority. - easier

For similar reasons as discussed above, applicants first filing in the UK would file the complete animation to ensure a valid priority claim when filing abroad. Allowing the filing of a description to overcome any objections would make this process easier.

Combining options

Which options do you think we should introduce? (please select all that apply) All apart from “none”

- Additional guidance
- Amend the legal definition of a design only
- Amend the legal definition of a product only

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

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

Our preferred option is to amend the legislation in accordance with the recent changes to EU registered design law by Regulation 2024/2822. As discussed above, this would be the most practical and simplest way of updating the law to meet the needs of applicants who want to protect animated designs and GUIs.

Assessment of impacts

- Do you agree with our assessment of the impacts as set out in the annex?

Yes

- Are there any impacts which we have not been included but should be?

No

SECTION D - Computer-generated designs

<u>Question</u>	<u>Comment from CIPA</u>
Do you agree that the existing computer-generated designs provisions should be removed? Please explain your answer and provide relevant evidence.	No We consider there to be considerable risks associated with removing the provisions, and therefore prefer for them to be maintained. We expect that s.2(4) RDA and s.214(2) CDPA are currently unknowingly relied upon by many designers, since these subsections make it absolutely clear that even if their use an AI tool or CAD software, then if they were the person who made the arrangements necessary for the creation of the design, they are the designer. There is no need for them to keep evidence of their prompts or instructions, because they will not need to prove that they provided sufficient input for the creation of the design in order to be named the designer. If protection for computer-generated designs are removed, it will just lead to substantial complexities and impracticalities during enforcement. The reality is that very few, if any, designers will keep long-term records of all prompts and instructions they provide to AI tools and CAD software. This will make it very hard for designers to prove that they made a computer-assisted rather than computer-generated design. On the other side, it will be virtually impossible for a 3rd party to prove that the prompts or instructions provided to the computer were so minimal that it is merely a computer-generated design. If the Government really feels that amendment is necessary, we consider that they must carefully consider setting out legislation providing a clear difference between computer-assisted and computer-generated designs. Alternatively, they may wish to rely on jurisprudence developing (and therefore accepting that initially the removal of the provision will result in much complex litigation). We think that providing a clear definition in legislation or through jurisprudence would be very difficult, and will simply result in substantial litigation in future. For example, the legislation could set out that a brief input to an AI tool ('generate 50 chair designs') and a mere selection of the output could be considered computer-generated designs. If any specific instructions are given ('generate 50 chair designs, where the legs are X shaped, the seat is Y shaped, the colour is Z etc), then it could be a computer-assisted design. However, even with such a basic example the boundary lines would be immensely hard to define – if the user just says ('generate 50 white chair designs', then is stating 'white' enough to make it computer-assisted?

	Due to the very high risk of changes simply resulting in much more litigation and uncertainty, we therefore consider that the provisions should be retained. If the Government is concerned about registered designs being obtained for large numbers of designs created solely by AI without any creative input from a human, then we think that the simplest and most obvious way of dealing with this is to increase the filing fees. At present, 50 AI generated designs can be registered for £150. If the filing fee is increased, even just to £50 per design, then applications for 50 AI generated designs would cost £2500 (still less than the EU). However, these fee increases would likely be enough to put off applicants from trying to obtain protection for designs they have no intention of commercialising themselves. If the Government has concerns about AI generated designs creating prior art, we think that there is little that can be done in the registration process to prevent it. Any AI generated designs published on a website could be citable as prior art (unless considered an obscure disclosure).
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
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
If not, why not?	We generally consider that harmonisation between the rights is important, in the view of the general aim of simplifying design law. Hence the preference is to maintain the provisions for all types of design rights. However, if consideration is given to deleting the provisions for registered designs, we recommend that they be retained in unregistered designs. This would then at least provide a short

	term of protection against copying for computer-generated designs. We think this would be a very useful fall-back, particularly in cases where there is no evidence that it is computer-generated or computer-assisted, as discussed above.
Have you ever knowingly relied on the existing computer-generated designs provisions to protect your designs?	Yes.
Would you be impacted if the existing computer-generated designs provisions were removed? If you think you would be impacted by removal of the existing computer-generated designs provisions, please provide evidence to support this:	Yes. As mentioned above, we expect that s.2(4) RDA and s.214(2) CDPA are currently unknowingly relied upon by many designers, since these sub-sections make it absolutely clear that even if their use an AI tool or CAD software, then if they were the person who made the arrangements necessary for the creation of the design, they are the designer. There is no need for them to keep evidence of their prompts or instructions, because they will not need to prove that they provided sufficient input for the creation of the design in order to be named the designer. In addition, the information regarding how a design was created is rarely discussed during the preparation of applications for registered designs (or patents for that matter). It simply is not something that advisors and designers usually discuss, as it has not been relevant due to the existence of s.2(4) RDA and s.214(2) CDPA. We expect that due to the significant ambiguity in the differences between computer-generated and computer-assisted designs, litigation will become more complex and costly as parties try to argue that a design is one or the other. In reality, most designs will be computer-assisted in future; this means that attacking a registration for being computer-generated could become a standard part of litigation, requiring significant effort in finding evidence (if any exists). Whilst we appreciate that many other countries with major AI industries do not have equivalent provisions, we think that removing the provision could send a chill effect throughout the relevant industries due to misinterpretation. We expect that if those in the industry hear that these provisions are being removed, they will view the UK in a less favourable right for investment; they may very well not know that other countries do not have equivalent provisions. We can also imagine the move as being interpreted to mean removing protection for computer-assisted designs (unless they are expressly protected in new legislation).

	As mentioned elsewhere in our response, information to ascertain whether designs are computer-generated or computer-assisted is simply not collected during the design process. Therefore, we do not think that there will currently be any reliable evidence available to assist with this part of the consultation.
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?	No
Do you think that the computer-generated designs provisions should be reformed to address this issue, or for any other reason? Please explain your answer, including how the provisions should be reformed if you chose 'yes', and provide relevant evidence:	We do not consider that originality in unregistered design right is the same as originality in copyright, given the further definition of the former in s.213(4) CPDA. However, if they are considered the same, then we can see the potential for a conflict. On the other hand, the wording of the relevant provisions does state '<i>In the case of a design generated by computer in circumstances such that there is no human author, the person by whom the arrangements necessary for the creation of the design are made shall be taken to be the author</i>'. The provision is essentially a contradiction, as it means that there is always a human author defined in law. This may be sufficient to overcome any potential conflict. If the Government sees scope for a better test for determining who the author is when computers are used to generate designs, then reform could be a possibility. However, as mentioned above, we think that this will be extremely hard to do and is likely to just result in significant uncertainty and complexity in litigation.
Should the IPO collect information about the use of AI in the creation of a registered design as part of the application process?	No – it would be impractical for applicants and designers to collect this information, particularly for priority claiming designs. However, if the UKIPO wishes to prevent computer generated designs from having protection, then requiring the information upon filing is the only way that this can ever practically be carried out.
If yes, do you think supplying this data should be mandatory?	No – we do not see how such information can be collected through UK designations on Hague applications, and whether the Hague Agreement would even allow such information to be collected. We think that any further divergence between Hague

	applications and UK design applications would result in more Hague applications being filed.
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?	We consider that it would be impractical to collect this information, since designers filing their own designs may not be aware of the issues at hand, so will not be able to clearly define computer-assisted vs computer-generated in a way that will result in reliable information. Furthermore, we consider that it would be immensely impractical for all foreign applicants filing registered designs in the UK. Firstly, this information would not be something that any other intellectual property offices are asking for. Secondly, we expect that in most cases the applicants will simply not know the answer, as they will not routinely collect this information. Thirdly, many applicants will be concerned with confidentiality issues around disclosing how designs have been made. We also not clear how such information could be collected for Hague registrations designating the UK. We also think it will be hard to explain why this information is required for designs, but not for other IP rights such as patents. We also expect that, in the view of the many bad faith filings already being made, applicants will also provide incorrect answers that will just skew any data collected.

SECTION E – Miscellaneous Changes

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? (Y/N/don't know)

Yes.

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

Do you agree that the that time limit for responding to both types of objections should be harmonised at 2 months? 'Yes' in relation to harmonisation, but 'No' in relation to the 2 month response term.

If not, why not? Limited text box? There is certainly merit in harmonising the period of response to formality and substantive matters, noting monitoring two separate deadlines, if they are not harmonised, may cause confusion. That being said, it is suggested that the response term be set at 3 months, rather than 2 months. Particularly if the Applicant is based outside of the UK, getting response instructions may take some time, such that a 2 month period of response may be unduly short.

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

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, under limited circumstances.

There is perceived value in the registrar being allowed to share an application before publication, for the purpose of carrying out their statutory duties, in some limited circumstances.

Such circumstances could be to facilitate compliance of a UK design registration with any of the exemptions set out under Schedule A1 of the RDA 1949, to the extent the UK design registry could facilitate channels of communication to third party organisations who might otherwise fall within this Schedule A1 (such as the Red Cross, or the College of Arms, or the International Olympics Committee). Noting an Applicant may otherwise not themselves have such channels of communication open to them, or otherwise know who should be contacted at such organisations.

Though in case of such channels of communication being implemented, perhaps the UK design registry might in those instances require the Applicant's consent for the UK design registry to send the details of the design via these channels of communication, to give the Applicant the option to keep the design unpublished if they wish to do so (or in case the Applicant might then want to make their own lines of enquiry, to demonstrate compliance with the relevant third party organisations, or in case they already have permission from these third party organisations, which would dispense for any action from the UK design registry using these lines of communication).

If the UK design registry is not allowed to share an application before publication for the purpose of carrying out their statutory duties, then it is also not seen how the UK design registry is able to fulfil its obligations under s5 RDA 1949, to the extent this might require the UK design registry to have the scope of a design assessed by the relevant party security services sitting outside of the UK design registry?

Also, if the UK design registry is not allowed to share an application before publication, for the purpose of carrying out their statutory duties, then under what powers is the UK design registry allowed to publish refusal decisions relating to designs, pursued outside of the Hague design registration system, which are unsuccessful during the examination process, if this is something they might be intending to do?

Equally, if the UK design registry is not allowed to share an application before publication for the purpose of carrying out their statutory duties, would this not prevent the UK design registry from sending any submitted DF55 Form to the Appointed Person, to the extent the content of the DF55 Form relates to a decision to refuse a UK design registration that is otherwise unpublished? Appreciating no such refusal decision, to our understanding, has yet to be appealed in this way to the Appointed Person?

[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?](#)

If this provision was allowed, then a concern would be that it might then impose quite an obligation on the UK design registry to be reacting to all such matters, as/when they arise. This approach might then also allow entities to bypass the invalidation process of UK design registration (along with paying its related fee) through submitting third party observations free of charge, with an expectation then that the UK design registry might then react to these observations by virtue of such an implemented provision.

And can there then be an expectation that the UK design registry will then react to every such third party observations which is submitted?

As an alternative approach, to the extent such matters might be presented on a UK design registration (for instance as a set of third party observations), and resultantly be placed on the file wrapper for the UK design registration, then would it not be easier (and more economically beneficial/viable for the UK design registry) to simply allow a third party to rely on such observations as part of any invalidation application which they themselves might make, using Form DF19A?

[Do you agree that warrant of validity and liability provisions should be similar across trade marks, patents and designs? Yes – harmonisation across the three registered rights would seem appropriate.](#)

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

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) The safeguards mentioned above in brackets appear cogent.

Should the Act be updated to reflect that representations for currently registered designs are made available online? Yes – to the extent this represents the reality of the situation.

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

Very important. Noting that just because something is old/historical does not mean it is not required. Indeed, the alternative of an entity otherwise having to go to the National Archives in Kew to view a historical design registration record is unsatisfactory. Particularly from an access to justice point of view, those outside the UK should be able to view records easily, without these logistical constraints. So in an ideal world, it would be considered beneficial that all records be made available online. That being said, it is recognised that such an approach would have an administrative cost to implement. So perhaps it could be constrained to older records being made available, if they are ever actively requested by an interested party, rather than proactively adding all these old registrations from the start?

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

Yes – to the extent that this might facilitate the UK design registry's workflows, and might also reduce the likelihood of errors, such as missed information being provided, by Applicants (particularly those who are unrepresented, or inexperienced).

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

Option 0: Maintain current practice (do nothing).

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

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.

Option 2 > Option 0 > Option 1

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. Which 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 is preferable over the convenience of registration by the Applicant, through otherwise

not being mandated to provide such priority document evidence 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 DAS as soon as possible.

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?

N/A – to the extent Option 2 is determined as being the most preferable option, as the registry will then always have this priority document provided.

Please provide any additional information relevant to priority claims.

It is well understood that the UK design registry has every intention to accede to the WIPO DAS, where the registry has made repeated commitments to do so in various forums. That being said, aside from how the UK design registry might treat usage of the WIPO DAS as an '*Accessing office*', there is a much more pressing desire for them to adopt the WIPO DAS as a '*Depositing Office*' (in other words, where the UK design registration is the first filing). The lack of this functionality as a '*Depositing Office*' seriously hampers the attractiveness of the UK design registry as an office of first filing.

Thus to the extent it might take some time for any decision on how the UK design registry might treat priority document evidence, in the context of a priority claim, it is suggested that the UK design registry adopt the WIPO DAS as a '*Depositing Office*' in the meantime, as a much more pressing concern.

Also considered helpful would be the provision of electronically certified priority documents (as were available during the COVID pandemic), as an alternative to physical certified copies. Noting the provisioning of physical certified copies then requires couriering original hard copies to agents in each other country, which introduces extra costs and delays, which can be potentially avoided in those territories where an electronic certified copy is considered acceptable. Perhaps this option could be introduced as a tick box option in the DF23 Form, where the user can then ask for either a 'paper' or 'electronic' certified copy? Or otherwise, perhaps consideration could be given to the introduction of an online service provided by the UKIPO, akin to that provided by the EUIPO in the context of EU design registrations, which might allow for electronic certified copies of UK design registrations to be obtained free of charge, and immediately on demand?

Related to the above, it has also been noted that the time for the UKIPO to process requests for certified copies of priority documents is inconsistent. Related to this, and often when multiple documents are requested, they are not all supplied at the same time (or some not at all, unless reminded), which can be troublesome.

- Do you agree with our assessment of the impacts as set out in the annex? (No)
- Are there any impacts which we have not been included but should be? (Yes)
- If yes, please briefly explain which additional impacts should be included.

‘Cost’ was a factor considered in the analysis of impacts, but a serious question remains as to the effectiveness of the current official fee structure for UK design registrations (and in particular those pursued outside of the Hague system).

The very low official fees could well be a factor as to why so many ‘*nefarious*’ UK design registrations exist, along with the fact that the current fee structure encourages more designs to be submitted than might otherwise be submitted using alternative official fee structures (noting, for instance, that 9 designs used in the same application incurs the same basic official fee as 2 designs pursued in the same application).

The UK design registry might therefore wish to study whether this basic official fee structure could benefit from a change (increase), in case this might have an impact on reducing the overall number of ‘*nefarious*’ UK design registrations being submitted. Consideration might also be given as to whether the ‘*tiered*’ official fee structure, where 11-20 designs all cost the same, and 21-30 all cost the same for example, is still appropriate. Perhaps a revised fee structure, more akin to that adopted by the EUIPO, where there is a basic official fee for the first design, and a lesser official fee for each subsequent design included in the same application, could be more beneficial, as a mechanism for reducing the extent of ‘*nefarious*’ UK design registrations being submitted?

It is also suggested to revise the official fees for using deferred publication, which currently overly penalise those UK design registrations where deferred publication is employed. For instance, at the current official fee levels, 50 designs pursued in one application, without deferred publication, incurs official fees of £150. Yet with deferred publication, this incurs official fees of £2,150 for that same application. This is not proportionate, or appropriate.

Consideration may also be given as to whether Applicants might be afforded the possibility, as part of the design submission process, to optionally provide a suggested Locarno Classification (main heading, and sub heading) alongside any provided verbal product indication for the design, in case this facilitates the UK design registry in examining the design, and reduces the likelihood of an Applicant’s design being classified in a Locarno Classification which they were otherwise not expecting?

Consideration might also be given at incentivising the use of the DF21 searching service, as well as increasing its official fee. The current official fee of £24 appears commercially unviable, and hence is suggested to be increased to something which is more reflective of the work incurred by the UK design registry (for instance, to at least £100).

In exchange, the UK design registry might wish to explore better incentivizing the use of the service, perhaps by performing an impact assessment on whether usage of the service might constitute a formal defence against any subsequently asserted action under s35ZA 1949 (for instance as a means for evidencing compliance with s35ZA(1)(b) RDA 1949, or s35ZA(3)(c) RDA 1949), to the extent the relevant person was shown to have employed a DF21 search beforehand.

Or perhaps the DF21 service could be used as a formally recognised means for prima facie asserting innocent infringement in the context of s24B(1) RDA 1949, until any other circumstances might have led to that consideration no longer being applicable (for instance, the proprietor then informing the relevant person about the existence of the design registration).

On a final note, it is suggested that to facilitate the UK's accession to the DLT, that the UK implements restoration provisions for late priority claims, under the '*unintentional*' test, as soon as possible.

SECTION F - Simplification of unregistered designs and overlap with copyright

Initial Remarks

The Copyright, Designs and Patents Act re-defined the relationship between registered design and copyright protection, limiting the latter in relation to functional three dimensional designs and introducing UK Unregistered Designs to plug the gap.

It largely harmonised the registered and unregistered design rights, to the extent possible. Since then, the Registered Designs Act has been extensively modified by secondary legislation, chiefly to bring it into line with EU law, whilst UK Unregistered Design law remained unchanged; additionally, Unregistered Community Designs came into being and were preserved on withdrawal as Supplementary Unregistered Designs. Whilst these different measures are to some extent harmonised (by the Intellectual Property (Enforcement, etc.) Regulations 2006 and the Intellectual Property Act 2017) we welcome this chance to realign and simplify design protection.

We think there is much to say for including all unregistered design protection schemes within the same Act, ideally including also registered designs, to ensure that they do not in future go out of lock. On the other hand, for reasons of legal certainty, we think it preferable to harmonise forwards from existing legal provisions, rather than forming new law out of whole cloth, to ensure that the limited amount of guidance available from existing case law remains applicable. We also see benefit in maintaining forms of protection roughly equivalent in their subject-matter to the current Supplementary Unregistered Design and UK Unregistered Design protection. Absent this, there will be no protection of the investment made in developing functional, non-aesthetic designs against slavish copying – a gap which many other countries fill using unfair competition law.

So we think harmonisation should chiefly extend to property in and ownership of designs; the acts of infringement; the defences; the acts initiating unregistered design protection; and the term of protection. Harmonisation on these points at least would provide competitors with greater certainty as to how to provide competing products without infringing. The first two of these areas should also be harmonised with their Registered Design equivalents. The amended law should be as far as possible in accordance with the UK's international obligations, under for example TRIPs and the EU-UK Trade and Cooperation Agreement.

We think the protection for functional designs might have the same term (initiated by the same first disclosure even), ownership/property provisions, acts of infringement and defences as non-functional designs but might differ in the following characteristics:

- The current, narrower scope of protection ("exactly or substantially" the same, or perhaps "differing only in immaterial details"),
- The current, narrower validity criterion ("original" in the sense of "not slavishly copied", and not commonplace) rather than novelty/individual character,
- The current protection for internal and external features of shape and configuration of the whole or part of a product, rather than the visibility exclusion,
- No "must fit" exclusion - instead, the same repair defence as for registered designs and SUD,
- No "method or principle of construction" exclusion - instead, a general exclusion, applicable to all types of design protection, of "ideas, concepts, methods or principle of

construction or of function as such", but not to the forms resulting from those (based perhaps on an extended version of TRIPs Art 9(2))."

Specific Responses

Para 21 – Discounted Options

<u>Question</u>	<u>Answer</u>	<u>CIPA Comment</u>
Do you agree that the options above should be discounted	Yes	
If not, which option do you think we should consider further: Abolish SUD and retain design right. Abolish unregistered designs and extend copyright. Keep the system the same and provide improved guidance	N/R	(a) We question whether abolishing SUD would be consistent with the UK's obligations under Art 247.1 of the EU-UK Trade and Cooperation Agreement. (b) We doubt the desirability of extending copyright protection to the full range of functional articles protected by design right – the term is too long for such products. (c) Improved guidance is always welcome, but ultimately the issues are for the Court, not the IPO.

Para 37 – Term and qualification

<u>Question</u>	<u>Answer</u>	<u>CIPA Comment</u>
Which of the following is more important to you:		
• Maximum protection [rank]	1	We see the aim of reform as fixing problems which have arisen, rather than reducing protection already available
• Maximum simplification [rank]	2	
Rank the options in in order of preference		
• Option 0 Do Nothing	2	
• Option 1 Retain SUD abolish DR	4	
• Option 2 Consolidate	1	
• Neither	3	
Would harmonising the following aspects make it easier for you to use the system?		
• Qualification requirements (yes/no/don't know)	Y	
• Term of protection (yes/no/don't know)	Y	

Do you agree that a single qualification requirement should apply to both aesthetic and functional aspects of a design (Y/N/Don't know)	Y	Yes, provided that the solution adopted does not jeopardize the protection available to UK designers who wish to market abroad as well as in the UK. See Section G.
Do you agree that a single term of protection should apply to both aesthetic and functional aspects of a design (Y/N/don't know).	Y	
If term of protection is harmonised, how long should it be (please choose preferred option):		We have ranked these, in order to explain our views, but our choice would be 10 years.
3 years	4	We think this, the current period of protection for SUD, is too short as the time required for litigation means that a design will often have expired before judgment. This would also be a major reduction of lifetime from the present 10-16 years available under design right.
5 years	3	We think this period of protection is too short. The 2011 IPO Report found that the average period over which firms received a return on their design investment was 4.6 years for product designs (Design services, design rights and design life lengths in the UK, Haskel & Pesole 2011/5, p20) – curtailing protection to 5 years would remove nearly half of designs from protection before the investment made in them had paid off as expected
5 years plus 5 years licence of right	2	There is little evidence of use of the present licence-of-right system, so its removal would simplify the law.
10 years	1	This is our preferred option. We note that TRIPs requires a minimum of 10 years' protection for designs, and that South Africa provides 10 year registered design protection for functional designs.
Other (please specify)	--	

Para 44 – Simplification

<u>Question</u>	<u>Answer</u>	<u>CIPA Comment</u>
To what extent should unregistered design be harmonised or consolidated?		

Harmonise some legal provisions but keep separate regimes	Y	We think keeping separate regimes – but within the same Act – would signal continuity from the existing rights, indicating that existing case law should continue to apply where relevant.
Create a single right which is harmonised in some respects but where different provisions may apply to aesthetic and functional aspects of a design	N	Whilst this solution could also work, it might be less clear that a single right owed its parentage to the existing provisions.
Create a single right where the same provisions apply to both the aesthetic and the functional aspects of a design	N	We are not sure how the same provisions would apply to the functional and aesthetic aspects of a design but have some concerns that this would result in a loss of protection relative to the current situation.
Do you agree that the SUD legal framework should apply to a new consolidated unregistered design, if introduced?	Y/N	As indicated above, we think it would be better to retain two separate “flavours” of unregistered design, with functional designs retaining some current design right provisions. However if a consolidated unregistered design is the chosen option we think the SUD legal framework is a good starting point, particularly where it is aligned with the law of registered designs and is therefore the subject of more case law guidance. We think in particular the SUD acts of infringement and defences are a better starting point than those for design right, though these might be updated in line with the changes recently made in the EU. We mention below some areas where design right provisions might be retained in a consolidated unregistered design.
Do you agree that the repair/spare parts provisions should be harmonised across all different types of design protection?	Y	Yes. We think it would encourage fair competition in the aftermarket to have a single spare parts regime for all unregistered and registered designs.
If yes, we should use the provisions currently used for (tick preferred option):		
Registered designs		
Supplementary unregistered designs		

UK unregistered design right	N	
OTHER	Y	Our preferred option would be to adopt a repair defence applicable to all kinds of designs, based on that applicable to SUD, but clarified to adopt the interpretation given in <i>BMW v Round & Metal</i> [2012] EWHC 2099 (Pat). That clarification would limit the defence to “must-match” (i.e. “dependent”) spare parts, excluding from its scope the relatively small number of upgrade-type parts like alloy wheels, seats and so on where the competitor is not forced to copy by consumer preference, which is also the solution recently adopted in the EU (Art 19(1) of the Re-Cast Directive). That would essentially replace the current design right “must-match” exclusion with a defence to similar effect, whilst providing a level playing field enabling the automotive sector to operate under the same regime in the UK as in the EU.
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?	N	We believe this would represent a reduction of protection for functional designs as compared to the present design right regime, which protects internal as well as external features. If as we propose a distinction is retained between aesthetic and functional designs, we suggest that the distinction should not apply to the latter.
Do you think that design protection for any product should be limited to features which are visible in normal use?	N	No. We think that the logic of <i>Ferrero's Application</i> [1978] R.P.C. 473 is good. Features of a product which are visible at point of sale or via advertising (like the inside of the chocolate egg in that case) may form part of its appeal to the user even if they are not visible during “normal” use. We note that this was recently made explicit in the EU (Recital 16 of the Re-Cast Directive).
How important to you is the ability to protect the internal configuration of a product?	Don't Know	This would best be answered by applicants.
Are there any elements of the design right regime which you think should be used in a		There are two aspects of the infringement provisions of the design right regime which we think might usefully apply to all

consolidated right, rather than going fully with SUD regime?		unregistered designs. Firstly, the infringing act of “making a design document” could be retained and expanded to cover uploading and distributing design documents electronically, in line with the changes recently made in the EU (Art 16(d) of the Re-Cast Directive). Secondly, something like the existing requirement of s.227(1) CDPA might be retained, limiting liability of a “secondary” infringers unless “he knows or has reason to believe” the article handled is infringing – since the rights are unregistered, it seems reasonable to protect “innocent” dealers. For consistency with the “threats” provisions, this should not be available to importers.
Please provide any additional comments in relation to simplification of designs here:		We think harmonisation should chiefly extend to property in and ownership of designs; the acts of infringement; the defences; the acts initiating unregistered design protection; and the term of protection. Harmonisation on these points at least would provide competitors with greater certainty as to how to provide competing products without infringing. The first two of these areas should also be harmonised with their Registered Design equivalents.

Para 46 – Consolidation

<u>Question</u>	<u>Answer</u>	<u>CIPA Comment</u>
Do you find the number of legal instruments relating to design law confusing?	N	Not confusing to us as professionals, but unhelpful, and confusing to some of our clients.
Do you think the government should consider consolidating designs law into a single piece of legislation	Y	Having a single Act covering all registered and unregistered design law would make analysis of design matters considerably simpler for all involved. This would assist firstly in interpretation, and secondly in ensuring that different rights do not drift out of alignment again, but we also believe that the distinction between “functional” (i.e. “design right”-style) and

		“aesthetic” (i.e. “SUD-style”) designs should be retained within the Act.
Please provide any additional comments in relation to consolidation of designs law here		

Para 75 – Copyright Overlap

<u>Question</u>	<u>Answer</u>	<u>CIPA Comment</u>
Do you think there is still confusion about items protected by copyright and design rights following recent case law?	Y	We do think there is still confusion. The recent <i>WaterRower</i> judgment (<i>WaterRower (UK) Ltd v Liking Ltd</i>) [2024] EWHC 2806 (IPEC)) confirms that CJEU case law, particularly <i>Cofemel</i> and <i>Brompton Bicycle</i> , remains relevant and refers to “ <i>the difficulty in attempting to further define how the court should approach the evidence and assessment of the statutory phrase</i> [work of artistic craftsmanship]”. In <i>WaterRower</i> the design was pleaded as a “ <i>work of artistic craftsmanship</i> ”. The judge concluded that the design in question was “ <i>original</i> ”, but found that it was not a “ <i>work of artistic craftsmanship</i> ”. However, the position of the CJEU is that originality <i>per se</i> is sufficient for protection, and the higher UK Courts have not ruled whether the UK is still permitted to rely on the closed list of types of work in s.4(1) CDPA. Until they do so, or the law changes, the position will remain unclear.
Are there other changes to the copyright framework which could be considered under Option 4?	Y	One option to be considered would be to amend the Act to make explicit the limiting nature of the list of works in s.4(1) CDPA, so as to remove the effect of the CJEU <i>Cofemel</i> and <i>Brompton</i> cases. Beyond this, it could be argued that the “sculpture” and “work of artistic craftsmanship” categories have outlived their shelf-lives and should be re-defined <i>ab initio</i> , and that the definition of “graphic works” needs re-visiting following the suggestion in <i>Response Clothing v Edinburgh Woollen Mill</i> [2020] EWHC 148 (IPEC) that it is limited to “ <i>the author making marks on a substrate to generate an image</i> ”.

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?		We think there is some benefit to increasing the harmonisation of defences across different IP rights, to clearly define the boundaries of legitimate competition. Specifically, in the context of designs and copyright, whilst some overlap remains we recommend the introduction of defences to infringement of artistic works for the purposes of repair, experimental use and use on ships and aircraft; and perhaps a defence in design law for comment, critique or parody as in the recent EU changes (Art 18(1)(e) of the Re-Cast Directive). We think consideration should be given to the re-introduction of s.52 CDPA (though with some clarification), bringing the term of copyright protection roughly into line with that of registered designs.
Do you prefer:		
• Option 3	--	
• Option 4	--	
• Option 5	Y	
• None of these		
Please provide any additional comments in relation to copyright here:		The broader questions whether the closed list of s.4 CDPA should be maintained and, if so, whether the classes of work it contains should be updated needs broader consideration than is available through the lens of design law reform.

SECTION G - Post-Brexit issues relating to unregistered designs

Initial Remarks

There are several confusions surrounding the past and current provisions concerning the initiation of Unregistered Community Designs/European Union Designs, Continuing and Supplementary Unregistered Designs. These revolve around the meanings of Articles 5-7, 11 and 110a(5) 2nd sentence of Regulation 6/2002, and the significance of a decision of the German Supreme Court. The only UK case to have considered these issues (the *Beverly Hills Teddy Bear* case [2019] EWHC 2419 (IPEC)) concluded that they were not *acte claire*, and made a referral to the CJEU which was terminated before a decision. That case considered Unregistered Community Designs, but the law governing Supplementary Unregistered Designs and the amended law governing European Union Designs differ from that which applied, as both now omit Article 110a(5) 2nd sentence.

Prior to commenting on the specific questions below, we therefore briefly set out here our own view of these issues.

Arts 5-7 (SUD and UEUD)

These provide that a design lacks novelty/individual character if made available to the public prior to “*the date on which the design for which protection is claimed has first been made available to the public*”. Each “making available to the public” is defined in Art7 as a disclosure made in such a way that the disclosure could “*reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the*” [Community (UEUD)]/[UK or a qualifying country or a qualifying territory] (SUD).

There is thus no geographical limit on where either the prior disclosure or the disclosure of the protected design must be – the geography applies to the recipients of the disclosure, and will rarely make much difference, as UK and EU circles tend to become aware of the same things.

Art 11 (SUD and UEUD)

This Article refers to protection from the date on which the design was first “*made available to the public within the Community*” (para 1), which phrase is defined (para 2) as meaning that a disclosure which “*could reasonably have become known to the circles specialised in the sector concerned, operating within the Community*”. The SUD equivalent refers to the UK or a qualifying country or a qualifying territory. Again, there is thus no geographical limit on where the disclosure must be – the geography applies to the recipients of the disclosure, and will rarely make much difference. The word “first” does not mean that the “first” disclosure must be in the EU (or UK), merely that the life is calculated from the first disclosure there.

Art 110a(5) 2nd Sentence

This provision added on accession of new EU states indicated that “*Pursuant to Article 11, a design which has not been made public within the territory of the Community shall not enjoy protection as an unregistered Community design.*” However, it did not rule out the possibility that there might have been an earlier disclosure outwith that territory.

Articles 5-7, 11 and 110a(5) thus allow a design to be disclosed outside the EU/UK, then subsequently disclosed within, the validity being judged as of the first disclosure and the term being calculated as of the subsequent disclosure. This is referred to in the *Beverly Hills Teddy Bear* case as the “split date” theory, and reflects how the validity of a registered design is judged as of its foreign priority date but the term is judged as of its UK (or EU) application date.

Gebäckpresse II (I ZR 126/06)

In this German case (never reported or published in English), the BGH held that in view of Art 110a(5) the provisions of Arts 5-7 had to be read as referring to the validity of an unregistered design being judged as of its first disclosure *in the EU*. They concluded that as there was no grace period, this meant the earlier disclosure outside the EU would remove the novelty of the design later disclosed within the EU. They acknowledged that the position prior to Art 110a(5) was unclear. We disagree with the BGH. Their interpretation does damage to the clear wording of the provisions above, and the absence of a grace period in our view arises because, on the split date theory, it is unnecessary. But even on their interpretation, there is no need for the “first” disclosure to be within the EU; novelty is only removed by an earlier disclosure outside the EU on a previous date, so that simultaneous or same-day disclosures are not problematic.

SUD and UEUD

In any event, the EU has removed Art 110a(5) 2nd sentence from the version of the Regulation applicable since 1st May 2025, and Art 110a was entirely omitted from the UK’s SUD version of the Regulation. The reasoning of the BGH is therefore moot, and we are unaware of any other basis for arguing that the disclosure of a design which initiates protection must take place in any particular region. Arts 5-7 and 11 do impose geographical restrictions, but these affect the recipients and not the disclosure (or discloser).

TRIPs Obligations

Underlying TRIPs and the WTO agreements are principles of non-discrimination between WTO Members. The BGH interpretation of Arts 5-7, 11 and 110a(5) would have resulted in preferential treatment for those who first disclose in the EU. Whilst this is not direct national discrimination, it is highly likely to constitute indirect discrimination, by analogy with the *Tod’s* copyright case (Case C-28/04) in which the CJEU pointed out that “*The author of a work first published in a Member State will, in the majority of cases, be a national of that State, whereas the author of a work published in another Member State will generally be a person who is not a national of the first Member State.*” We are generally against reciprocity-based access to rights, which is against the spirit of TRIPs and the Paris Convention amongst others, and we believe the situation now is not on all fours with that considered by the IPO nearly three decades ago in *Azrak-Hamway International Inc’s Licence of Right Application* [1997] RPC 134.

Para 11 – Discounted Options

<u>Question</u>	<u>Answer</u>	<u>CIPA Comment</u>
Do you agree that the options above should be discounted?	Y	
If not, which option do you think we should give further consideration to:		
Seeking reciprocal recognition of disclosure with the EU	N	

Allowing any disclosure abroad to give rise to SUD	N	We agree that obscure disclosures will create ambiguous rights. Only disclosures which would come to the attention of the circles specialised in the sector concerned should count.
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Para 27 – Preferred Options

<u>Question</u>	<u>Answer</u>	<u>CIPA Comment</u>
Please rank the options in order of preference (1 = most preferred, 5 = least preferred)		
Option 0 - Do nothing	3	As argued above we think this option would, in fact, be the same as option 4, but we believe that Option 4 will give greater clarity.
Option 1 – Unilaterally recognise simultaneous disclosure in law	4	This option would perhaps give some certainty (although “simultaneous” would require definition, see below) but at the cost of ruling out our view of the present law. We therefore do not prefer this. It would principally benefit those making online disclosures, favouring that one marketing strategy over others.
Option 2 – Introduce a grace period	2	A grace period would mitigate the effect of the BGH view of disclosure.
Option 3 – Creation of SUD following first disclosure anywhere in the EU	5	At very least this option should extend to the EEA and not merely the EU, but in fact there are other trading partners who also provide protection to UK designers and/or where UK designers might wish to launch.
Option 4 – Creation of SUD following first disclosure anywhere in the world	1	We favour this option. This will (a) allow UK designers to freely choose where to launch their designs without losing protection in their home market, and (b) meet the UK’s TRIPs obligations.
If a simultaneous disclosure provision is introduced into UK law, should we recognise simultaneous disclosures made in:		We do not believe that “simultaneous” disclosure limited by country is a very useful concept today, because electronic disclosures are not closely tied to places. If there is to be any limitation, we think all WTO Member States should be treated alike. The following comments should be read in that light.
The EU	Y	
The European Economic Area	Y	

(Liechtenstein, Iceland, Norway)		
• Switzerland		
• USA		
• China		
• Japan	Y	Japan has a three year period of protection against slavish copying of products, with no reciprocity requirement.
• Korea	Y	The Republic of Korea has a three year period of protection against slavish copying of products, with no reciprocity requirement.
• Australia		
• New Zealand		
• Anywhere in the world	Y	
• Other countries (please specify)	Y	All WTO Member States. More specifically, countries such as Ukraine which have bilateral agreements with the EU establishing equivalent unregistered design rights.
• Don't know		
What should constitute simultaneous disclosure:		
• At exactly the same time	N	As this is a physical impossibility, it raises insuperable issues of proof for whichever party has to bear the burden.
• Within the same hour	N	We do not see any logic to this
• Within the same day	Y	As explained above, we believe that this is in fact the current position. Resolving issues of date is less complex than resolving issues of timing.
• Within a longer period of time (please specify)	N	A longer period of time would constitute a grace period, see below, not a simultaneous disclosure.
• Don't know		
Do you think a grace period should be introduced for unregistered designs?		
• Yes		
• No		
• Don't know		
If the government introduces a grace period for unregistered designs, how long should this be?		

• Less than a month	N	
• 1 month		There is perhaps some historical logic in applying the equivalent to the “30 days” period in Berne Art 3(4) governing simultaneous publication of books.
• 2 months	N	
• 3-6 months		A maximum period of 6 months between foreign disclosure and UK disclosure would correspond to the period between foreign design filing and UK design filing claiming priority, which is perhaps analogous.
• Other (please specify)		
• Don't know		
If we allow disclosures abroad to give rise to SUD, should we recognise disclosures:		
• In the EU only	N	
• Anywhere in the world	Y	
• Don't know		
• Other (please specify)	Y	Any WTO Member State
To what extent are you concerned about asymmetry i.e. other jurisdictions not reciprocating any measure the UK introduces? (concerned, slightly concerned, unconcerned),	N	Unconcerned. The UK has historically led by example, rather than demanding reciprocity, and has supported the non-discrimination and most-favoured-nation bases for international free trade. The only measure for which the UK attempted to secure reciprocity was UK unregistered design right, and no significant foreign jurisdiction took it up.
Please provide any further relevant information which you think will help us assess which option to take forward.		Policy-making has until now been driven by a zero-sum-game approach to withdrawal from the EU, based on worst-case assumptions about the meaning of the ambiguous provisions of Regulation 6/2002. Now that the EU has removed the basis for those worst-case assumptions we recommend moving away from reciprocity-based thinking – should the rest of the world adopt a reciprocity approach, the UK could suffer.

Para 33 – Impact Assessment

<u>Question</u>	<u>Answer</u>	<u>CIPA Comment</u>
Do you agree with our assessment of the impacts as set out in the annex?		We think the assessment sets out the right factors but we cannot quantify their effects. The assessment considers whether businesses would

		switch between registered and unregistered protection, but we think this effect would be small – many designers who rely on unregistered protection do so because they forgot or failed to register, rather than making a conscious choice against registration in favour of unregistered rights.
Are there any impacts which we have not been included but should be?		
Please supply any other information which you consider would be useful to help us assess the impacts of the options.		

SECTION H - Call for evidence on criminal sanctions for design infringement

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?

These vary significantly depending on the nature of the dispute and the parties in question. CIPA's members represent businesses of all sizes, from sole traders through to multinationals, and it is of course difficult to define a 'typical' dispute and its attributes. Some disputes are resolved with informal or formal pre-action correspondence, costing relatively little (e.g., £1000-3000 in legal fees for a pre-action letter) within days or weeks. Other cases do of course progress to court, in which case a dispute can incur hundreds of thousands of pounds in legal fees and span years. There is no 'one size fits all' approach to a design dispute, but CIPA is committed to supporting efforts to resolve disputes as efficiently, quickly, and cheaply as possible, while maintaining equitable outcomes for all parties involved. However, the cost-effectiveness of the first step on the ladder – the letter before action – is to be emphasised. In the context of business commerce, there is a very low-cost barrier to entry for rights holders.

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

No. This is because, as a general practice, our clients with an interest in their designs already take design protection seriously. They perform FTOs and ask for legal advice where concerns arise. There may or may not be an extra 'deterrent', but such that there is there is no additional material consequence of this – they can do no more to avoid other's rights. There is, however, a legitimate fear that this level of diligence is unfeasible in respect of unregistered designs - no amount of work can guarantee what rights exist, and how valid they are. This will inevitably have a chilling effect on design innovation for businesses of all sizes.

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

This question is extremely difficult, if not impossible, to answer definitively. Our investigations of publicly available records indicate that vanishingly few criminal prosecutions have involved registered design offences since their introduction in 2014. Freedom of information requests were filed with the Crown Prosecution Service (CPS) for England and Wales and the Crown Office (CO) for Scotland to obtain data on the number of s35ZA RDA prosecutions brought since inception. The CPS indicated that no cases were registered on their database for offences under s35ZA RDA. The CO reported that there have been three charges under s35ZA reported to them since 1 January 2015, with all three being in 2022. The only reported case on record including any reference to s35ZA RDA is *Iqbal vs City of Wolverhampton*¹ in the EWCA in April 2025, in which a market trader was convicted of various IP-related offences including registered design infringement offences under s35ZA RDA. It is noteworthy that the registered design number(s) alleged to have been infringed are not mentioned whatsoever in this judgment and, more generally, some of the comments relating to designs in this judgment are rather concerning to experienced design practitioners.

¹ [Iqbal & Anor v City of Wolverhampton Council \[2025\] EWCA Crim 498 \(17 April 2025\)](#)

In our view, the extremely low prevalence of criminal design cases over the decade since s35ZA RDA's introduction is straightforward evidence that its deterrent effect is likely to be negligible. Criminal infringers will not be deterred by a punishment that is almost never imposed in practice. Additionally, there is no evidence to suggest that public authorities are regularly pursuing criminal infringers on the rights holder's behalf. The notion that SMEs' design enforcement will, in effect, be outsourced to the police, CPS, and the like is simply not borne out by the available evidence.

In this context, the value of criminal sanctions for any form of design infringement is highly questionable. We strongly support the repeal of the criminal offence for registered design infringement.

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

No. However, a lack of negative consequences does not automatically mean that the introduction of criminal sanctions has been positive. Indeed, this is inherently unquantifiable; we will never be aware of – for instance - the products that weren't made and the actions that weren't taken.

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

Our members will certainly represent clients on both sides of unregistered design infringement disputes, but the total prevalence of such disputes is not quantifiable.

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

Answer is the same as E1. Tactics vary significantly dependent upon the nature of the dispute and the parties in question. Our members represent businesses of all sizes, from sole traders through to multinationals, and so it is impossible to define a 'typical' dispute and its attributes. We note that the small claims track of IPEC is currently available for UDR disputes, but its decisions are rarely published so it is difficult to assess prevalence of SCT use for design matters.

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

Answer is the same as E1. These vary significantly dependent upon the dispute in question. Our members represent businesses of all sizes, from sole traders through to multinationals, and so it is impossible to define a 'typical' dispute and its attributes.

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 do not support criminalisation of designs infringement whatsoever. However, if criminal penalties are to be provided, then they must be very narrowly defined to cover exclusively malicious, intentional, and exact copying of a design in the course of business. Further, we strongly suggest that any criminalisation statute includes a notice-and-cure provision. Allowing

criminal sanctions for infringing acts beyond this would immeasurably stifle design innovation in the UK, large and small businesses alike would be unable to develop new designs for fear of criminal penalties.

Furthermore, we suggest that it should be a defence to criminal sanctions that the accused infringer has obtained at least one of an invalidity or non-infringement opinion from a regulated person. It should also be a defence that, at the time of the alleged copying, the alleged infringer could not have independently established whether a valid unregistered right existed.

In view of the inherently unknowable nature of UDRs, it would also be appropriate to require that criminal copying may only occur where the relevant product is clearly marked with the UDR details. The marking – which could be a webmarking - should enable third parties to understand at least the scope and features of the UDR, its term, and its owner, so that a proper clearance analysis can be performed. Marking could prove onerous for the rights holder but that is precisely the point; if it is difficult for the design owner to identify their own UDR, then how can a third party be expected to do so?

It is a profoundly serious matter to be alleged to be a criminal, and the nature of the potential offence – unregistered design infringement – does not sufficiently justify the potential reputational damage of such allegations.

[E8a. What conditions of intentional copying do you believe would be necessary for a criminal offence?](#)

As above, the offence must be very narrowly defined to cover exclusively malicious, intentional, and exact copying of a design in the course of business, and only where at least one warning has been given and acknowledged by the alleged copier.

[E9: Please provide any further evidence and/or information on the prevalence of unregistered design infringement and its impacts.](#)

We expect that some responses to this consultation will include case studies in which design infringement has caused severe damage to a business or has required significant costs to bring an enforcement action. We of course sympathise with any person or entity whose IP is infringed but, ultimately, it must be recognised that any detriment to the designer is commercial and financial in nature and is therefore an inappropriate target for criminalisation.

[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?](#)

Relatively few jurisdictions criminalise the infringement of designs whatsoever. A small number of countries, such as Germany, France, Italy, Spain, Japan, and South Korea, provide criminal sanctions for registered design infringement. We have not been able to identify any country that provides criminal sanctions for unregistered design infringement.

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

CIPA's members support businesses ranging from sole traders to multinational companies. Our position is simple: we oppose the criminalisation of design infringement in all its forms. In our view, the Government's focus should be on practical civil reforms that deliver equitable outcomes for all businesses.

We have strong conviction that criminalising unregistered design right (UDR) infringement would not provide the speculated benefits. Instead, it would hurt designers of all sizes, stifle and suffocate legitimate design innovation activity, and add uncertainty and delay to a system that should be focussed on speed and clarity. In addition, the current evidence shows the existing criminal offence for registered designs (RDs) is ineffective and should be repealed, let alone be applied further in the designs regime.

In that context, CIPA strongly opposes the criminalisation of UDR infringement. We also favour repeal of the existing criminal offence for RD infringement.

We set out below five key pillars in support of our position.

1) UDRs are uniquely unsuited to criminalisation

The infringement of some IP rights - such as copyright, registered trade marks, and (for now) RDs - can be criminal in some circumstances, which has lead some to question why the same should not apply to UDRs. There is a straightforward answer: the criminalisation of UDR infringement is uniquely concerning because of the intrinsic nature of UDRs themselves.

UDRs are delicately balanced legal objects. They are a limited, highly qualified civil right designed to address straightforward copying in specific circumstances. They come into existence automatically and for free. As such, their scope and validity are untested and inscrutable up to the point of enforcement. Yet they immediately place limitations on the actions of others. Hence, they represent a considered compromise of the interests of rights holders vs those of third parties. Adding criminality to enforcement dramatically disrupts this balance in favour of the rights holder, to the marked detriment of other designers.

As further aspects to this balance, UDRs for example have stringent proof-of-ownership requirements, and in certain circumstances copying of a design covered by UDR is expressly permitted, i.e. after expiry of the associated UDR and during its last five years of term. Yet again, the compromise is that these specifics cannot be reliably known by third parties in advance.

The net effect of these different aspects is that UDRs are easy to obtain and powerful in civil proceedings – good for the rights holder designer – but that they are limited in scope and enforceability – good for other designers.

This necessarily leads to a compromise: it is effectively impossible for anyone other than the designer to know categorically whether an enforceable UDR exists. Diligent third parties cannot reliably assess:

- i) in which specific parts or features of an object any UDR subsists;
- ii) whether a given design is valid by being original and not commonplace;
- iii) whether a UDR exists by virtue of the owner being a qualifying person, and in the absence of exhaustion; and
- iv) when any UDR expires.

Put simply, in many real-world scenarios, one simply cannot tell whether a valid UDR exists, what it covers, or for how long. The same is not true for the other IP rights which have been criminalised.

Criminal liability turns on intention or subjective awareness of risk. A UDR's existence and scope are not reasonably certain to third parties in advance, meaning that UDRs are ill-suited to criminal sanctions. The burden of criminality is simply too high given the uncertain and amorphous nature of the right. Given the severity of criminality and the unknowable nature of a UDR, the only factor third parties can control is risk: to avoid it entirely, to take no action, to stop designing. We consider this chilling of design innovation activity the only plausible outcome.

In summary, the very features of UDRs that provide benefit to designers are the same that make criminalisation unsuitable. What is good for some designers in some contexts, can be bad for the very same designers in other contexts: criminal sanctions are good when enforcing, bad when defending – see section 3 below. However, UDRs are commercially meaningful in civil proceedings as they stand. Should further deterrents be needed, we consider them most effectively addressed within the civil framework – see section 4 below.

2) Inopportune timing in view of wider UDR reform

This consultation actively considers the wholesale reform of unregistered protection for designs in the UK. There could be imminent change in what form these rights take, what they cover, who owns them, their term length, and potential defences.

It is inappropriate to consider criminalising infringement of a right whose fundamental characteristics are not yet known. We submit that reforms in this area would be most efficiently tackled in sequence: settle the civil framework first, consider civil solutions and deterrents, and only then assess whether any genuine enforcement gap remains.

3) Criminalisation could hurt SMEs most

A significant factor in the discussion around criminalisation has always been the expense, effort, time, and stress of enforcing design IP for small designers. However, those very same SMEs are also those who are least equipped to defend a criminal allegation. Adding criminal liability makes product launches and iterations riskier and slower for all designers.

This is especially the case for UDRs, because freedom-to-operate (FTO) checks against unregistered rights are effectively infeasible if not impossible, for reasons as discussed in section 1 above. Large entities are better equipped to bring significant resources to bear on clearance, but SMEs are unlikely to have the same capacity. The mere allegation of criminality is a serious business concern – it should not be one that designers may find practically impossible to avoid, despite diligent attempts. The result will be fewer launches, more design outsourcing, and more caution, which is anathema to the UK's strive for growth.

Fundamentally, designers of every kind all depend in part on inspiration and iterative improvement, and do not work in a vacuum. To the contrary, the thriving and entrepreneurial design culture in the UK economy is testament to this ecosystem. Further criminalisation within the design space will ultimately deter the same community that it is intended to protect.

4) Improved civil deterrence and enforcement

Two key pillars of the argument in favour of criminalisation are its alleged deterrent effect and the difficulty and expense of enforcement.

The argument for increasing the alleged deterrent effect through criminality appears to be founded on the premise that justice itself is inaccessible. Anecdotes will surely be provided to allege that civil remedies cannot be accessed due to high barrier-to-entry cost and long timescales and are in any case insufficient. As a result, the reasoning arrives at avoiding civil remedies entirely through the threat of criminality as a deterrent.

First, we consider this argument necessarily concedes that criminality will have a dramatic chilling effect on design activity – this is precisely what a deterrent is. The deterrent effect cannot and will not be contained to only those performing intentional copying, and the threat of criminality is likely to stifle diligent designers far more than flagrant copyists. Secondly, and more importantly, this argument seems to give up on the advantages and benefits of the civil regime entirely. We disagree with this position and instead consider improving the civil regime the most desirable, effective, and advantageous option for all designers.

In particular, CIPA understands and supports the need for credible protection against wilful copying and improvements to remedies and access to justice. The flexibility of the civil regime could effectively address these concerns with proposals to :

- Introduce/strengthen uplifted civil remedies for wilful infringement (e.g., uplifted damages, indemnity costs, enhanced interest rates, etc., where copying is deliberate).
- Improve access to low-cost forums (e.g., provide an opinions service covering the validity and infringement of unregistered designs – with cost implications to deter subsequent litigation for example, allow registered design claims into IPEC small claims as proposed; refine costs caps, and promote active case management).
- Invest in fast-track relief (e.g., early neutral evaluation, for example a designs opinions service provided the UK IPO, or subsidised mediation for SMEs).
- Support registration uptake (keep fees reasonable; educate SMEs on the benefits of registration; clarify and modernise the products that can be registered).

These measures would make considerable progress on the policy objectives of deterrence and ease of enforcement. With reference to the Government's criminality standards (i.e., necessity and proportionality²), this clearly shows that there are effective, lower-risk civil alternatives that achieve the same goals.

5) Criminal sanctions do not provide improved protection or speed of justice

Criminal cases are slow and resource intensive. Crown Court backlogs are at near record highs, with nearly 80,000 cases pending³ and trials being listed years in advance. Consequently, it is extremely unlikely that police and Crown Prosecution Service bandwidth would be routinely applied to design infringement cases.

Further, at the point of there being an infringement, the criminality or otherwise of the UDR infringer does not benefit the UDR holder – it is too late. The mere fact of greater punishment for the infringer does not provide better remedy for the right holder. In contrast, dynamic civil remedies can be used to redress the wrong more effectively and commercially.

² <https://www.gov.uk/government/publications/making-new-criminal-offences/introducing-or-amending-criminal-offences-or-penalties>

³ <https://www.lawsociety.org.uk/contact-or-visit-us/press-office/press-releases/court-waiting-times-undermine-justice>

Courts and judges are currently ill equipped to assess certain aspects of the niche IP regime. Legal certainty in criminal cases is of utmost importance and cannot currently be guaranteed.

We are now over a decade since the criminalisation of registered design infringement. The data shows the number of prosecutions is vanishingly small. As discussed in response to question E3 above, there is only one reported case relating to s35ZA RDA, an appeal by members of a family who were convicted of selling counterfeit Apple AirPods. This provides evidence that the system appears to be of little use.

The assessment from the previous ‘Consultation on the Reform of the UK Designs Legal Framework Government Response - April 2013’⁴, paragraph 82 was that ‘After consideration, the Government is of the view that unregistered design rights would require too high a level of evidence to prove a criminal activity had taken place’. This assessment still stands.

In that context, we consider that criminalisation of design infringement is likely to be of negligible deterrent value.

Conclusion

We share designers’ frustration with copying. But criminalising UDRs would criminalise uncertainty, slow innovation, and burden small businesses with risks they can least afford—without delivering the fast, practical outcomes they need. A focused civil-first reform package will protect creators, unlock growth, and keep the UK a world-class place to design and build.

⁴ <https://webarchive.nationalarchives.gov.uk/ukgwa/20140712093446/http://www.ipo.gov.uk/response-2012-designs.pdf>

SECTION I - Call for evidence on inclusion of claims made under the Registered Designs Act 1949 within the Intellectual Property Enterprise Court's small claims track

Question 1 – Since 2020, have you been involved in a dispute, or considered launching a dispute, in relation to a registered design that you consider would have been suitable for the Intellectual Property Enterprise Court's small claims track, if it heard these types of cases?

Yes

Question 2 – Have you been a party to a dispute at the IPEC concerning an unregistered design where the validity of the design right has been challenged? (Y/N/Don't know/Prefer not to say)

Yes - we have not collected data on this, but we expect that at least some CIPA members will have been involved in such proceedings.

Question 3 – Do you have any evidence from other jurisdictions to indicate that lower cost dispute procedures are/are not appropriate forums for registered designs cases? (Y/N)

No

Question 4 – Do you support the inclusion of registered designs cases within the IPEC SCT?

Yes

Question 5 – Do you think that most registered designs cases are suitable for the IPEC SCT?

Yes

Question 6 – If there is a risk that registered designs cases could be moved from the IPEC SCT to the multi-track would this deter you from launching proceedings at the SCT?

Don't know

Question 7 – If registered design cases were included within the IPEC SCT, are there any other additional measures that could be taken to ensure these cases were handled effectively?

We think that the various options available to parties need to be carefully considered and excluded from the SCT. For example, if a request is then made to maintain the UK design registration in an amended form pursuant to s11ZD RDA 1949, then perhaps it becomes too complex for the SCT. Furthermore, consideration needs to be given regarding certificates of contested validity as it is unclear what the costs outcome would be of starting a claim on the SCT with such a certificate would be. If this cannot be resolved, then perhaps registrations with certificates of contested validity should be excluded from the SCT. On the other hand, if a certificate means that validity is not considered during proceedings, then the SCT may very well be more appropriate.

Question 8 – Are there any alternatives to the inclusion of registered designs cases in the IPEC SCT that would improve access to justice for individual designers and SMEs?

Yes.

In addition to the SCT being made available, we consider that the infringement opinion service (as allowed for in the IP Act 2014) needs to be launched by the UKIPO, for consideration alongside or within invalidity proceedings before the UKIPO. For example, we consider that decisions on validity could also include an opinion on infringement. This would be particularly useful for invalidity applicants who are applying because they have received a threatening letter or online marketplace takedown notice.

If the invalidity decision is that the registered design is valid, then it could be useful if there was an opinion on infringement at the same time. For example, the decision could be that the registered design is valid over the prior art for including novel features X and Y, but that as the allegedly infringing product does not include features X and Y then there is no infringement.

Many parties may then find that such an opinion is sufficient to end the matter without needing to resort to court proceedings. In addition, online marketplaces could be required by legislation, or otherwise encouraged, to reinstate listings after a non-infringement opinion or invalidity decision is reached.

Please provide any additional information or evidence or case studies to support your responses.

We think that registered designs should be part of the SCT, particularly to aid smaller businesses and litigants in person. We consider that this would significantly reduce costs for such parties. We would highlight *Simon Barber v Steven Francis Wakefield Ors* 2024 EWHC 3058 IPEC, particularly paragraph 3, which relate to registered design infringement proceedings between litigants in person that could very well have been heard on the SCT.