

# **Consultation on the Modernisation of the UK System of Registration of Designs**

## **Summary**

It is proposed to make changes to the law governing the registration of designs. The proposals take the form of a draft Order under Regulatory Reform Act 2001 ("the 2001 Act") which will make various changes to the Registered Designs Act 1949. In addition there is a complementary proposal to consolidate and revise the Rules made under that Act (the amendments to the Rules are not part of the Regulatory Reform process, but the consultations are being run together). Therefore the Registered Designs Rules 1995 (SI 1995/2912) ("the 1995 Rules") will be revoked. Both proposals are aimed at a single objective: to make the national system for registering designs as affordable, quick and as accessible as possible.



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# **Part 1**

## ***Introduction***

### **Background**

- 1.1 On 9th December 2001 the Registered Designs Act 1949 ( "the 1949 Act") was amended by the Registered Designs Regulations 2001 (SI 2001/3949) to comply with the EC Directive on the legal protection of designs (Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998) ("the Designs Directive"). The powers granted by the European Communities Act 1972, under which the Registered Designs Regulations 2001 were made, would not have extended to allow certain amendments to the procedural requirements of the 1949 Act which, even at that point, were considered to be desirable.
- 1.2 Since the amendments came into force at the end of 2001, it has become increasingly apparent that the 1949 Act, and the Registered Designs Rules 1995 (SI 1995/2912) made under that Act, are in need of modernisation (see Part 2 and 3 on the current law and our proposals for change).

### **The purpose of the proposals**

- 1.3 UK businesses register and protect fewer designs than some of their competitors in other countries, most notably France and Germany. If the 1949 Acts and the Rules made under it made it easier to protect new designs this should encourage innovation and enhance the competitiveness of UK businesses. The Design Registry at the Patent Office would therefore like to ensure that the national system for registering designs offers a useful and cost effective alternative to the system of registering Community designs.
- 1.4 The proportion of design applicants representing themselves before the Patent Office has risen to around 70%, which reflects the continuing value of a national design registration to small and medium sized businesses. We would therefore like to take the opportunity to consult with all users of the design registration system to ensure that, as far as possible, the system meets the needs of small and medium sized enterprises, as well as those of larger firms, who see a continuing value in national registered designs.

### **Regulatory Reform Order-making**

- 1.5 Each proposal for a Regulatory Reform Order ("RRO") must satisfy a number of legal tests. The questions in the rest of this document are designed to elicit the information that the Minister will need in order to satisfy the Committees that, among other things, the proposal satisfies these tests.
- 1.6 For this reason, we would particularly welcome your views on how each aspect of the proposed changes in this consultation document meets the following tests:

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- *Necessary protection* - the Minister making an RRO must be of the opinion that it does not remove any necessary protection. This means that no order can be made unless the Minister is of the opinion that it would maintain any protections that the Minister considers to be necessary. Such protection relates to the checks and balances associated with a particular regulatory regime. The protection does not have to be statutory in nature and does not have to be for the purposes originally intended by Parliament. If the Minister considers a particular protection to be no longer necessary, he or she must provide the Parliamentary scrutiny committees with compelling evidence to support this view.
- *Rights and freedoms* - an RRO cannot be made unless the Minister is satisfied that it does not prevent any person from continuing to exercise any right or freedom which they might reasonably expect to enjoy. This test recognises that there are certain rights that it would not be fair to take away from people under these procedures.

## Other Safeguards

1.7 In order to provide for the effective reform of regulatory regimes, RROs can re-state existing burdens and create new burdens. But where that is the case stringent additional safeguards apply:

- *Proportionality* — If a new legal burden is being imposed (or an existing burden is being re-enacted), then the Minister must ensure that it is proportionate to the benefit it brings. This means, for example, that imposing a burden which will cost charities several thousand pounds in return for some negligible benefit would not pass the test.
- *Fair balance* — before proposing any RRO that has the effect of imposing new legal burdens, the Minister must be of the opinion that a fair balance is being struck between the interests of the person affected by the Order and the interests of the wider public. In this context, fairness does not mean that everyone must benefit. What it does mean is that the benefit to society as a whole must be such as to justify the additional burden on a small group or the individual.
- *Desirability* — before proposing any RRO that has the effect of imposing new legal burdens, the Minister making the Regulatory Reform Order must be of the opinion that the extent to which it removes burdens or brings other benefits makes the Order as a whole desirable.

## Consultation

1.8 The Act requires Departments to consult widely on regulatory reform proposals. It requires us to collect evidence on a number of issues from a wide range of consultees. The list of consultees, including the devolved administrations, to whom the document has been sent is at Annex D. It is also available on the Internet at:

<http://www.patent.gov.uk>; and

<http://www.ukonline.gov.uk>

- 1.9 Comments are invited from all interested parties, and not just from those to whom the document has been sent. A response form is at Annex F.
- 1.10 The Parliamentary Committees who will deal with orders under the 2001 Act have requested that a note explaining the Parliamentary process for orders to be made under the Act be annexed to all consultation papers so that consultees understand when and to whom they are able to put their views, should they wish to do so. This is set out in Annex E.
- 1.11 This consultation document follows the format recommended by the Cabinet Office for such proposals. The criteria applicable to all UK public consultations under the Cabinet Office Code of Practice on Consultation are set out in Annex H.

## **Disclosure**

- 1.12 Normal practice will be for details of representations received in response to this consultation document to be disclosed, or for respondents to be identified. While the 2001 Act provides for non-disclosure of representations, the Minister is required to include the names of all respondents in the list submitted to Parliament alongside the draft Order. You should note that:
  - If you request that your representation is not disclosed, the Minister will not be able to disclose the contents of your representation without your express consent and, if the representation concerns a third party, their consent too. Alternatively, the Minister may disclose the content of your representation but only in such a way as to make it anonymous;
  - In all cases where your representation concerns information that may be damaging to the interests of a third party, the Minister is not obliged to pass it on to Parliament if he does not believe it to be true or he is unable to obtain the consent of the third party.
- 1.13 Please identify any information which you or any other person involved do not wish to be disclosed. You should note that many facsimile and e-mail messages carry, as a matter of course, a statement that the contents are for the eyes only of the intended recipient. In the context of this consultation such appended statements will not be construed as being requests for non-inclusion in the post consultation review unless accompanied by an additional specific request for confidentiality, such as an indication in the tick-box provided for that purpose in the response form of Annex F.
- 1.14 Finally, you should be aware that the scrutiny Committees will be able to request sight of your representation as originally submitted. This is a safeguard against attempts to bring improper influence to bear on the Minister. We

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envisage that, in the normal course of events, this provision will only be used rarely and on an exceptional basis.

### **Freedom of Information**

- 1.15 It is possible that requests for information contained in consultation responses may be made in accordance with access to information regimes (these are primarily the Freedom of Information Act 2000, the Data Protection Act 1998 and the Environmental Information Regulations 2004). If you do not want your response to be disclosed in response to such requests for information, you should identify the information you wish to be withheld and explain why confidentially is necessary. Your request will only be acceded to if it is appropriate in all the circumstances. An automatic confidentiality disclaimer generated by your IT system will not of itself be regarded as binding on the Department.

### **The Proposals for the Revised Rules**

- 1.16 We are seeking the views of all of our customers about these proposed rule changes in order that we can be sure to deliver the best possible service to UK business. It is proposed that the rule changes will be made, and will come into force, at the same time that changes are made to the Registered Designs Act 1949 by the Regulatory reform Order.
- 1.17 Comments on both proposals should be sent by **close of play, 23<sup>rd</sup> September 2005**, at the latest to:

Janet Folwell  
Room 2Y08  
Concept House  
Cardiff Road  
Newport  
South Wales  
NP10 8QQ  
Fax: 01633 811174  
E Mail: [janet.folwell@patent.gov.uk](mailto:janet.folwell@patent.gov.uk)

from whom further copies of this document may also be obtained.

## **Part 2**

### ***Registered Designs - An Overview of the system of Design Registration and of the Rights which flow from it***

#### ***Background to the policy and legislation at issue***

#### **Background**

- 2.1 The Registered Designs Act 1949 is the Act which governs the registration of designs in the United Kingdom. The Act also extends to the Isle of Man (see section 47 of the 1949 Act). Anybody can apply to register a design under the Act and as explain above it has become increasingly popular with small and medium sized enterprises and private applicants. However, it is also used by larger enterprises as well.
- 2.2 The regime for the registration of designs has changed substantially since its inception in the late eighteenth century. After a number of Acts dealing with particular products the legislation was consolidated a number of times before it was finally consolidated in the present 1949 Act.
- 2.3 Since that consolidation the law of registered designs has undergone a number of changes. The two most significant changes were made by the Copyright, Designs and Patents Act 1988, which meant that registered designs were no longer treated as "industrial copyrights" (there are transitional provisions for subsisting registrations). However, the most significant change was brought about by the harmonisation of design law in the European Community under the Designs Directive. Now, therefore, the substantive law of registered designs is governed by that Directive, but procedural matters remain outside its scope. The proposed RRO affects only procedural matters.

#### **The Community design system**

- 2.4 It is also possible to register a design as a Community design at the Office for Harmonisation in the Internal Market, Trade Marks and Designs (OHIM) under Council Regulation on Community Designs (EC) No. 6 of 2002 ("the Community Design Regulation"). The registered Community design provides similar rights to a national registered design, except that a Community design is a unitary right covering the whole of the European Community. It has proved to be an attractive proposition for European businesses; between 1st April 2003 (the date of its introduction) and 30th September 2004, a total of 72,015 new Community design applications were filed. Since the advent of the registered Community design, UK national applications for registration have dropped by 60%.

- 2.5 The Community system represents a modern and more liberal approach to procedural requirements, many of which the 1949 Act presently forbids. Thus this new system has shown the 1949 Act to be quite dated. It is therefore desirable to modernise the domestic legislation to grant some further flexibility.

### **The basics of registered design law**

- 2.6 A design is defined by section 1(2) of the 1949 Act as:  
*“the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.”*
- 2.7 This is a broad definition covering designs as diverse as works of art and graphic designs and, at the other extreme, the shape and appearance of functional objects such as umbrellas and machines.
- 2.8 In order to qualify for protection a design must be “new” and have “individual character” (see section 1B of the 1949 Act). This means that it must convey to a user, who is informed as to the relevant field of design, a different overall impression compared to any known pre-existing design.
- 2.9 There are other reasons why a design may not be protected under the 1949 Act. The Act excludes designs consisting of the features of appearance of a product which are solely dictated by the product’s technical function (see section 1C of the 1949 Act). Such designs may, however, be an invention which could be protected by a patent. Nor can a design be registered if it must necessarily be reproduced in its exact form and dimensions so as to permit the product in which the design is incorporated to fit and function with another product (see section 1C of the 1949 Act). This is to prevent anti-competitive monopolies in the spare parts markets. There are further grounds of refusal which prohibit the registration of designs which are contrary to accepted principles of morality (see section 1D of the 1949 Act); or which infringe protected emblems, arms or flags (see Schedule A1 of the 1949 Act).
- 2.10 A national registered design provides the holder with an exclusive right to use the design and any other design which does not create a different overall impression. Registered designs are protected for 5 years. They can be renewed for successive 5 year periods up to a maximum period of 25 years. A registered design is also a property right which can be bought or sold like any other property.
- 2.11 The validity of a registered design can be challenged at any time. The validity of national designs can be challenged at the Patent Office: see sections 11ZA to 11ZF of the 1949 Act (and rules 52 to 57 of the Registered Design Rules 1995 (SI 1995/2912); the draft Rules cater for such hearings under Part 3) and registered Community designs at OHIM under Articles 24 to 26 of the Community Design Regulation.

## **Part 3**

### **An Overview of the Proposals for a Regulatory Reform Order**

#### **Consultees are invited to consider the following proposals:**

##### **Proposal 1: Ending substantive examination for novelty**

- 3.1 The Registered Designs Regulations 2001, which implemented the Designs Directive, brought about a number of fundamental changes to the UK law governing registered designs. Before those Regulations were implemented, prior disclosure of a design in the UK prevented it from being regarded as a new design for the purposes of registration. Since those changes were made, the disclosure of a design anywhere in the world may now be sufficient to invalidate a later registration of the design in the UK, if the prior disclosure of the design is likely to have come to the attention of a person located in the European Economic Area (EEA).
- 3.2 Only a minority of designs are registered and therefore available to be searched in the registers maintained by national authorities. Given this and the world wide scope required for a fully effective search for earlier designs, it is practically impossible for an examiner to carry out a conclusive search in all the relevant overseas territories in order to satisfy himself that a design is indeed a new one.
- 3.3 In anticipation of the changes to the national law on designs, the Registrar changed his examination practice on 21st April 1999. Since that date the Registrar has not conducted an automatic search of earlier designs as part of the examination process. Instead, the practice has been to raise lack-of-novelty objections only where, in the Examiner's judgement, a design is self evidently not new or is lacking in individual character due to an already published or well known design. In practice, over 90% of applications for registration are registered without a search having been conducted of earlier designs.
- 3.4 Those objections which are raised tend to arise when the design is to be applied to consumer goods (because the examiner is more likely to have experience of the market), or occasionally to an industrial product that the examiner happens to have some personal knowledge about. The result of the examination process has therefore become somewhat arbitrary and difficult to predict. It is therefore unsurprising that the number of designs finally refused registration on account of lack of novelty or individual character is very low indeed: less than 2%.
- 3.5 The value of retaining examination on novelty grounds has been further eroded by the introduction, in 2003, of the registered Community design. The Community Design Regulation which established the Community design

requires OHIM to register designs without examination as to whether the design is new or has individual character. Thus an applicant faced with a lack of novelty type objection raised by an Examiner in the UK Designs Registry, which he does not agree with, has the option of effectively circumventing the objection by re-filing the application for registration as a registered Community design. Not surprisingly, many do.

- 3.6 It appears that the remaining value of examining national design applications on novelty grounds is very low. It is thought that the benefit of examination is now greatly outweighed by the burden it places on users of the system, particularly where the examination is necessarily incomplete and unpredictable. It is therefore proposed to abolish the power of the Registrar to refuse a design on the grounds that it lacked novelty or individual character. This will also remove the need for the examiner to examine design applications for those characteristics.
- 3.7 This means that users of the system will no longer be burdened by the cost and delay involved in seeking to persuade the Registrar that their design creates a different overall impression to any earlier design identified by the examiner as being potentially relevant.
- 3.8 The proposed change will bring greater legal certainty and clarity. At present, it is impossible for any applicant who has not faced a substantive objection at examination stage to know whether or not his design has been examined. In future it will be clear to all that no new registered designs have been examined on novelty grounds and therefore there can be no undue expectation that the Registrar has satisfied himself in this respect before the design is registered.
- 3.9 The impact on the general public will be minimal. Ending novelty examination will result in slightly more invalid designs being registered than is currently the case, but there will still be the option of challenging the validity of these registrations by bringing invalidity proceedings before the Patent Office or the court. This will place an additional cost on those wishing to challenge the validity of registered designs, but in fact so few designs are presently examined that the saving in costs for users of the system will, on the whole, be reduced.
- 3.10 Ending the current unsatisfactory examination policy on novelty and individual character grounds will make the system more attractive to users of the registered design system (e.g. applicants for registered designs and their agents), as it will become faster and make registering a design more easily affordable. This should also encourage users to exploit the system more, as it will be easier to predict the likelihood of registration on the remaining substantive grounds of refusal listed in section 3A(4) of the 1949 Act (as it would be amended by the RRO).
- 3.11 It is proposed that a new rule will be introduced in the Rules made under the 1949 Act to make the publication of all registered designs mandatory. This will make it easier for those with an interest in the field of designs to challenge any design registrations that they believe to be invalid. The easy availability of this

information is part of the quid pro quo for finally ending examination on novelty grounds.

## **Proposal 2: Allow multiple applications**

- 3.12 Under the current law, only one design can be included in a national application for registration. Thus, an applicant wishing to register a number of designs at the same time must file a separate application for each design, each of which will be paid for and processed separately. This requirement represents a burden in time and cost on those who, by reason of the nature of their business, sometimes need to register a number of new designs at the same time. It also places a burden on the Registrar as each application needs to go through the formal procedure separately rather than considering applications collectively.
- 3.13 The Community Design Regulation, which introduced the registered Community design, already provides for multiple design applications. This has proved to be popular with users. Over half of all Community design applications include more than one design and the average number of designs included in every Community designs application is 3.83. It is expected that a similar pattern would emerge if multiple designs were permitted by the national system.
- 3.14 It is therefore proposed to amend the law so that one or more designs may be included in a single application for registration. This will be administratively simpler for the applicant (for example, he will only have to provide his name and address once). It will also be simpler for the Office because the information which is common to all the designs will only have to be recorded once and only one filing receipt issued.
- 3.15 Unlike the Community design system, it is not proposed to only allow multiple applications where the designs are to be incorporated in products falling within the same class of the Locarno product classification system (see the Locarno Agreement Establishing an International Classification for Industrial Designs (8th October 1968)). The national design registration is used by a high proportion of applicants without professional representation. We feel that limiting the scope for multiple design applications to classes of a technical product classification system, which is little known or understood by non-IP professionals, will make the system more complex than it needs to be. Given the proposal to end examination on novelty grounds, there is little benefit to the Registry in requiring designs included in an application to all be for the same type of product. It is therefore proposed to adopt the system that is most flexible for applicants.
- 3.16 It is intended that the administrative savings which result from permitting multiple design applications will be passed on to applicants in the form of a discount in the cost of including two or more designs in an application for registration.
- 3.17 It is proposed to change Section 3A of the 1949 Act so that where an application includes multiple designs and one or more of the designs meet the

remaining requirements for registration, and one or more designs do not, the Registrar will be under a duty to register the design or designs which do meet the requirements for registration irrespective of the fate of the other designs. Consequently, there will be no need of a provision for dividing an application in order to avoid a situation whereby the registration of a design is delayed as a result of it being included in an application along with another design, or designs, which do not meet the requirements for registration.

### **Proposal 3: Ending the withdrawal of some registered designs from public inspection**

- 3.18 The publication of a registered design prior to products embodying the design being placed on the market can have negative consequences for the proprietor. For example, the publication of a company's new designs may give its competitors a commercial advantage by affording them an insight into their rival's forthcoming products. It can also aid the less scrupulous to place out and out copies of the proprietor's designs on the market at a time which coincides with the launch of official products embodying the designs.
- 3.19 The current law provides for designs embodied in prescribed classes of products to be withheld from public inspection for a prescribed period following registration of the design. A particular person may nevertheless be given access to the registered design during this period with the agreement of the proprietor or, where the circumstances justify it, at the discretion of the Registrar or a court.
- 3.20 The only classes of products which have been prescribed for this purpose are textile products, wallpaper, similar wall coverings and lace (see rule 69 of the 1995 Rules). The reason for singling out these products appears to be largely historic.
- 3.21 The effect of the prescription is that designs associated with these products can be registered and yet remain unavailable for public inspection for up to three years. This places a burden on those engaged in business and who may be affected by a registered design, but who are denied free access to it.
- 3.22 It is true that the Act makes provision for the exemption from a possible damages claim for an innocent infringer who was not aware, and had no reasonable ground to suppose, that a particular design was registered. However, such registered designs may nevertheless be enforced by way of an injunction against unauthorised third party use.
- 3.23 We have considered how the law could be changed to better reflect the needs of business. We propose that the Act be amended so as to delete the prohibition on public inspection of registered designs contained in sections 22(2) and 22(3) of the 1949 Act.
- 3.24 We propose to make provision in new Registered Design Rules for the registrar to publish all registered designs. It is proposed that the Rules will require an applicant to provide his consent for the publication of any representation of a

design that he files at the Registry. Delaying doing so would result in a delay in the publication and registration of the design, and ultimately may lead to the application to register the design being deemed abandoned. Nevertheless, this provision should give applicants a degree of control over the timing of the publication and registration of their design and therefore help to avoid the problems described in paragraph 3.18 above.

#### **Proposal 4: Facilitating the restoration of lapsed design registrations**

- 3.25 This proposal is designed to make it easier for a proprietor to restore a registration that he has allowed to lapse due to non payment of the renewal fee. It will have no impact on the public other than ensuring that the proprietors of registered designs are able to reinstate their legitimate rights in a greater number of circumstances.
- 3.26 Section 8A of the 1949 Act enables a proprietor to apply to restore his rights in a registered design which has been allowed to lapse through non-renewal, but the application will only be granted where the proprietor can show, through evidence, that his failure to renew the registration occurred despite him having taken reasonable steps to extend his registration. It is proposed that, in future, an application for restoration should be granted where the proprietor is able to state that the failure to pay the renewal fee was unintentional. The law would therefore show greater flexibility where a registration lapses due to administrative error.
- 3.27 The change would remove the burden from the proprietor of providing evidence that he or his employees took reasonable care in the matter and provide him with a greater prospect of securing a belated renewal of his design registration. But the proposed change would not interfere with the provisions under section 8B of the 1949 Act that protect any other party who commences use of the design after the date that its registration lapsed, but before it is restored by the proprietor.

#### **Transitional provisions**

- 3.28 The substantive law governing designs in the United Kingdom is, unfortunately, very complicated. This is caused by a series of transitional arrangements being included in the Copyright, Designs and Patents Act 1988 and the Registered Designs Regulations 2001. The net result of these arrangements is that there are three types of designs subsisting under the 1949 Act: (i) those that were registered before 1988; (ii) those registered between 1988 and 2001; and (iii) those registered after 2001. This complexity means that certain provisions of the 1949 Act do not apply to certain designs, to ensure that the transitional arrangements already in place are not adversely affected certain amendments made by the proposed RRO will not apply to certain designs (namely those in category (i) and (ii)). The relevant amendments are made by articles 7 to 10 of the proposed draft Order. These articles amend sections 3B, 11ZA, 11ZB, 11ZD of the 1949 Act.

### **Subordinate provisions**

- 3.29 There are no subordinate provisions, within the meaning of the 2001 Act, included in the proposed RRO.

### **Supplementary and consequential provisions**

- 3.30 A large part of the proposed RRO is made up of consequential provisions. The need for these and where they are made is set out in detail in the Part 4 of this document.

### **Summary of Regulatory Impact Assessment**

- 3.31 Three options have been considered. We could do nothing. This option would mean that the UK design registration system will remain out of date and unattractive to users. In view of the current low demand for new registrations, statutory fees will have to be increased in order to cover the cost of running the national system. UK businesses will then be faced with a choice between higher national registration fees or still higher Community design registration fees, leading to even fewer small businesses protecting their designs through registration.
- 3.32 Another option would be to modernise the designs registration system without any changes being made to the primary legislation. This could be done by changing the Registered Designs Rules which underpin the way in which the primary legislation works. But the most that could be achieved with this option would be some minor improvements to reduce bureaucracy when filing a new application. Such changes would make a negligible difference to the future demand for the system, and therefore the consequences highlighted in the above option would still apply.
- 3.33 We prefer another option which is to modernise the primary legislation with a package of changes to simplify the pre and post registration procedures, and at the same time make the system more transparent and affordable. The proposals will encourage more innovators (especially smaller businesses) to register their designs in the UK, and larger businesses will also benefit from the easier and less costly designs registration system. The end result will be that the future demand for the UK designs registration system will grow as more businesses seek to protect their designs through registration, and this in turn will keep statutory fees at a low level whilst still funding the cost of running the system.

### **Devolved administrations**

- 3.34 Registered designs like all other areas of intellectual property (except certain plant varieties) are reserved matters. Therefore, the changes made by the proposed RRO would apply to the whole of the United Kingdom (including the Isle of Man). However, there are no special implications for the devolved administrations or the Isle of Man.

**Other matters**

- 3.35 It is proposed to informally consult users separately about the making of an Order under the Electronic Communications Act 2000. Such an order would add a new provision to the 1949 Act which would allow the registrar to make directions facilitating and governing electronic communication to (and from) the Registry. Any such Order is likely to be very similar to the Patents Act 1977 (Electronic Communications) Order 2003 (SI 2003/512).



## **Part 4**

### ***Regulatory Reform - Legal Analysis***

#### **Proposal 1: Ending substantive examination for novelty**

##### **Burdens under the Current Law and the removal or reduction of burdens (Sections 6(2)(a) and 6(2)(b) of the 2001 Act)**

- 4.1 The process described below sets out what happens when a person applies to register a design at the Design Registry of the UK Patent Office.
- 4.2 Once a person has applied for a registered design the Registry performs a “formalities” examination. This examination checks whether certain requirements as to form and content of the application are complete. This examination has nothing to do with determining whether or not a particular design is suitable for registration under the 1949 Act.
- 4.3 Once the formal examination is complete a substantive examination of the application for registration is undertaken. During this examination the registrar, or more accurately, an examiner will determine whether the design satisfies a number of substantive considerations. The examiner will have to determine whether or not he thinks the design is dictated by its technical function. If he concludes that it is so dictated then the right in a registered design cannot subsist (section 1C(1) of the 1949 Act). In other words, the application is refused (under section 3A(4)). Similarly, he examines whether the application is contrary to public policy or morality (section 1D of the 1949 Act). However, there is another requirement that must be satisfied before a design can be registered. It must be new and have individual character (section 1B(1) of the 1949 Act). For a design to be new and have individual character it must create a different overall impression when compared to any design previously known to exist in the European Economic Area.
- 4.4 To assist him in determining whether or not a design is new or has individual character the examiner may make such searches (if any) he thinks fit (section 3(4) of the 1949 Act) ("novelty search"). If, as a result of those searches or otherwise, an examiner considers that an application is not new or does not have individual character he must refuse the application under section 3A(4) of the 1949 Act. This refusal automatically entitles the applicant to an appeal (section 3D of the 1949 Act).
- 4.5 In practice, however, before the application is refused the applicant is notified of the substantive objections. If he wishes to proceed with his application he has to undertake a number of procedural steps (these are set out in rule 29 of the 1995 Rules). These steps generally involve making representations, which will initially be written representations, but there may eventually be an oral hearing. Obviously, the purpose of these steps is to enable the applicant to persuade the examiner that his design is new and has individual character. This imposes a considerable burden on an applicant, one which often it is not worth bearing.

- 4.6 This is demonstrated by the common practice of withdrawing an application facing an objection at the UK Registry on the grounds of lack of novelty and applying instead to the Office for Harmonization of the Internal Market (OHIM) for a registered Community design. The Community Design Regulation ((EC) Regulation No 6/2002/EC), which governs the grant of such designs, does not permit OHIM to refuse to register a design on the grounds that it lacks novelty or individual character. OHIM do not, therefore, conduct novelty searches and so the applicant will not face any substantive objections on that basis. If an applicant decides to abandon his domestic application and only pursue his Community application the cost of prosecuting that first application will be wasted.
- 4.7 It is self-evident that refusing to register an applicant's design on the grounds it is not novel or lacks individual character is a burden on that applicant. In addition, it is clear that the process of substantive examination for novelty itself places a significant burden on the applicant in terms of wasted time and wasted costs if he abandons the application to file at OHIM. Alternatively, if he pursues the application he faces substantial costs trying to persuade the Registry that his design is new and has individual character.
- 4.8 It is therefore proposed that the registrar should no longer be able to refuse an application on the grounds that it lacks novelty. This will also remove the need to conduct searches and to substantively examine the application on those grounds.
- 4.9 To remove this burden section 1A of the 1949 Act will be repealed. Further, the power to conduct searches, set out in section 3(4) of that Act, would also need to be repealed.

**Re-enacting Provisions and new provisions imposing legal burdens  
(Section 6(2)(c) and (f) of the 2001 Act)**

- 4.10 No legal burdens are being re-enacted and no new provisions are included which impose legal burdens.

**Impact on Necessary Protection and Rights and Freedoms  
(Sections 6(2)(d) and 6(2)(e) of the 2001 Act)**

- 4.11 At present it is possible for a design which is not new or does not have individual character to be refused registration or if it has already been registered to be declared invalid. The grounds for declaring a registration invalid are set out in section 11ZA. These include, in subsection (1), being invalid on any of the grounds mentioned in section 1A of the 1949 Act. Although it will no longer be possible for the registrar to refuse to register a design on the grounds of novelty, it is not intended to stop a person making an application for a declaration of invalidity (under section 11ZB of the 1949 Act).
- 4.12 The public will therefore retain the necessary protection because they will still be able to launch invalidity proceedings to challenge any registration. Further,

because at present it is uncertain whether any particular design has been examined or not, it could be argued that removing all substantive examination removes that uncertainty and adds protection. This protection comes from the fact that nobody could place unjustified reliance on the register of designs on the basis that they believe a design has been registered, and so must be valid, be new and have individual character.

- 4.13 It is proposed as part of Proposal 3 (inspection) to impose an obligation on the registrar (in the Rules made under the 1949 Act) to publish every application for the registration of a design. At present the registrar voluntarily publishes most design registrations in the journal *Designs in View*. Therefore, as an additional protection it is proposed to turn this into a statutory duty which will apply to all registered designs.
- 4.14 Overall, it is not intended to change the underlying requirements for the subsistence of a design. All that is proposed is that the Registrar will no longer consider whether a design is novel or not, leaving this to members of the public.
- 4.15 This may, at first blush, appear to be making a substantial change in the role of the registry. However, this is not the case. This is because there is no effective mechanism for searching prior art. Only a small proportion of “designs”, within the meaning of the 1949 Act, are actually registered. A full examination would necessitate a search of the marketplace for “unregistered” designs (whether or not they are protected as such). This task is impractical and the results of searches of registered designs may therefore be misleading. The European Commission considered introducing a novelty search as part of the procedure for obtaining a registered Community design. However, they rejected such an approach saying that:

*“Experience from national registration systems suggests that such examination is at best of limited value and at worst futile, and usually only gives a false and therefore dangerous feeling of legal certainty.”*

Commission Proposes EC-Wide Industrial Design Protection: Press Release P/93/36.

- 4.16 These problems led the Patent Office to decide in 1999 that it would no longer routinely search prior art (see "Notification of a Change in the Examination of Design Applications" *Patents and Designs Journal No. 5738*, 28th April 1999, at p. vii.). Since that time only about 10% of cases actually involve a search of the national register being carried out and these are usually instigated because the examiner has some familiarity with the field of designs concerned.
- 4.17 At present, it is impossible for an applicant, who has not faced a substantive objection, to know whether or not his design has been examined. Furthermore, even if it has been examined for novelty the breadth of the potential prior art is such that any comfort that could be granted by a search is minimal at best.
- 4.18 To conduct a thorough search to the standard whereby a person can normally rely on the validity of a design would push up the cost of applying for a registered design to an unacceptable level. It is suggested that it would be better

to maintain a cheaper deposit system and leave it to traders in the market to challenge registered designs, if and when, they find relevant prior art.

- 4.19 The balance that needs to be struck is between the applicant and the public. If novelty examination ends then slightly more invalid designs will be registered. Thus, members of the public will either have to challenge the validity of those designs or not use the design. However, because so few applications are examined for novelty at present and, of those examined, even fewer are the subject of successful objections by the register, the actual impact on the public will be small. Whereas the reduction in delay and cost faced by applicants who face a substantive objection will more than counterbalance a few more improperly granted exclusive rights.
- 4.20 Furthermore, if the design system becomes quicker and cheaper then it will be more desirable to designers and the underlying benefit of the registered designs system - encouraging innovation - will be enhanced..

**Consequential amendments  
(Section 1(6) of the 2001 Act)**

- 4.21 It is proposed to insert three new subsections into section 11ZA. Subsection (1)(a) would permit a design to be declared invalid on the grounds it does not fulfil the requirements of section 1(2) of the 1949 Act. Subsection (1)(b) would permit a design to be declared invalid on the grounds that it does not fulfil the requirements of sections 1B to 1D of the 1949 Act and subsection (1)(c) would permit a design to be declared invalid if any ground of refusal mentioned in Schedule A1 applied. In addition, new subsections (1A) and (1B) reflect the effect of the present sections 1A(2) and (3).
- 4.22 All of these grounds of invalidity presently exist as grounds of refusal under section 1A, which is presently mentioned in section 11ZA(1) of the 1949 Act. Therefore, the new sections 11ZA(1) to (1B) merely restate what is already the law. So, these amendments are merely consequential on the repeal of section 1A.
- 4.23 At present section 3A(4) refers to section 1A of the Act. To give effect to Proposal 2 (multiple applications) it would be necessary to modify section 3A(4) considerably. This would include a number of cross-references to what is presently section 1A, making the new section 3A(4) unnecessarily complicated. Therefore, it is proposed to move the remaining substantive grounds (i.e. other than novelty) to section 3A(4). Those re-stated grounds will have the same effect as the present provisions found in section 1A(1). It is, therefore, purely a drafting change based on the repeal of section 1A (and so consequential).
- 4.24 A number of minor consequential amendments are also necessary to give effect to this. In section 11ZA(3) and in section 20(1A)(b) references need updating to reflect that the grounds of invalidity, that were originally set out in section 11ZA(1) only (by reference to section 1A), are now set out in section 11ZA(1) to (1C). Further, a number of references to section 1A need to be updated so that they now refer to the new section 3A(4) and section 11ZA(1) to (1D). This

involves consequential amendments to section 3B(4), 11ZA(1) and (2), 11ZD(1) and section 20(1A)(a).

**Supplemental or incidental provision  
(section 1(6) of the 2001 Act)**

4.25 It is proposed to permit a registered proprietor to apply to the registrar to modify his registration where the registrar intends to declare the registration invalid on the grounds mentioned in the new section 11ZA(1C) (presently section 1A(2) of the 1949 Act). At present an application being granted on this basis is not included within the scope of section 11ZD, and a proprietor who faces invalidity proceedings therefore has no opportunity to try and rectify his registration. In contrast, where a design is due to be declared invalid on other novelty grounds (i.e. section 1B) the proprietor is given such an opportunity. This change could be considered to remove an anomaly (within the meaning of section 1(1)(d) of the 2001 Act); alternatively, it is a supplemental or incidental provision (within the meaning of section 1(6) of the 2001 Act). It is proposed, therefore, to permit a proprietor whose application is about to be declared invalid on the grounds of proposed section 11ZA(1C) to have the opportunity to modify his application and so save it from total invalidity.

**Transitional provision  
(section 1(6) of the 2001 Act)**

4.26 Article 19 of the Order provides a transitional provision. The purpose of this provision is to limit the effect of articles 7 to 10 (which relate to invalidity). At present any design that resulted from an application made before the Registered Designs Regulations 2001 (SI 2001/3949) came into force is judged, in relation to invalidity, under the pre-2001 law. The transitional provision simply ensures that in relation to invalidity (or cancellation in pre-2001 terms) the two regimes are kept separate.

**Proposal 2: Allow multiple applications**

**Burdens under the Current Law and the removal of burdens  
(Sections 6(2)(a) and 6(2)(b) of the 2001 Act)**

4.27 At present the 1949 Act precludes an applicant from applying for two or more designs in a single application. This burden is not expressly stated on the face of the legislation, but is the effect of the wording of section 3 of the 1949 Act.

4.28 Section 3 of the Act permits an application for the registration of a design to be made. Although it may initially appear that the words “a design” would include “designs” (in accordance with section 6 the Interpretation Act 1978), other parts of the 1949 Act are drafted in such a way as to make it clear that the references in section 3 of the Act do not include the plural (for example, section 3A(4) and 3B).

- 4.29 In contrast, Article 2 of the Commission Regulation (2245/2002/EC) implementing Council Regulation (EC) No 6/2002 on Community designs, expressly permits multiple designs to be included in an application.
- 4.30 It is proposed to remove the burden of requiring single applications to be made for each design by amending section 3(1) so that an application may be made for "a design or designs". This would also remove an ancillary fees burden from the applicant. At present, each application requires a separate fees to be paid, so three applications means three sets of fees. However, if two or more designs are included in a single application then it is expected that the Registry will face reduced handling costs (compared to an equivalent number of applications for single designs) and that this will be reflected in the fees charged for such applications.

**Re-enacting Provisions and new provisions imposing legal burdens  
(Section 6(2)(c) and (f) of the 2001 Act)**

- 4.31 No legal burdens are being re-enacted and no new provisions are included which impose legal burdens.

**Impact on Necessary Protection and Rights and Freedoms  
(Sections 6(2)(d) and 6(2)(e) of the 2001 Act)**

- 4.32 This proposal would have no effect on necessary protections or anyone's rights and freedoms as it merely grants more freedom to users during the application process.

**Consequential amendments  
(section 1(6)(c) of the 2001 Act)**

- 4.33 To ensure that this provision is effective, consequential amendments (within the meaning of section 1(6)(c) of the 2001 Act) are necessary. These amendments fall into two camps.
- 4.34 The first set of consequential amendments (to sections 3(2), (3), 3B(1), 3B(2), 14(1) and (2) of the 1949 Act) are made to reflect the fact that an application can be for "a design or designs".
- 4.35 The second set of consequential amendments are necessary to direct certain actions at designs included in an application, rather than applications themselves. This requires amendments to subsections (1) to (3) of section 3A of the 1949 Act (subsection (4) is a consequential amendment under the first proposal) to make it clear that the registrar may refuse to register a design included in an application, instead of refusing the application *in toto*. Section 3B(2) to (4) also require consequential amendment to direct the activity towards the design, rather than towards the application.
- 4.36 Finally, section 22(4) of the 1949 Act requires consequential amendment so that where one design included in an application is refused, but another is registered, the bar on inspection and publication only applies to the design that is refused.

### **Proposal 3: Ending the withdrawal of some registered designs from public inspection**

#### **Burdens under the Current Law and the removal or reduction of burdens (Sections 6(2)(a) and 6(2)(b) of the 2001 Act)**

- 4.37 Once a design has been registered a representation or specimen of the design is normally available for inspection (see section 22(1) of the 1949 Act). However, this general requirement has certain limitations imposed in relation to certain prescribed classes of product. Where a class of product has been prescribed no representation or specimen of that design will be open to the public (section 22(2) of the 1949 Act). This is intended to prevent the registration system being used by the unscrupulous as a means of copying the latest designs. Once a design has been registered, whether or not it is open to inspection, a proprietor may sue anyone for infringement of his registered design (this is the effect of section 7A(6) of the 1949 Act).
- 4.38 At present the prohibition on disclosure only applies to textile products, wallpaper and similar wall coverings and lace (see rule 69 of the 1995 Rules) and lasts either two or three years (depending on the product).
- 4.39 It is proposed to repeal section 22(2) of the 1949 Act, thereby removing the limitation it imposes, and to allow all registered designs to be inspected once they have been registered. The repeal of subsection (2) of section 22 would also necessitate the repeal of subsection (3).

#### **Re-enacting Provisions and new provisions imposing legal burdens (Section 6(2)(c) and (f) of the 2001 Act)**

- 4.40 No legal burdens are being re-enacted and no new provisions are included which impose legal burdens.

#### **Impact on Necessary Protection and Rights and Freedoms (Sections 6(2)(d) and 6(2)(e) of the 2001 Act)**

- 4.41 Where an application was made before the date the Order came into force, it is intended to maintain the present restriction in section 22(2) and (3). Therefore, if a proprietor had already applied to register a design (whether or not it had got as far as registration) he will not find that his design is now open to inspection. In other words, his legitimate expectations will be protected. Article 20 of the draft Order provides a transitional provision (within the meaning of section 1(6)(c) of the 2001 Act) to facilitate this. However, new designs will no longer be entitled to delay inspection once it is registered; an applicant may, however, ask to extend certain procedural time limits to delay the registration of his design. This will be provided by changes to the rules.
- 4.42 At present a person may be sued for the infringement of a registered design even though that design is not open to inspection. Although such an infringement may be considered to be "innocent", exempting the infringer from liability for

damages (see section 9 of the 1949 Act), it is now thought to be inappropriate, in the modern age, for a person to have a "secret" exclusive right, albeit only for a limited period of time.

- 4.43 Where a proprietor wishes to make an application to register his design (for priority purposes or otherwise), but he also wishes to delay the inspection (or publication) of that design, he will be able to delay registration itself. This will be achieved by changes to the rules, which would allow a procedural delay before registration. It is considered that this pre-registration delay is more appropriate than limiting inspection post-registration. This being the case the proposal is considered to provide a fair balance between the public at large and the proprietors of registered designs.

#### **Proposal 4: Facilitating the restoration of lapsed design registrations**

##### **Burdens under the Current Law and the removal or reduction of burdens (Sections 6(2)(a) and 6(2)(b) of the 2001 Act)**

- 4.44 The right in a registered design initially lasts for five years from the date of registration (section 8(1) of the 1949 Act). Thereafter, the proprietor may apply to extend his protection every five years for a further period of five years, up to a maximum twenty-five years. The application to extend protection must be accompanied by the renewal fee (which increases with each renewal). Where the proprietor fails to apply to extend his protection, it expires. During the first six months following the expiry of the registered design the proprietor may apply for a late extension by paying the renewal fee and an additional fee (section 8(4) of the 1949 Act), but if he fails to apply within this six months his right in the design lapses.
- 4.45 Once the design has lapsed the proprietor may apply, within a prescribed period, to restore his right in the design under section 8A of the 1949 Act. An application to restore a registered design will only be granted where the proprietor can show that he took reasonable care to see that the period was extended under section 8(2) or (4). Requiring a proprietor to show that he failed to pay the relevant fees yet exercised reasonable care is an obvious burden.
- 4.46 It is proposed that this standard of care be reduced, and with it the burden, so that an application to restore can be made where the failure to pay the renewal fee or the additional fee was unintentional. A similar change was made to section 28 of the Patents Act 1977 by article 9 of the Regulatory Reform (Patents) Order 2004 (SI 2004/2357).

##### **Re-enacting Provisions and new provisions imposing legal burdens (Section 6(2)(c) and (f) of the 2001 Act)**

- 4.47 No legal burdens are being re-enacted and no new provisions are included which impose legal burdens.

##### **Impact on Necessary Protection and Rights and Freedoms (Sections 6(2)(d) and 6(2)(e) of the 2001 Act)**

## *Legal Analysis*

4.48 The lowering of the standard of care required for restoration of a lapsed registration would grant greater protection to proprietors. Further, members of the public who commence use after a design lapses, but before it is restored will continue to be protected by the provisions of section 8B of the 1949 Act. The reduction of the standard of care will not affect this protection in any way. It is therefore felt that this change will not have any adverse effect on necessary protection or the rights and freedoms of others.



## **Part 5**

### ***Proposals for Revised Rules under the Registered Designs Act***

- 5.1 It is proposed to modernise and simplify the Rules made under the Registered Designs Act 1949. The modernisation of these Rules is being conducted in conjunction with the changes made by the Regulatory Reform Order, in that certain changes are necessary because of the proposed amendments to the 1949 Act. However, many of the changes are simply being made to modernise and update the procedures under the Act. As the Rules are not made under the 2001 Act, but under the 1949 Act, there is no need for them to comply with the requirements of the 2001 Act. Notwithstanding, they are intended to be generally deregulatory.
- 5.2 The Rules have been re-written from scratch. The description which follows focuses on the significant changes from the Registered Design Rules 1995. This commentary follows the division of the draft Rules into five parts, and includes a section on the transitional arrangements and some provisions from the old rules which have not been included in the proposed new rules.

#### **Part 1 - Application for Registration**

- 5.3 Rule 3 brings together in one place the requirements which must be satisfied in order to make a valid application which can be afforded a filing date. The basic requirements are simply that the application must be made on Designs Form 2A (or a replica or other substitute acceptable to the Registrar) and must include:
- the name of the person making the application,
  - a representation or specimen of the design or designs,
  - the prescribed fee.
- 5.4 Until these conditions are met there is no application. Consequently, rule 3(4) requires the Registrar to notify the applicant of any deficiency.
- 5.5 Rule 3(2) introduces a distinct form for subsequent applications made under section 3B of the Act in respect of a design (or designs) which have omitted from an earlier application. A distinct form is required in order to distinguish design applications of this type from the vast majority of design applications, which are not seeking to retain the filing date of an earlier filing.
- 5.6 Rule 3(3) is linked to a new feature of the system of design registration in the UK: a statutory obligation on the Registrar to publish new designs in a Journal (see rule 10). In order to avoid premature publication of a design, the Rules require the proprietor to give his consent to publishing a particular representation of the design in the application. If there is more than one design in the application, consent will be needed for each design (similarly, consent may be given for some designs but not others). If a suitable representation is

included in the application, but consent is not given at the time of the application, it may be given later (see rule 8), thus deferring publication (and registration) of the design concerned (but not of any design included in the application for which consent is given).

- 5.7 Rule 4 sets out two further formal requirements which must be satisfied before the designs in the application can be registered. Firstly, that the applicant has specified the product to which the design is intended to be applied, or in which it is incorporated. Secondly, that any specimen filed does not exceed the maximum size for storage purposes in the Registry. Failure to comply with these requirements will result in the Registrar issuing a direction for the applicant to remedy the default within a specified period. Failure so to do will result in the application to register the design affected being refused. However, failure to observe these requirements will not mean that there is no application, as with a failure to comply with rule 3(1) and 3(2).
- 5.8 The effect of rule 4(5) is that, where an oversize specimen is filed, the applicant may replace it with a representation of the design without affecting the filing date of the application.
- 5.9 Rule 5 follows rule 15 of the old Rules, except that there is no longer any express requirement as to the positioning of the disclaimer. Instead it is envisaged that the application form will contain a place for this information and thus reduce the likelihood of a formalities objection.
- 5.10 Rule 6 is similar in substance to old rules 27 and 28. It also sets out the consequence of failing to make good a convention claim namely that the “convention applications” will be disregarded.
- 5.11 Rule 7 is an updated version of old rules 29, 30 and 31. It is similar in substance, except that the Registrar is now required to give written reasons for any decision to refuse registration.
- 5.12 Rule 8 makes provision for the registrar to direct the applicant to file a representation of a design which is suitable for the purposes of publication in the Journal, where:
- the registrar does not propose to refuse to register the design;
  - no representation has been filed, or one has been filed but it is unsuitable for publication.
- 5.13 The rule also sets out the consequence of failing to comply with the registrar's direction, which is that the application may be refused.
- 5.14 Rule 8 also requires an applicant, who has filed a representation of a design which is suitable for publication, to provide his consent to its publication in the Journal, unless he has already provided such consent at the time of filing his application.

5.15 Rule 9 replaces and simplifies old rules 36 and 36A. It is proposed that the period within which a subsequent application under section 3B of the 1949 Act may be filed is 2 months beginning on the date on which the earlier application was modified by excluding the designs in question. The proposed period within which an application shall be deemed abandoned under section 3(5) of the 1949 Act, as a result of a default or neglect on the part of the applicant, shall be 12 months from the date of the application, or in the case of an application made under section 3B, 12 months from the date of the original application. This is effectively the maximum period within which an applicant will have to put his application in order for registration. This includes providing a suitable representation of his design for publication in the Journal, and his consent to such publication.

## **Part 2 - Designs after Registration**

5.16 Rule 10 introduces a duty on the registrar to publish all registered designs. The registrar has, as a matter of practice, published most designs since 1999. This rule provides a statutory basis for that practice and extends publication to designs for those classes of products which have hitherto not been published (textile products, wallpaper, wall coverings and lace).

5.17 Rule 11 replaces old rules 38 and 39. It has similar effect, except that the period leading up to the expiry of a registration in which a renewal application may be filed has been extended from 3 months to 6 months.

5.18 Rule 12 replaces old rule 41. It provides a procedure for applying to restore a lapsed right in a design under the proposed new section 8A of the 1949 Act. The period within which such an application may be made remains 12 months. The revised rule no longer requires the applicant to submit three forms to complete the process. Instead the Designs Form 29 will have a prescribed fee made up of the overdue renewal fee and an additional amount.

## **Part 3 - Proceedings before the Registrar**

5.19 Rule 14 sets out the procedure for making an application to the registrar for a declaration of invalidity, and for the proprietor to file a counterstatement. The main differences from rules 52 and 53 of the old rules are that:

- the statement of facts on which the applicant relies must be verified by a statement of truth,
- it is no longer necessary to submit the application in duplicate,
- there is a consequence for not filing a counterstatement, which is the registrar may treat the proprietor as not opposing the application,
- the counterstatement must state which allegations are denied or admitted, and which allegations the proprietor requires the applicant to prove, and
- the counterstatement shall also be verified by a statement of truth.

5.20 Rule 15 gives the registrar the power to set a timetable for the filing of evidence by the parties, which he may subsequently extend or shorten by virtue of rule

18(1). The rule also includes new consequences to cover the situations where a) the applicant fails to file evidence in support of his application, and b) either party fails to copy its evidence to the other side. The consequence of a) is that, unless the registrar otherwise directs, the application shall be deemed withdrawn. The consequence of b) is that the evidence shall not be considered as having been filed until it is copied to both the registrar and the other party.

- 5.21 Rule 18 gives the registrar a general power to shorten or extend any period which he has previously specified under one of the provisions in this part of the rules. It also reproduces powers previously found in old rule 48 with regard to case management and the production of documents and evidence.
- 5.22 Rule 19 replaces rule 57(3) of the old Rules, which provides that hearings between two or more parties should normally be in public. New rule 19(3) introduces criteria against which the registrar must consider applications for such hearings to be held in private.
- 5.23 Rule 20 replaces old rule 60(1). It is not proposed to re-enact old rule 60(2), which required the registrar to consider abating awards of costs where reasonable notice to the other side may have avoided the proceedings. The registrar may, in general, take account of the behaviour of the parties, but it is not considered to be appropriate to single this particular factor out for special mention. Although it may be desirable for a party to give notice of his intention to start invalidation proceedings, the failure to do so should not, in principle, prevent a successful party from claiming any costs to which it would otherwise be entitled.
- 5.24 Rule 21 replaces rule 61 of the old rules and makes provision for a party to proceedings to seek security for their costs. The new rule limits the registrar's discretion to require security for costs, when compared to the discretion provided under the old rule. The new rule takes account of the relevant provisions of international treaties and it is derived from the equivalent provision in the Civil Procedural Rules 1998 (CPR r. 25.12 and r. 25.13). The one difference being that it is proposed that the registrar will have power to require security for costs in circumstances where a costs order could theoretically be enforced but there is evidence that a party has not paid other awards of costs against it. In those circumstances, the lower costs awarded by the registrar (compared to the courts) suggest that it would be more proportionate to require the party concerned to provide security for their costs, rather than to require the other party to face the increased prospect and risk of having to go to court to recover what may be a relatively modest award of costs.
- 5.25 Rule 22 replaces, and has similar effect to, old rule 62(3) and (4), which give the Registrar the power of an Official Referee with regard to the attendance and examination of witnesses under oath and the discovery and production of documents.

## **Part 4 - The Register**

- 5.26 Rule 24 provides that the register and any representation or specimen of a registered design shall be open to public inspection during the hours that the Patent Office is open for all classes of business. The current version of this rule (rule 67) specifies the hours of business. The Office's hours of business are likely to be the subject of a separate consultation exercise. The effect of rule 24 is to limit access to whatever hours are subsequently adopted for all classes of business. In practice, registered designs are also accessible via the Office internet site, which is available even when the Office is closed to personal visitors.
- 5.27 Rules 26 and 27 provide for certified copies or extracts of entries in the register and of representations, specimens and documents relating to a registered design. It is not proposed to introduce provision for uncertified copies or extracts as in rule 73 of the old rules. This is because the need for such uncertified copies has evaporated due to the availability of the information via the Office's web site.
- 5.28 Rule 28 has been limited to reflect the requirements of section 23 of the Act, which requires the registrar to respond to requests to state whether a particular design is registered. The current version of this rule (rule 71) requires the Registrar to identify any registered designs which produce on the informed user the same overall impression as the design which is the subject of the enquiry. In effect, this requires the registrar to make a judgement about whether the later design has individual character in the light of earlier registered designs. The registrar receives only a small number of requests under rule 71. If there is sufficient demand for the registrar to offer such a service, he will consider whether it can be introduced by way of an extension of the Office's existing commercial search services. However, it is our view that it is inappropriate for the rules to extend the requirements of section 23 in this respect.
- 5.29 Rules 29 and 30 simplify and replace the procedure set out in old rules 42 to 46 for registering assignments and other interest in a registered design, and in recording changes in names and addresses.
- 5.30 Rule 31 simplifies and replaces old rules 77 and 78, which indicate what must be done to record Orders of the courts.

## **Part 5 - Miscellaneous**

- 5.31 Rule 32 provides for the registrar to extend any time or period prescribed by the rules. It has similar effect to old rule 51. The periods for making a request for restoration of a registration and putting an application in order (rules 9(1) and 12(2)) are excluded from extension.
- 5.32 Rule 33 provides for the registrar to amend any document and rectify any irregularity in procedure. It has similar effect to old rule 50.
- 5.33 Rule 34 sets out the information which must be published in the Designs Journal.

- 5.34 Rule 35 provides for the appointment of agents. It replaces old rules 10 and 11. The only significant difference is that a new agent is not required to file his appointment form in duplicate, and the registrar no longer has a duty to send one copy to the old agent. It is our view that it is the responsibility of applicants and proprietors to inform an agent of theirs that they have been replaced with a new agent.
- 5.35 Rules 36 and 37 provide for the filing of an address for service in the UK. They are simplified and updated versions of old rules 8 and 9. The main difference is that Rule 37 now provides that failure to provide an address for service shall lead to the refusal of an application.
- 5.36 Rule 38 provides for the registrar to certify any day as an "interrupted day" where there is either a general interruption of postal services in the UK or an interruption in the normal operation of the Patent Office. In these circumstances, the period allowed by the Rules for filing any notice, application of document shall, where it expires on the interrupted day, be extended to the next day which is not an interrupted day or an "excluded day" under rule 42. The rule is a simplified version of old rule 76. The only significant difference is that this rule does not provide for the extension of periods of time set out in the Act itself. In practice this means that the period of six months for filing a convention application cannot be extended if it ends on an "interrupted day".
- 5.37 Rule 39 is a new rule which makes similar provision for cases where dates or periods set under the rules are not complied with because of an unexpected delay in a communications service. In contrast to rule 38, this rule stands to be applied on a case by case basis. It is further distinguished from rule 38 by:
- not being limited to postal delays, and
  - not being limited to delays in services provided in the UK.
- 5.38 Rule 40 is a simplified version of old rule 62. It stipulates the form in which evidence may be given before the registrar, and gives the registrar the power to direct that, in any particular case, paper statements are sworn or that oral evidence be given.
- 5.39 Rules 41 and 42 will make provision for the Patent Office's hours of business and for the designation and effect of "excluded days" (Sundays, Bank Holidays and the like). The Patent Office proposes to consult users separately about these matters and the Registered Designs Rules are expected to follow the outcome of that consultation.
- 5.40 Rule 43 replaces and has similar effect to old rule 66. It provides for the appointment of advisors to assist the registrar in any proceedings before him.

## **Transitional Provisions**

- 5.41 Rule 44 gives effect to transitional provisions. Among these is paragraph 5 of Schedule 2, which provides that where provisions restricting the public's right to

inspect registered designs continue to apply to existing registrations in certain classes of products (textiles, wallpaper, similar wall coverings, and lace), the periods within which prohibition of inspection of affected designs shall continue to be the period set out in old rule 69.

### **Old Rules which have not been Replaced**

- 5.42 An application to register a design is not a property right (although a property right may exist in the underlying design). Accordingly, the Registry now believes that it would be inappropriate for a rule equivalent to rule 37 of the old rules to be included, which provided for the substitution of an applicant in the event that the original applicant died before the design is registered.
- 5.43 Section 21 of the Act provides for the correction of errors. Rule 47 of the old rules requires that requests for correction be made on a prescribed form. We see no need to stipulate the use of a form for this purpose. A request in writing is sufficient. Consequently, the new rules do not include an equivalent to old rule 47.
- 5.44 Rule 49 of the old rules gave the registrar the power to grant dispensations from the rules. That power was rarely, if ever, used. We believe that the proposed rules are sufficiently flexible so as not to require such a provision. Consequently, there is no equivalent to rule 49 in the proposed new rules.



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DRAFT STATUTORY INSTRUMENTS

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**2006 No.**

**REGULATORY REFORM**

**DESIGNS**

**The Regulatory Reform (Registered Designs) Order 2006**

*Made* - - - -

*Laid before Parliament*

*Coming into force* - -

Whereas:

- (a) the Secretary of State for Trade and Industry (“the Secretary of State”) has consulted—
  - (i) such organisations as appear to her to be representative of interests substantially affected by her proposals for this Order,
  - (ii) the Comptroller-General of Patents, Designs and Trade Marks,
  - (iii) the Law Commission,
  - (iv) the National Assembly for Wales,
  - (v) such other persons as she considers appropriate;
- (b) following the consultation mentioned in recital (a) the Secretary of State considered it appropriate to proceed with the making of this Order;
- (c) a document containing the Secretary of State's proposals was laid before Parliament as required by section 6 of the Regulatory Reform Act 2001 and the period for Parliamentary consideration under section 8 of that Act has expired;
- (d) the Secretary of State has had regard to the representations made during this period, in particular to the [Report] of the Delegated Powers and Regulatory Reform Committee of the House of Lords and the [Report] of the Regulatory Reform Committee of the House of Commons;
- (e) a draft of this Order was laid before Parliament with a statement giving details of those representations and the changes to the Secretary of State's proposals in the light of them;
- (f) the draft was approved by resolution of each House of Parliament;
- (g) the Secretary of State is of the opinion that this Order does not remove any necessary protection or prevent any person from continuing to exercise any right or freedom which he might reasonably expect to continue to exercise; and
- (h) this Order creates burdens affecting persons in the carrying on of certain activities, and the Secretary of State is of the opinion that—
  - (i) the provisions of this Order, taken as a whole, strike a fair balance between the public interest and the interests of the persons affected by the burdens being created, and

*Annex A – Draft of Proposed Regulatory Reform Order*

- (ii) the extent to which this Order removes or reduces one or more burdens, or has other beneficial effects for persons affected by the burdens imposed by the existing law, makes it desirable for this Order to be made;

Now therefore the Secretary of State, in exercise of the powers conferred by section 1 of the Regulatory Reform Act 2001(a), hereby makes the following Order—

**Introductory**

1. This Order may be cited as the Regulatory Reform (Registered Designs) Order 2006 and it shall come into force on [ ] 2006.
2. The Registered Designs Act 1949(b) shall be amended as follows.

**Substantive examination for novelty**

3. Section 1A (substantive grounds for refusal of registration) shall be omitted.
4. In section 3 (applications for registration), subsection (4) shall be omitted.
5. In section 3A (determinations of applications for registration), for subsection (4) there shall be substituted—
  - “(4) If it appears to the registrar that the application for registration includes—
    - (a) something which does not fulfil the requirements of section 1(2) of this Act;
    - (b) a design that does not fulfil the requirements of section 1C or 1D of this Act; or
    - (c) a design to which a ground of refusal mentioned in Schedule A1 to this Act applies,he shall refuse to register that thing or that design.”.
6. In section 3B (modification of applications for registration), in subsection (4), for “section 1A(1)(b) or (c)” there shall be substituted “section 3A(4)(b) or (c)”.
- 7.—(1) Section 11ZA (grounds for invalidity of registration) shall be amended as follows.
  - (2) In subsection (1), for “on any of the grounds mentioned in section 1A of this Act.” there shall be substituted—
    - “(a) on the ground that it does not fulfil the requirements of section 1(2) of this Act;
    - (b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act;
    - (c) where any ground of refusal mentioned in Schedule A1 to this Act applies.”.
  - (3) After subsection (1), there shall be inserted—
    - “(1A) The registration of a design (“the later design”) may be declared invalid if it is not new or does not have individual character when compared to a design which—
      - (a) has been made available to the public on or after the relevant date; but
      - (b) is protected as from a date prior to the relevant date by virtue of registration under this Act or the Community Design Regulation or an application for such registration.
    - (1B) In subsection (1A) “the relevant date” means the date on which the application for the registration of the later design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.”.
- 8.—(1) Section 11ZB (applications for declaration of invalidity) shall be amended as follows.

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(a) 2001 c. 6.  
(b) 1949 c. 88.

*Annex A – Draft of Proposed Regulatory Reform Order*

(2) In subsection (1), for “on the ground mentioned in section 1A(1)(a) or (b) of this Act” there shall be substituted “under section 11ZA(1)(a) or (b)”.

(3) In subsection (2), for “on the ground mentioned in section 1A(1)(c) of this Act” there shall be substituted “under section 11ZA(1)(c)”.

(4) In subsection (3), for “on the ground mentioned in section 1A(2) of this Act” there shall be substituted “under section 11ZA(1A)”.

(5) In subsection (5), for “on the ground mentioned in” there shall be substituted “under”.

**9.** In section 11ZD (modification of registration), for the words in subsection (1) from “on any ground” to “this Act” there shall be substituted “under section 11ZA(1)(b) or (c), (1A), (3) or (4)”.

**10.**—(1) Section 20 (rectification of register) shall be amended as follows.

(2) In subsection (1A)(a), for “section 1A(1)(c)” there shall be substituted “section 11ZA(1)(c)”.

(3) In subsection (1A)(b), for “section 1A(2)” there shall be substituted “section 11ZA(1A)”.

**Multiple applications**

**11.**—(1) Section 3 (applications for registration) shall be amended as follows.

(2) In subsection (1), after “a design” there shall be inserted “or designs”.

(3) In subsection (2), after “design”, in both places it occurs, there shall be inserted “ or designs”.

(4) In subsection (3), after “a design” there shall be inserted “or designs”.

**12.**—(1) Section 3A (determination of applications for registration) shall be amended as follows.

(2) In subsection (1), for “an application for the registration of a design” there shall be substituted “to register a design included in an application under this Act”.

(3) In subsection (2)—

(a) for “a design” there shall be inserted “or designs”; and

(b) for “the application” there shall be substituted “to register any design included in it”.

(4) In subsection (3), for the words from “an application” to the end of the subsection there shall be substituted “the applicant is not under section 3(2) or (3) or 14 entitled to apply for the registration of a design included in the application, he shall refuse to register that design.”.

**13.**—(1) Section 3B (modification of applications for registration) shall be amended as follows.

(2) In subsection (1), after “a design” there shall be inserted “or designs”.

(3) In subsection (2)—

(a) after “a design” there shall be inserted “or designs”;

(b) for “the design”, where it first occurs, there shall be substituted “any design included in the application”; and

(c) after “direct that the application” there shall be inserted “so far as relating to that design”.

(4) In subsection (3), for “a design has disclosed more than one design and” there shall be substituted “more than one design”.

(5) In subsection (4)—

(a) “an application for” shall be omitted; and

(b) after “the application” there shall be inserted “for the design”.

**14.**—(1) Section 14 (registration of design where application for protection in convention country has been made) is amended as follows.

(2) In subsection (1), after “a design” there shall be inserted “or designs”.

(3) In subsection (2), after “a design” there shall be inserted “or designs”.

*Annex A – Draft of Proposed Regulatory Reform Order*

**15.** In section 22 (inspection of registered designs), for subsection (4) there shall be substituted—

“(4) Where registration of a design has been refused pursuant to an application under this Act, or an application under this Act has been abandoned in relation to any design—

- (a) the application, so far as relating to that design, and
- (b) any representation, specimen or other document which has been filed and relates to that design,

shall not at any time be open to inspection at the Patent Office or be published by the registrar.”.

**Inspection**

**16.** In section 22 (inspection of registered designs), subsections (2) and (3) shall be omitted.

**Lowering the standard of care for restoration of lapsed right in design**

**17.** In section 8A (restoration of lapsed right in design), for subsection (4) there shall be substituted—

“(4) If the registrar is satisfied that the failure of the proprietor—

- (a) to pay the prescribed renewal fee within the prescribed period; or
- (b) to pay that fee and any prescribed additional fee within the period of six months immediately following the end of that period,

was unintentional, the registrar shall order the restoration of the right in the design on payment of any unpaid renewal fee and any prescribed additional fee.”.

**Transitional provisions**

**18.—**(1) The amendments made to the Registered Designs Act 1949 by articles 7 to 10 shall not apply to post-1989 registrations or pre-1989 registrations.

(2) In paragraph (1)—

“post-1989 registrations” means registrations to which regulation 12 of the Registered Designs Regulations 2001(a) applies;

“pre-1989 registrations” means registrations which fall within regulation 13(1) of those Regulations.

**19.** The amendments made to section 22 of the Registered Designs Act 1949 by article 16 shall not apply to any registration under the Act which has resulted from an application made before the coming into force of this Order.

[Signatory Text]

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(a) SI 2001/3949.

## **Annex B**

### ***Sections of the Registered Designs Act 1949 which are amended by the RRO***

#### **1A Substantive grounds for refusal of registration**

- (1) ~~The following shall be refused registration under this Act~~
  - (a) ~~anything which does not fulfil the requirements of section 1(2) of this Act;~~
  - (b) ~~designs which do not fulfil the requirements of sections 1B to 1D of this Act;~~
  - (c) ~~designs to which a ground of refusal mentioned in Schedule A1 to this Act applies.~~
- (2) ~~A design (“the later design”) shall be refused registration under this Act if it is not new or does not have individual character when compared with a design which—~~
  - (a) ~~has been made available to the public on or after the relevant date; but~~
  - (b) ~~is protected as from a date prior to the relevant date by virtue of registration under this Act or the Community Design Regulation or an application for such registration.~~
- (3) ~~In subsection (2) above “the relevant date” means the date on which the application for the registration of the later design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.~~

#### **3 Applications for registration**

- (1) An application for the registration of a design or designs shall be made in the prescribed form and shall be filed at the Patent Office in the prescribed manner.
- (2) An application for the registration of a design or designs shall be made by the person claiming to be the proprietor of the design.
- (3) An application for the registration of a design or designs in which national unregistered design right subsists shall be made by the person claiming to be the design right owner.
- (4) ~~For the purpose of deciding whether, and to what extent, a design is new or has individual character, the registrar may make such searches (if any) as he thinks fit.~~
- (5) An application for the registration of a design which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within such time as may be prescribed shall be deemed to be abandoned.

#### **3A Determination of applications for registration**

- (1) Subject as follows, the registrar shall not refuse ~~an application for the registration of a design~~ to register a design included in an application under this Act.

*Annex B – Sections of the Registered Designs Act 1949 which are amended by the RRO*

- (2) If it appears to the registrar that an application for the registration of a design or designs has not been made in accordance with any rules made under this Act, he may refuse ~~the application~~ to register any design included in it.
- (3) If it appears to the registrar that ~~an application for the registration of a design has not been made in accordance with sections 3(2) and (3) and 14(1) of this Act, he shall refuse the application~~ the applicant is not under section 3(2) or (3) or 14 entitled to apply for the registration of a design included in the application, he shall refuse to register that design.
- (4) ~~If it appears to the registrar that any ground for refusal of registration mentioned in section 1A of this Act applies in relation to an application for the registration of a design, he shall refuse the application.~~
- (4) If it appears to the registrar that the application for registration includes—
- (a) something which does not fulfil the requirements of section 1(2) of this Act;
  - (b) a design that does not fulfil the requirements of section 1C or 1D of this Act; or
  - (c) a design to which a ground of refusal mentioned in Schedule A1 to this Act applies.
- he shall refuse to register that thing or that design.

**3B Modification of applications for registration**

- (1) The registrar may, at any time before an application for the registration of a design or designs is determined, permit the applicant to make such modifications of the application as the registrar thinks fit.
- (2) Where an application for the registration of a design or designs has been modified before it has been determined in such a way that ~~the design~~ any design included in the application has been altered significantly, the registrar may, for the purpose of deciding whether and to what extent the design is new or has individual character, direct that the application so far as relating to that design shall be treated as having been made on the date on which it was so modified.
- (3) Where—
- (a) ~~an application for the registration of a design has disclosed more than one design and~~ more than one design has been modified before it has been determined to exclude one or more designs from the application; and
  - (b) a subsequent application for the registration of a design so excluded has, within such period (if any) as has been prescribed for such applications, been made by the person who made the earlier application or his successor in title,
- the registrar may, for the purpose of deciding whether and to what extent the design is new or has individual character, direct that the subsequent application shall be treated as having been made on the date on which the earlier application was, or is treated as having been, made.
- (4) Where ~~an application for~~ the registration of a design has been refused on any ground mentioned in ~~section 1A(1)(b) or (c)~~ section 3A(4)(b) or (c) of this Act, the application for the design may be modified by the applicant if it appears to the registrar that—

*Annex B – Sections of the Registered Designs Act 1949 which are amended by the RRO*

- (a) the identity of the design is retained; and
  - (b) the modifications have been made in accordance with any rules made under this Act.
- (5) An application modified under subsection (4) above shall be treated as the original application and, in particular, as made on the date on which the original application was made or is treated as having been made.
- (6) Any modification under this section may, in particular, be effected by making a partial disclaimer in relation to the application.

**8A Restoration of lapsed right in design**

- (1) Where the right in a registered design has expired by reason of a failure to extend, in accordance with section 8(2) or (4), the period for which the right subsists, an application for the restoration of the right in the design may be made to the registrar within the prescribed period.
- (2) The application may be made by the person who was the registered proprietor of the design or by any other person who would have been entitled to the right in the design if it had not expired; and where the design was held by two or more persons jointly, the application may, with the leave of the registrar, be made by one or more of them without joining the others.
- (3) Notice of the application shall be published by the registrar in the prescribed manner.
- ~~(4) If the registrar is satisfied that the proprietor took reasonable care to see that the period for which the right subsisted was extended in accordance with section 8(2) or (4), he shall, on payment of any unpaid renewal fee and any prescribed additional fee, order the restoration of the right in the design.~~
- (4) If the registrar is satisfied that the failure of the proprietor—
- (a) to pay the prescribed renewal fee within the prescribed period; or
  - (b) to pay that fee and any prescribed additional fee within the period of six months immediately following the end of that period,
- was unintentional, the registrar shall order the restoration of the right in the design on payment of any unpaid renewal fee and any prescribed additional fee.
- (5) The order may be made subject to such conditions as the registrar thinks fit, and if the proprietor of the design does not comply with any condition the registrar may revoke the order and give such consequential directions as he thinks fit.
- (6) Rules altering the period prescribed for the purposes of subsection (1) may contain such transitional provisions and savings as appear to the Secretary of State to be necessary or expedient.

**11ZA Grounds for invalidity of registration**

- (1) The registration of a design may be declared invalid ~~on any of the grounds mentioned in section 1A of this Act. —~~

*Annex B – Sections of the Registered Designs Act 1949 which are amended by the RRO*

- (a) on the ground that it does not fulfil the requirements of section 1(2) of this Act;
  - (b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act;
  - (c) where on any ground of refusal mentioned in Schedule A1 to this Act applies.
- (1A) The registration of a design (“the later design”) may be declared invalid if it is not new or does not have individual character when compared to a design which—
- (a) has been made available to the public on or after the relevant date; but
  - (b) is protected as from a date prior to the relevant date by virtue of registration under this Act or the Community Design Regulation or an application for such registration.
- (1B) In subsection (1A) “the relevant date” means the date on which the application for the registration of the later design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.
- (2) The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.
  - (3) The registration of a design involving the use of an earlier distinctive sign may be declared invalid on the ground of an objection by the holder of rights to the sign which include the right to prohibit in the United Kingdom such use of the sign.
  - (4) The registration of a design constituting an unauthorised use of a work protected by the law of copyright in the United Kingdom may be declared invalid on the ground of an objection by the owner of the copyright.
  - (5) In this section and sections 11ZB, 11ZC and 11ZE of this Act (other than section 11ZE(1)) references to the registration of a design include references to the former registration of a design; and these sections shall apply, with necessary modifications, in relation to such former registrations.

**11ZB Applications for declaration of invalidity**

- (1) Any person interested may make an application to the registrar for a declaration of invalidity ~~on the ground mentioned in section 1A(1)(a) or (b) of this Act~~ under section 11ZA(1)(a) or (b).
- (2) Any person concerned by the use in question may make an application to the registrar for a declaration of invalidity ~~on the ground mentioned in section 1A(1)(c) of this Act~~ under section 11ZA(1)(c).
- (3) The relevant person may make an application to the registrar for a declaration of invalidity ~~on the ground mentioned in section 1A(2) of this Act~~ under section 11ZA(1A).
- (4) In subsection (3) above “the relevant person” means, in relation to an earlier design protected by virtue of registration under this Act or the Community Design Regulation or an application for such registration, the registered proprietor of the design, the holder of the registered Community design or (as the case may be) the applicant.

*Annex B – Sections of the Registered Designs Act 1949 which are amended by the RRO*

- (5) The person able to make an objection under subsection (2), (3) or (4) of section 11ZA of this Act may make an application to the registrar for a declaration of invalidity ~~on the ground mentioned in~~under that subsection.
- (6) An application may be made under this section in relation to a design at any time after the design has been registered.

**11ZD Modification of registration**

- (1) Subsections (2) and (3) below apply where the registrar intends to declare the registration of a design invalid ~~on any ground mentioned in section 1A(1)(b) or (c) or 11ZA(3) or (4) of this Act~~under section 11ZA(1)(b) or (c), (1A), (3) or (4).
- (2) The registrar shall inform the registered proprietor of that fact.
- (3) The registered proprietor may make an application to the registrar for the registrar to make such modifications to the registration of the design as the registered proprietor specifies in his application.
- (4) Such modifications may, in particular, include the inclusion on the register of a partial disclaimer by the registered proprietor.
- (5) If it appears to the registrar that the application has not been made in accordance with any rules made under this Act, the registrar may refuse the application.
- (6) If it appears to the registrar that the identity of the design is not retained or the modified registration would be invalid by virtue of section 11ZA of this Act, the registrar shall refuse the application.
- (7) Otherwise the registrar shall make the specified modifications.
- (8) A modification of a registration made under this section shall have effect, and be treated always to have had effect, from the grant of registration.

**14 Registration of design where application for protection in convention country has been made**

- (1) An application for registration of a design or designs in respect of which protection has been applied for in a convention country may be made in accordance with the provisions of this Act by the person by whom the application for protection was made or his personal representative or assignee:

Provided that no application shall be made by virtue of this section after the expiration of six months from the date of the application for protection in a convention country or, where more than one such application for protection has been made, from the date of the first application.

- (2) Where an application for registration of a design or designs is made by virtue of this section, the application shall be treated, for the purpose of determining whether (and to what extent) that or any other design is new or has individual character, as made on the date of the application for protection in the convention country or, if more than one such application was made, on the date of the first such application.
- (3) Subsection (2) shall not be construed as excluding the power to give directions under section 3B(2) or (3) of this Act in relation to an application made by virtue of this section.

*Annex B – Sections of the Registered Designs Act 1949 which are amended by the RRO*

- (4) Where a person has applied for protection for a design by an application which—
- (a) in accordance with the terms of a treaty subsisting between two or more convention countries, is equivalent to an application duly made in any one of those convention countries; or
  - (b) in accordance with the law of any convention country, is equivalent to an application duly made in that convention country,
- he shall be deemed for the purposes of this section to have applied in that convention country.

**20 Rectification of register**

- (1) The court may, on the application of the relevant person, order the register of designs to be rectified by the making of any entry therein or the variation or deletion of any entry therein.
- (1A) In subsection (1) above “the relevant person” means—
- (a) in the case of an application invoking any ground referred to in ~~section 1A(1)(c)~~ section 11ZA(1)(c) of this Act, any person concerned by the use in question;
  - (b) in the case of an application invoking the ground mentioned in ~~section 1A(2)~~ section 11ZA(1A) of this Act, the appropriate person;
  - (c) in the case of an application invoking any ground mentioned in section 11ZA(2), (3) or (4) of this Act, the person able to make the objection;
  - (d) in any other case, any person aggrieved.
- (1B) In subsection (1A) above “the appropriate person” means, in relation to an earlier design protected by virtue of under this Act or the Community Design Regulation or an application for such registration, the registered proprietor of the design, the holder of the registered Community design or (as the case may be) the applicant.
- (2) In proceedings under this section the court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register.
- (3) Notice of any application to the court under this section shall be given in the prescribed manner to the registrar, who shall be entitled to appear and be heard on the application, and shall appear if so directed by the court.
- (4) Any order made by the court under this section shall direct that notice of the order shall be served on the registrar in the prescribed manner; and the registrar shall, on receipt of the notice, rectify the register accordingly.
- (5) A rectification of the register under this section has effect as follows—
- (a) an entry made has effect from the date on which it should have been made,
  - (b) an entry varied has effect as if it had originally been made in its varied form, and
  - (c) an entry deleted shall be deemed never to have had effect,

*Annex B – Sections of the Registered Designs Act 1949 which are amended by the RRO*

unless, in any case, the court directs otherwise.

- (6) Orders which may be made by the court under this section include, in particular, declarations of partial invalidity.

**22 Inspection of registered designs**

- (1) Where a design has been registered under this Act, there shall be open to inspection at the Patent Office on and after the day on which the certificate of registration is issued—

- (a) the representation or specimen of the design,  
(b) ...

This subsection has effect subject to the following provisions of this section and to any rules made under section 5(2) of this Act.

- ~~(2) Where—~~

- ~~(a) a design has been registered;~~  
~~(b) a product to which the design was intended to be applied or in which it was intended to be incorporated was specified, in accordance with rules made under section 36 of this Act, in the application for the registration of the design; and~~  
~~(c) the product so specified falls within any class prescribed for the purposes of this subsection;~~

~~no representation, specimen or evidence filed in pursuance of the application shall, until the expiration of such period after the day on which the certificate of registration is issued as may be prescribed in relation to products of that class, be open to inspection at the Patent Office except by the registered proprietor, a person authorised in writing by the registered proprietor, or a person authorised by the registrar or by the court:~~

~~Provided that where the registrar proposes to refuse an application for the registration of any other design on the ground that, by reference to the first mentioned design, it is not new or does not have individual character, the applicant shall be entitled to inspect the representation or specimen of the first mentioned design filed in pursuance of the application for registration of that design.~~

- ~~(3) In the case of a registered design and a specified product which falls within any class prescribed for the purposes of the last foregoing subsection, the representation, specimen or evidence shall not, during the period prescribed as aforesaid, be inspected by any person by virtue of this section except in the presence of the registrar or of an officer acting under him; and except in the case of an inspection authorised by the proviso to that subsection, the person making the inspection shall not be entitled to take a copy of the representation, specimen or evidence or any part thereof.~~
- ~~(4) Where an application for the registration of a design has been abandoned or refused, neither the application for registration nor any representation, specimen or evidence filed in pursuance thereof shall at any time be open to inspection at the Patent Office or be published by the registrar.~~
- (4) Where registration of a design has been refused pursuant to an application under this Act, or an application under this Act has been abandoned in relation to any design—

*Annex B – Sections of the Registered Designs Act 1949 which are amended by the  
RRO*

- (a) the application, so far as relating to that design, and
- (b) any representation, specimen or other document which has been filed and relates to that design,

shall not at any time be open to inspection at the Patent Office or be published by the registrar.

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STATUTORY INSTRUMENTS

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**2004 No.**

**DESIGNS**

**The Registered Designs Rules 2006**

*Made* - - - -

*Laid before Parliament*

*Coming into force* - -

**ARRANGEMENT OF RULES**

1. Citation, commencement and interpretation
2. Forms

**PART 1**

**APPLICATIONS FOR REGISTRATION**

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6. Convention applications
7. Substantive and formal examination of application
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**PART 2**

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## *Annex C – Draft of the Proposed Registered Designs Rules*

The Secretary of State, in exercise of the powers conferred on her by section 36 of the Registered Designs Act 1949(a), after consultation with the Council on Tribunals pursuant to section 8(1) of the Tribunals and Inquiries Act 1992(b), makes the following Rules:

### **Citation, commencement and interpretation**

1.—(1) These Rules may be cited as the Registered Designs Rules 2006 and shall come into force on [            ].

(2) In these Rules “the Act” means the Registered Designs Act 1949 and “section” means a section of that Act.

### **Forms**

2.—(1) The forms of which the use is required by these Rules are those set out in Schedule 1.

(2) Such a requirement to use a form is satisfied by the use of—

- (a) a form which is a replica of the form set out in that Schedule; or
- (b) a form which is acceptable to the registrar and contains the information required by the form as so set out.

## **PART 1**

### **APPLICATIONS FOR REGISTRATION**

#### **Applications**

3.—(1) Subject to paragraph (2), an application for the registration of a design or designs shall be made on Designs Form 2A and shall—

- (a) include the identity of the person making the application; and
- (b) either—
  - (i) include a representation of the design or designs; or
  - (ii) be accompanied by a specimen of the design or designs,

and it shall be accompanied by the prescribed fee.

(2) An application for the registration of a design or designs, which is a subsequent application for the purposes of section 3B(3), shall be made on Designs Form 2B and shall be accompanied by the prescribed fee.

(3) Where an application includes a representation of the design, the applicant may give his consent for its publication on Designs Form 2A.

(4) Where a person purports to file something under section 3(1) and—

- (a) it is not in the form prescribed by either paragraph (1) or paragraph (2); or
- (b) it is not accompanied by the prescribed fee,

the registrar shall notify that person accordingly.

(5) A specimen may not be filed under paragraph (1)(b)(ii) if it is hazardous or perishable.

(6) An application for the registration of a design which is a repeating surface pattern shall only be treated as such if—

- (a) the representation or specimen filed under paragraph (1)(b) includes the complete pattern and a sufficient portion of the repeat in length and width to show how the pattern repeats; and

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(a) 1949 c. 88.  
(b) 1992 c. 53.

- (b) the application contains a statement that it relates to a repeating surface pattern.

#### **Formal requirements**

4.—(1) Where an application does not comply with—

- (a) the first requirement, the registrar shall direct the applicant to comply with those requirements;
- (b) the second requirement, the registrar shall direct the applicant to file a representation.

(2) In a direction given under paragraph (1), the registrar shall specify a period before the end of which the applicant shall comply with the requirements.

(3) The first requirement is that the applicant has specified the product to which the design is intended to be applied or in which it is intended to be incorporated.

(4) The second requirement is that the dimensions of any specimen of the design filed under rule 3(1)(b)(ii) do not exceed 29.7cm x 21cm x 1cm.

(5) Where the applicant files a representation pursuant to a direction given under paragraph (1)(b)—

- (a) that representation shall be deemed to have been filed under rule 3(1)(b)(i); and
- (b) any specimen filed under rule 3(1)(b)(ii) shall be treated as not having been filed.

(6) Nothing done to comply with the first requirement shall be taken to limit the scope of the protection conferred by the registration of a design.

#### **Partial disclaimers and descriptions explaining representations**

5.—(1) An application for the registration of a design or designs may be accompanied by a disclaimer which—

- (a) limits the scope or extent of protection being applied for in relation to the design; or
- (b) indicates that the application for registration relates to a design that forms only a part of the appearance of a product.

(2) A representation or specimen filed under rule 3(1)(b) may be accompanied by a brief description of the design, in particular its lines, contours, colours, shape, texture and materials.

#### **Convention applications**

6.—(1) Where an application for registration of a design or designs is made by virtue of section 14 the applicant shall comply with the following provisions.

(2) The application shall contain a declaration specifying—

- (a) the date of filing of each convention application; and
- (b) the country in or for which it was made.

(3) The applicant shall, before the end of the period of three months beginning on the date the application was filed, file at the Registry a copy of the representation of the design or designs that were the subject of the convention application.

(4) A copy of the representation filed under paragraph (3) shall be—

- (a) duly certified by the authority with which it was filed; or
- (b) verified to the satisfaction of the registrar.

(5) Where any document relating to the convention application is in a language other than English the registrar may direct the applicant to provide a translation of the whole or any part of that document.

(6) Where the applicant—

- (a) fails to file a copy of the representation of the design which has been certified or verified in accordance with paragraph (4); or

(b) fails to comply with a direction given under paragraph (5),  
the convention application shall be disregarded for the purposes of section 14(2).

(7) In this rule “convention application” means an application for the protection of a design which has been made in a convention country.

### **Substantive and formal examination of application**

7.—(1) Where it appears to the registrar that he should refuse to register a design included in an application—

- (a) by reason of the application for the registration of that design not being made in accordance with any of these Rules, other than rule 8 (see section 3A(2)); or
- (b) by reason of section 3A(3) or (4),

he shall notify the applicant accordingly.

(2) The notification under paragraph (1) shall include a statement of why it appears to the registrar that he should refuse to register the application or design (for the purposes of this rule the “statement of objections”).

(3) The applicant may, before the end of the period of two months beginning on the date of the notification under paragraph (1), send his written observations on the statement of objections to the registrar.

(4) Where the applicant gives written notice that he wishes to be heard, the registrar shall send him notice of a date for the hearing.

(5) Where the registrar refuses to register an application or a design he shall send to the applicant the written reasons for his decision.

(6) The date the written reasons were sent to the applicant shall be deemed to be the date of the decision for the purposes of any appeal.

### **Representation of design for publication**

8.—(1) Where the registrar decides that he should not refuse to register the design for the reasons mentioned in rule 7(1)(a) or (b) and—

- (a) no representation of the design has been filed, or
- (b) a representation has been filed but it is not suitable for publication,

the registrar shall direct the applicant to provide a representation of the design which is suitable for publication.

(2) Where a direction is given under paragraph (1), the applicant shall, before the end of the period of three months beginning on the date of the direction, file a representation of the design suitable for publication (otherwise the registrar may refuse to register the design: see section 3A(2)).

(3) Where a representation of the design, which is suitable for publication, has been filed, the applicant shall file his consent for its publication on Designs Form 2C, except where he has consented to its publication in accordance with rule 3(3).

### **Time limits for under section 3(5) and section 3B**

9.—(1) The time prescribed for the purposes of section 3(5) shall be twelve months beginning on the date on which the application for registration of the design was made (disregarding section 14).

(2) The period prescribed for the purposes of section 3B(3) shall be the period of two months beginning on the date on which the earlier application was modified under section 3B(2).

## PART 2

### DESIGNS AFTER REGISTRATION

#### **Publication**

**10.**—(1) Where a design has been registered under the Act, the registrar shall publish a representation of that design in the Journal as soon as possible after the certificate is issued.

(2) When the registrar publishes the representation of a design under paragraph (1), he may also publish any other information he thinks is relevant to that design.

(3) The representation published under paragraph (1) shall be the representation filed under rule 3(1)(b)(i) or 8(2) or pursuant to a direction given under rule 4(1)(b).

#### **Extension of duration of right in registered design**

**11.**—(1) An application for an extension under section 8(2) or 8(4) shall be made on Designs Form 9A.

(2) An application under section 8(2) may only be made during the period of six months ending on the date on which the relevant period of five years expires.

(3) On receipt of the prescribed renewal fee the registrar shall notify the registered proprietor of the extension of the right in the registered design.

(4) Subject to paragraph (5), where the right in a registered design has ceased to have effect by reason of section 8(3), the registrar shall, before the end of the period of six weeks beginning on the date the right ceased, send written notice to the registered proprietor of that fact.

(5) Paragraph (4) does not apply where the renewal fee and the prescribed additional fee is paid before a notice is sent under paragraph (4).

#### **Restoration of a lapsed right in a design under section 8A**

**12.**—(1) An application for the restoration of the right in a design under section 8A shall—

(a) be made on Designs Form 29;

(b) be supported by evidence of the statements made in the application.

(2) The period prescribed for the purposes of section 8A(1) shall be the period of twelve months beginning on the date the registered design ceased to have effect.

(3) The notice of the application shall be published in the Journal.

(4) Where, upon consideration of the evidence provided in accordance with paragraph (1), the registrar is not satisfied that a case for an order under section 8A has been made out, he shall notify the applicant accordingly.

(5) Where the registrar has notified the applicant under paragraph (4), the applicant may, before the end of the period of one month beginning on the date of the notification, request to be heard by the registrar.

(6) Where the applicant requests a hearing under paragraph (5), the registrar shall give him an opportunity to be heard, after which the registrar shall determine whether the application under section 8A shall be granted or refused and then notify the applicant accordingly.

(7) Where the registrar decides not to make the order he shall give the applicant written reasons for his refusal.

#### **Cancellation of registration**

**13.** A request under section 11 to cancel the registration of a design shall be made on Designs Form 19A.

## PART 3

### PROCEEDINGS HEARD BEFORE THE REGISTRAR

#### **Procedure for applying for a declaration of invalidity**

**14.**—(1) An application for a declaration of invalidity under section 11ZB shall—

- (a) be made on Designs Form 19A; and
- (b) be accompanied by a statement of the grounds on which the application is made.

(2) The statement of grounds shall include a concise statement of the facts on which the applicant relies and be verified by a statement of truth.

(3) The registrar shall send a copy of Designs Form 19A and the statement of case to the registered proprietor.

(4) The registrar shall specify a period within which the registered proprietor shall file a counter-statement.

(5) The registered proprietor, within that period, shall—

- (a) file his counter-statement on Designs Form 19B; and
- (b) send a copy of it to the applicant,

otherwise the registrar may treat him as not opposing the application.

(6) In his counter-statement the registered proprietor shall state—

- (a) which of the allegations in the statement of case he denies;
- (b) which of the allegations he is unable to admit or deny, but which he requires the applicant to prove; and
- (c) which allegations he admits,

and it shall be verified by a statement of truth.

#### **Evidence rounds**

**15.**—(1) When the period specified under rule 14(4) has expired, the registrar shall specify the periods within which evidence may be filed by the parties.

(2) Where the applicant for a declaration of invalidity files no evidence in support of his application he shall, unless the registrar otherwise directs, be deemed to have withdrawn his application.

(3) The registrar may, at any time, if he thinks fit, give leave to either party to file evidence upon such terms as he thinks fit.

(4) Under this rule, evidence shall only be considered filed when—

- (a) it has been received by the registrar; and
- (b) it has been sent to all other parties to the proceedings.

(5) Where the periods specified under paragraph (1) have expired, the registrar shall request that the parties give written notice of whether they wish to be heard.

(6) Where any party requests to be heard, the registrar shall send to the parties notice of a date for the hearing.

#### **Decision of registrar on invalidity**

**16.**—(1) When the registrar has made a decision on the application for a declaration of invalidity, he shall send to the parties to the proceedings written notice of it, stating the reasons for his decision.

(2) The date the decision was sent to the applicant shall be deemed to be the date of the decision for the purposes of any appeal.

### **Exercise of discretionary powers of registrar**

17. Without prejudice to any provision of the Act or these Rules requiring the registrar to hear any party to proceedings thereunder, or to give to any party an opportunity to be heard, the registrar shall give to any applicant for registration of a design an opportunity to be heard before exercising adversely to the applicant any discretion vested in the registrar by or under the Act.

### **General powers of registrar in relation to proceedings before him**

18.—(1) The registrar may extend or shorten (or further extend or shorten) any period which has been specified under any provision of this Part.

(2) At any stage of proceedings before him, the registrar may direct that such documents, information or evidence as he may reasonably require shall be filed before the end of a such period as he may specify.

(3) At any stage of proceedings before him, the registrar may direct that the parties to the proceedings attend a case management conference or pre-hearing review.

(4) The parties shall be given at least fourteen days notice of any case management conference or pre-hearing review.

(5) At a case management conference, the registrar may give such directions as to the management of the proceedings as he thinks fit.

(6) At a pre-hearing review, the registrar may give such directions as to the conduct of the hearing as he thinks fit.

### **Hearings in public**

19.—(1) Subject to paragraphs (3) and (4), any hearing before the registrar of proceedings between two or more parties relating to a registered design or to an application for a registered design, shall be held in public.

(2) Any party to the proceedings may apply to the registrar for the hearing to be held in private.

(3) The registrar shall only grant an application under paragraph (2) where—

(a) it is in the interests of justice for the hearing to be held in private; and

(b) all the parties to the proceedings have had an opportunity to be heard on the matter,

and where the application is granted the hearing shall be in private.

(4) Any hearing of an application under paragraph (2) shall be held in private.

(5) Nothing in this rule shall prevent a member of the Council of Tribunals or of its Scottish Committee from attending a hearing.

### **Costs of proceedings**

20. The registrar may, in any proceedings before him under the Act or these Rules, award to any party by order such costs as he considers reasonable, and direct how and by what parties they are to be paid.

### **Security for costs**

21.—(1) The registrar may require a person to give security for the costs of any application or appeal mentioned in section 30(3) if—

(a) he is satisfied, having regard to all the circumstances of the case, that it is just to require such security; and

(b) one or more of the conditions in paragraph (2) applies.

(2) The conditions are—

(a) the person is—

- (i) resident outside the United Kingdom; but
  - (ii) not resident in a Brussels Contracting State, a Lugano Contracting State or a Regulation State, as defined in section 1(3) of the Civil Jurisdiction and Judgments Act 1982<sup>(a)</sup>;
- (b) the person is a company or other body (whether incorporated inside or outside the United Kingdom) and there is reason to believe that it will be unable to pay the other person's costs if ordered to do so;
  - (c) the person has changed his address since filing an address for service with a view to evading the consequences of the proceedings;
  - (d) the person has failed to furnish an address for service or furnished an incorrect address for service;
  - (e) the person has taken steps in relation to his assets that would make it difficult to enforce an order for costs against him;
  - (f) the person has failed to pay a costs order in relation to previous proceedings before the registrar or a court (whether or not the proceedings were between the same parties).
- (3) In default of such security being given the registrar may treat the application or appeal as abandoned.

**Registrar shall have the powers of official referee**

22. The registrar shall have the powers of an official referee of the Supreme Court as regards—
- (a) the attendance of witnesses and their examination on oath; and
  - (b) the discovery and production of documents.

**Minimum notice of a hearing**

23. The registrar shall not give a person less than 14 days notice of any hearing under the Act or these Rules.

## PART 4 THE REGISTER

**Inspection of register and documents**

24.—(1) The register and any representation or specimen of a registered design shall be open for inspection during the hours the Patent Office is open for all classes of public business.

(2) Whilst a direction under section 5(1) in respect of a design remains in force, no representation or specimen of the design shall be open to inspection.

**Certificate of registration**

25.—(1) The certificate of registration of a design shall include—

- (a) the name of the registered proprietor;
- (b) the date of registration; and
- (c) the registration number of the design.

(2) Any request by the registered proprietor for a copy of the certificate of registration shall—

- (a) be in writing; and
- (b) be accompanied by the prescribed fee.

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<sup>(a)</sup> 1982 c. 27.

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(3) Before considering the request, the registrar may require the person making the request to provide such information or evidence as the registrar thinks fit.

### **Copies of entries in, or extracts from, the register**

26. An application under section 17(5) for a certified copy of an entry in the register or a certified extract from the register shall be made on Designs Form 23 and shall be accompanied by the prescribed fee.

### **Copies of representations, specimens and documents**

27.—(1) A person may apply to the registrar for a certified copy of any representation or specimen of a design or a document relating to a design and that person shall be entitled to such a copy.

(2) An application under paragraph (1) shall be made in writing and be accompanied by the prescribed fee.

### **Information about rights in registered designs**

28.—(1) A request for information under section 23 shall be made on Designs Form 21 and be accompanied by the prescribed fee.

(2) The request shall—

- (a) where the registration number is known by the person making the request, include that number; or
- (b) in any other case, be accompanied by a representation or specimen of the product—
  - (i) in which the design has been incorporated; or
  - (ii) to which the design has been applied.

### **Registration of interests**

29.—(1) The following are prescribed registerable matters for the purposes of section 17(1)(c)—

- (a) the grant or cancellation of a licence under a registered design;
- (b) the granting or cancelling of a security interest (whether fixed or floating) over a registered design or any right in or under it;
- (c) an order of a court or other competent authority transferring a registered design or any right in or under it.

(2) An application to the registrar to enter in the register a matter not mentioned in section 17(1)(a) or (b) or paragraph (1) shall be made in writing.

(3) An application under section 19(1) or (2) shall be made on Designs Form 12A.

(4) Where the registrar has doubts about whether he should enter a matter in the register—

- (a) he shall inform the person making the application of the reasons for his doubts; and
- (b) he may require that person to furnish evidence in support of the application.

### **Alteration of name or address**

30.—(1) A request by any person, upon the alteration of his name, for that alteration to be entered in the register or on any application or other document filed at the Patent Office shall be made on Designs Form 16A.

(2) A request by any person for the alteration of his address to be entered in the register or on any application or other document filed at the Patent Office shall be made in writing.

(3) Where the registrar has doubts about whether he should make the alteration to a name or address—

- (a) he shall inform the person making the request of the reason for his doubts; and
- (b) he may require that person to furnish evidence in support of the request.

(4) Any request for an alteration under this rule shall identify the entry in the register or the application or other document to which the request relates.

(5) If the registrar is satisfied that he should grant a request to alter a name or address then he shall cause the register, application or other document to be altered accordingly.

#### **Notice of rectification of the register**

**31.**—(1) The prescribed manner of giving notice to the registrar for the purposes of section 20(3) is by giving written notice.

(2) The prescribed manner of service on the registrar for the purposes of section 20(4) is by filing a copy of the order at the Patent Office.

## **PART 5**

### **MISCELLANEOUS**

#### **Extension of times or periods prescribed by Rules**

**32.**—(1) The registrar may, if he thinks fit, extend (or further extend) any time or period prescribed by these Rules, except the periods prescribed by—

- (a) rule 9(1) (period prescribed for the purposes of section 3(5)); and
- (b) rule 12(2) (period for making an application for restoration).

(2) Any extension under paragraph (1) shall be made—

- (a) after giving the parties such notice, and
- (b) subject to such conditions,

as the registrar may direct.

(3) An extension may be granted under paragraph (1) notwithstanding that the time or period prescribed by the relevant rule has expired.

#### **Correction of irregularities**

**33.** Where the registrar thinks fit, he may amend any document or rectify any irregularity of procedure—

- (a) after giving the parties such notice, and
- (b) subject to such conditions,

as he may direct.

#### **The Journal**

**34.**—(1) The registrar shall publish a journal which shall contain—

- (a) everything which is required by the Act or these Rules to be published; and
- (b) any other information that the registrar may consider to be generally useful or important.

(2) In these Rules “Journal” means the journal published under paragraph (1).

## **Agents**

**35.**—(1) Subject to paragraph (2), any act required or authorised by the Act or these Rules to be done by or to any person in connection with the registration of a design, or any procedure relating to a registered design, may be done by or to an agent authorised by that person orally or in writing.

(2) An agent shall be treated as authorised (and all previous agents shall be treated as no longer authorised) under paragraph (1) where—

- (a) he was nominated by the applicant at the time of—
  - (i) making his application for registration;
  - (ii) making his application for a declaration of invalidity under section 11ZB; or
  - (iii) making his application under section 19(1) or (2); or
- (b) he has filed Designs Form 1A.

(3) Where an agent has been authorised under paragraph (1), the registrar may in any particular case, if he thinks fit, require the signature or presence of his principal.

## **Address for service**

**36.**—(1) For the purposes of any proceedings before the registrar under the Act or these Rules, an address for service shall be filed by—

- (a) an applicant for the registration of a design;
- (b) a person applying to the registrar under section 11ZB for a declaration of invalidity of a registered design.

(2) Where a person has provided an address for service under paragraph (1), he may substitute a new address for service by notifying the registrar on Designs Form 1A.

(3) For the purposes of any proceedings before the registrar under the Act or these Rules the address for service of the proprietor of the design is his address on the register, except where he provides the registrar with an alternative address for service.

(4) The address for service provided by the applicant for registration shall, upon registration, be entered on the register as the address of the proprietor.

(5) Anything sent by post to a person at his address for service is properly addressed.

(6) In this rule and in rule 37, references to an address for service mean an address for service in the United Kingdom.

## **Failure to provide an address for service**

**37.**—(1) Where—

- (a) a person has failed to provide an address for service in accordance with rule 36(1); and
- (b) the registrar has sufficient information enabling him to contact that person,

the registrar shall direct that person to file an address for service.

(2) Where a direction has been given under paragraph (1), the person directed shall, before the end of the period of two months beginning on the date of the direction, file an address for service.

(3) Where—

- (a) a person has failed to provide an address for service; and
- (b) either—
  - (i) where a direction was given under paragraph (1), the period prescribed by paragraph (2) has expired; or
  - (ii) the registrar had insufficient information to give a direction under paragraph (1),

the person's application for registration or his application under section 11ZB shall be treated as refused.

### **Interrupted Day**

**38.**—(1) Subject to paragraph (2), where the period of time for giving, making or filing any notice, application or other document under these Rules expires on an interrupted day that period of time shall be extended to the first day immediately following which is not an interrupted day (or an excluded day).

(2) Where a day has been certified as an interrupted day under paragraph (4), paragraph (1) only applies in relation to notices, applications or other documents given, made or filed by post.

(3) The registrar may certify any day as an interrupted day where there is an event or circumstance causing an interruption in the normal operation of the Patent Office.

(4) The registrar may certify any day as an interrupted day where there is a general interruption or subsequent dislocation in the postal services of the United Kingdom.

(5) Any certificate of the registrar made under paragraph (3) or (4) shall be posted in the Patent Office and advertised in the Journal.

(6) In this rule—

“interrupted day” means a day which has been certified as such under paragraph (3) or (4); and

“excluded day” means a day specified as such by rule 42.

### **Delays in communication services**

**39.**—(1) Where—

(a) the period of time for giving, making or filing any notice, application or other document under these Rules has expired; and

(b) the registrar is satisfied that the failure to give, make or file any notice, application or other document within that period was wholly or mainly attributable to an unexpected delay in a communication service,

the registrar shall extend the period of time.

(2) Any extension under paragraph (1) shall be—

(a) made after giving the parties such notice; and

(b) subject to such conditions,

as the registrar may direct.

(3) In this rule “communication service” means a service by which documents may be sent and delivered and includes post, facsimile, email and courier.

### **Evidence**

**40.**—(1) Evidence shall be given in proceedings before the registrar by affidavit, witness statement or statutory declaration.

(2) A witness statement is a written statement signed by a person which contains the evidence which that person would be allowed to give orally.

(3) A witness statement may only be given in evidence if it includes a statement of truth.

(4) The registrar may direct in a particular case that—

(a) evidence shall only be given by affidavit or statutory declaration; or

(b) oral evidence shall be given in relation to a matter, either as examination in chief or under cross-examination.

(5) For the purposes of these Rules, a statement of truth—

(a) means a statement that the person making the statement believes that the facts stated in a particular document are true; and

(b) shall be dated and signed by, or on behalf of, the person making the statement.

**Hours of business**

41. [This rule will reflect the outcome of the consultation on business hours].

**Excluded days**

42. [This rule will reflect the outcome of the consultation on business hours].

**Appointing advisers**

43.—(1) The registrar may appoint an adviser to assist him in any proceedings before the registrar.

(2) The registrar shall settle any question or instructions to be submitted or given to the adviser.

**Transitional provisions and revocation**

44. Schedule 2 (transitional provisions and revocation) shall have effect.

[Signature]

SCHEDULE 1

rule 2

FORMS

[NOT INCLUDED]

## SCHEDULE 2

Rule 44

### TRANSITIONAL PROVISIONS AND REVOCATION

#### PART 1

##### TRANSITIONAL PROVISIONS RELATING TO PENDING APPLICATIONS

**1.** In this Part—

“old Rules” means the Registered Designs Rules 1995(a) as they had effect immediately before the coming into force of these Rules; and

“the RRO” means the Regulatory Reform (Registered Designs) Order 2006(b).

**2.** Where—

(a) the registrar sent the applicant a statement of objections under rule 29 of the old Rules; and

(b) the applicant has not sent to the registrar his observations in writing on the objection,

the objections shall be treated as the “statement of objections” under rule 7 of these Rules and the date the objections were sent shall be treated as the date the applicant was notified under rule 7(1).

**3.** Where—

(a) the period prescribed by rule 9 of these Rules has expired before these Rules come into force; and

(b) the period prescribed for the purposes of section 3B by rule 36A of the old Rules has not expired before the date on which these Rules come into force,

the period prescribed for the purposes of section 3B(3) shall be that mentioned in rule 36A of the old Rules.

**4.** Rule 10 does not apply where the application for registration of a design under the Act was made before these Rules come into force.

**5.** An application made in accordance with rule 41(1) and (2) of the old Rules shall be treated as made in accordance with rule 12(1) of these Rules.

**6.** Where the amendments made to section 22, by article 16 of the RRO, do not apply to a registration under the Act (by reason of article 20 of the RRO), rule 69 of the old Rules shall continue to have effect in relation to that registration.

**7.** A request under rule 72 of the old Rules for a certified copy of any representation, specimen or document kept at the Patent Office shall be treated as an application under rule 27(1) of these Rules.

**8.—(1)** The time the registrar allowed under rule 53 of the old Rules for the filing of the counter-statement shall be treated as the period specified under rule 14(4) of these Rules.

(2) Where—

(a) an application for a declaration of invalidation which was made before these Rules came into force; and

(b) a counter-statement has been filed by the registered proprietor,

the registrar shall, within 28 days of these rules coming into force, specify the periods within which any evidence (or further evidence) may be filed, in accordance with rule 15(1).

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(a) SI 1995/ 2912, amended by SI 1999/3196 and SI 2001/3950.

(b) SI 2006/[            ].

## PART 2

### TRANSITIONAL PROVISIONS RELATING TO APPLICATIONS MADE PRIOR TO 9TH DECEMBER 2001

**9.** In this Part, “the old Act” means the Registered Designs Act 1949 as it had effect immediately before the coming into force of the Registered Designs Regulations 2001(**a**).

**10.** This Part applies to—

- (a) a registered design (whether or not the right in the registered design has ceased to have effect); and
- (b) the copyright in the registered design (whether or not that copyright has expired),

where the application to register that design was made before 9th December 2001.

**11.** For the purposes of section 6 of the old Act, the circumstances for which a design shall be regarded as “applied industrially” are—

- (a) where the design is applied to more than fifty articles, which do not all together constitute a single set of articles (within the meaning of section 44(1) of the old Act); or
- (b) where the design is applied to goods manufactured in lengths or pieces, not being hand-made goods.

**12.—**(1) Part 3 of these Rules applies to an application under section 11(2) of the old Act for the cancellation of registration as it applies to an application for a declaration of invalidity under section 11ZB of the Act.

(2) The references in rule 14 to Designs Form 19A shall be construed as a reference to Designs Form 19B.

(3) Where an application is made under section 11(2) of the old Act, any reference in rule 14(1) to an application for a declaration of invalidity under section 11ZB of the Act shall be construed as a reference to an application under the relevant provision of the old Act.

(4) For the purposes of rule 21(1), an application under section 11(2) of the old Act shall be treated as if it were mentioned in section 30(3) of the Act.

(5) An applicant for the cancellation of registration under section 11(2) of the old Act shall file an address for service in the United Kingdom.

## PART 3

### REVOCATIONS

**13.** The following Instruments are hereby revoked—

- (a) The Registered Designs Rules 1995(**b**);
- (b) The Registered Designs (Amendment) Rules 1999(**c**);
- (c) The Registered Designs (Amendment) Rules 2001(**d**).

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(a) SI 2001/3949.  
(b) SI 1995/2912.  
(c) SI 1999/3196.  
(d) SI 2001/3950.



## **Annex D**

### ***List of Organisations Consulted***

#### **Organisations:**

The Law Society  
The Law Society of Scotland  
The Bar Council  
Trade Marks, Patents and Designs Federation  
Confederation of British Industry  
University of London, Queen Mary and Westfield College  
British Retail Consortium  
Incorporated Society of British Advertisers  
Chartered Society of Designers  
Association of British Chambers of Commerce  
Consumers Association  
National Consumers Council  
Federation of Small Businesses  
Licensing Executives Society  
International Chambers of Commerce  
Intellectual Property Institute  
London Chamber of Commerce and Industry  
Anti-Counterfeiting Group  
British Brands Group  
The Patent Judges  
The Intellectual Property Sub-Committee of the City of London Law Society  
Anti-Copying in Design (ACID)  
Chartered Institute of Patent Agents (CIPA)  
The Design Council  
Institute of Trade Mark Agents (ITMA)  
University of Oxford  
University of Cambridge

#### **Governmental/Quasi Governmental Organisations**

The Scottish Parliament  
The National Assembly for Wales  
The Isle of Man Office  
The Treasury  
The Ministry of Defence  
The Council on Tribunals  
The Scottish Council on Tribunals  
The Law Commission  
The Scottish Law Commission



## **Annex E**

### ***Regulatory Reform Proposals and Orders. Parliamentary Consideration***

#### **Introduction**

E - 1 These reform proposals in relation to the Registered Designs Act 1949 will require changes to primary legislation in order to give effect to them. The Minister could achieve these changes by introducing a Regulatory Reform Order under the Regulatory Reform Act 2001. Regulatory Reform Orders are subject to preliminary consultation and to extended Parliamentary scrutiny (by Committees in each House of Parliament) of any subsequently proposed Order. On that basis, the Minister invites comments on these reform proposals in relation to registered designs legislation as measures that might be carried forward by a Regulatory Reform Order.

#### **Regulatory Reform Proposals**

E - 2 This consultation document on the modernisation of the designs registration system has been produced because the starting point for regulatory reform proposals is thorough and effective consultation with interested parties. In undertaking this preliminary consultation, the Minister is expected to seek out actively the views of those concerned, including those who may be adversely affected, and then to demonstrate to the Scrutiny Committees that he or she has addressed those concerns.

E - 3 Following the consultation exercise, when the Minister lays proposals before Parliament under the Regulatory Reform Act, he or she must also lay a report for consideration by the Scrutiny Committees setting out a summary of:

- the burden imposed by the existing law;
- whether any of those burdens are proposed to be removed or reduced;
- how the proposals otherwise further the other objects of the Regulatory Reform Act (re-enacting proportionate burdens, introducing new but proportionate burdens, removing inconsistencies and anomalies);
- whether there is “necessary protection” and how it is to be continued;
- how new burdens (if any) are both proportionate and, taking the proposals as a whole, strike a fair balance between the public interest, and the interests of the persons affected by the new burdens;
- whether an Order that imposes burdens is desirable in terms either of the burdens it removes or the other benefits it brings;

- whether any parts of the proposed Order are being designated as “subordinate provisions”, allowing them to be changed by less elaborate Parliamentary procedures in the future;
- what cost savings or increases are expected, and why;
- what other benefits there will be from the proposals;
- details of the consultation process;
- any representations received as a result of that consultation; and, the changes made as a result.

E - 4 On the day the Minister lays the proposals and report, the period for Parliamentary consideration begins. It lasts for 60 days, excluding Parliamentary recesses of more than four days. If you want a copy of the proposals and the Minister’s report, you will be able to get them either from the Government department concerned or by visiting the Cabinet Office’s website at:

<http://www.cabinet-office.gov.uk/regulation/act/index.htm>

### **Parliamentary Scrutiny**

E - 5 Both Houses of Parliament scrutinise regulatory reform proposals and draft orders. This is done by the Scrutiny Committees.

E - 6 Standing Orders in the Commons stipulate that the Committee there considers whether proposals:

- (a) appear to make an inappropriate use of delegated legislation;
- (b) remove or reduce a burden or the authorisation or requirement of a burden;
- (c) continue any necessary protection;
- (d) have been the subject of, and take appropriate account of, adequate consultation;
- (e) impose a charge on the public revenues or contain provisions requiring payments to be made to the exchequer or any government department or to any local or public authority in consideration of any license or consent or of any services to be rendered, or prescribe the amount of any such charge or payment;
- (f) purport to have retrospective effect;
- (g) give rise to doubts whether they are *intra vires*;

- (h) require elucidation, are not written in plain English, or appear to be defectively drafted; or
- (i) appear to be incompatible with any obligation resulting from membership of the European Union;
- (j) prevent any person from continuing to exercise any right or freedom which he might reasonably expect to continue to exercise;
- (k) satisfy the conditions of proportionality between burdens and benefits set out in Sections 1 and 3 of the Regulatory Reform Act;
- (l) satisfy the test of desirability set out in Section 3(2)(b) of the Regulatory Reform Act;
- (m) have been the subject of, and take appropriate account of, estimates of increases or reductions in costs or other benefits which may result from their implementation; or
- (n) include provisions to be designated in the draft order as subordinate provisions; and in the case of the latter consideration the Committee shall report its opinion whether such a designation should be made, and to what Parliamentary proceedings any subordinate provisions orders should be subject.

E - 7 The Committee in the House of Lords will consider each proposal in terms of similar criteria, although these are not laid down in Standing Orders.

E - 8 Each Committee might take oral or written evidence to help it decide these matters, and each Committee could then be expected to report:

- whether the Minister should proceed to lay a draft Order in the same terms as the original proposal ,or
- whether amendment is necessary, or
- whether the Order-making power should not be used (for example, because of the significance or sensitivity of the proposal).

E - 9 Copies of Committee Reports, as Parliamentary papers, can be obtained through HMSO. They are also made available on the Parliament website at:

[http://www.parliament.uk/parliamentary\\_committees/regulatory\\_reform\\_committee.cfm](http://www.parliament.uk/parliamentary_committees/regulatory_reform_committee.cfm)

for the Regulatory Reform Committee in the Commons; and

[http://www.parliament.uk/parliamentary\\_committees/regulatory\\_reform\\_committee/regulatory\\_reform\\_committee\\_reports\\_and\\_publications.cfm](http://www.parliament.uk/parliamentary_committees/regulatory_reform_committee/regulatory_reform_committee_reports_and_publications.cfm)

for the delegated Powers and Regulatory Reform Committee in the Lords.

- E - 10 After the 60 days for Parliamentary consideration, the Minister can lay a draft Order before both Houses, this time for the approval of Parliament.
- E - 11 Each of the Scrutiny Committees examines the draft Order to see how far its views have been taken into account. They report, within 15 sitting days, whether the draft Order should be approved or not, and it would then be for the relevant House itself to take its final decision.
- E - 12 The final draft Order then has to be approved by both Houses of Parliament before becoming law.

## **Annex F**

### ***Response Form for Regulatory Reform Proposals***

#### **Respondent Details**

**Please return by 23<sup>rd</sup> September 2005**

Name:	Janet Folwell
Organisation:	Room 2Y08
Address:	Concept House Cardiff Road
Town/City:	Newport
County/Postcode:	South Wales NP10 8QQ
Telephone:	
Fax:	Fax: 01633 811174
E Mail:	E Mail: janet.folwell@patent.gov.uk

Tick this box if you are requesting non-disclosure of your response:

**(a) Do the proposals put forward in this consultation exercise maintain necessary protection for those affected?**

- Ending substantive examination on novelty and individual character grounds.
- Multiple design applications.
- Public inspection of registered designs.
- Restoration of lapsed designs

**(b) Do the proposals put forward in this consultation exercise prevent any person from continuing to exercise any right or freedom which he might reasonably expect to continue to exercise, with respect to each of the proposed measures?**

*Annex F – Response Form for Regulatory Reform Proposals*

- Ending substantive examination on novelty and individual character grounds
- Multiple design applications
- Public inspection of registered designs
- Restoration of lapsed designs

**(c) Are there any other benefits that would be gained from these proposals? Do you have any other comments?**

**The Patent Office would be grateful if you would please answer the following additional questions about the design registration system:**

- What use do you make of the current national registered designs system?
- Will you be more inclined to use it once the proposed changes have been made?
- How important a factor is the fee for registering a design?
- Are there any changes that have not been made to the system that you feel would benefit UK business?

## **Annex G**

### ***Response Form for Proposals for Revised Rules***

**Respondent Details**

**Please return by 23<sup>rd</sup> September 2005**

Name:	Janet Folwell
Organisation:	Room 2Y08
Address:	Concept House Cardiff Road
Town/City:	Newport
County/Postcode:	South Wales NP10 8QQ
Telephone:	
Fax:	Fax: 01633 811174
E Mail:	E Mail: janet.folwell@patent.gov.uk

Tick this box if you are requesting non-disclosure of your response:

**Please comment on the proposals for the revised rules:**

**PART 1: Application for registration**

**PART 2: Designs after Registration**

**PART 3: Proceedings before the Registrar**

**PART 4: The Register**

**PART 5: Miscellaneous**

**Transitional Provisions:**



## **Annex H**

### ***Code of Practice on Written Consultations***

This consultation is being conducted according to the Code of Practice on Written Consultation issued by the Cabinet Office (please see the Cabinet Office website:

<http://www.cabinet-office.gov.uk/regulation/Consultation/Code.htm>

This recommends the following criteria:

- (a) Consult widely throughout the process, allowing a minimum of twelve weeks for written consultation at least once during the development of the policy.
- (b) Be clear about what your proposals are, who may be affected, what questions are being asked and the timescale for responses.
- (c) Ensure that your consultation is clear, concise and widely accessible.
- (d) Give feedback regarding the responses received, and how the consultation process influenced the policy.
- (e) Monitor your department's effectiveness at consultation, including through the use of a designated consultation co-ordinator.
- (f) Ensure your consultation follows better regulation best practice, including carrying out a Regulatory Impact Assessment if appropriate.

If you have any comments or complaints about how this consultation process is being handled, please tell the Patent Office's Consultation Co-ordinator, who is:

Debbie Cooke  
Consultation Co-ordinator  
Room 3R09  
The Patent Office  
Concept House  
Cardiff Road  
Newport  
NP10 8QQ

Tel: 01633 813741  
Fax: 01633 814509  
E Mail: [debbie.cooke@patent.gov.uk](mailto:debbie.cooke@patent.gov.uk)



## **Annex I**

### ***Partial Regulatory Impact Assessment***

#### **1. Title of proposal**

- 1.1 A proposal to simplify and modernise the designs registration system, and make it fit for purpose with modern trading conditions.

#### **2. Purpose and intended effect of measure**

##### **(i) The objective**

- 2.1 These proposals seek to simplify and modernise the whole system of applying for, maintaining and enforcing UK design registrations. We aim to:

- Encourage more businesses to seek registration;
- Encourage UK businesses to innovate;
- Reduce the level of copying of new designs in the UK;
- Make the system fairer for all applicants;
- Increase Patent Office revenue which will help to maintain UK application and renewal fees at affordable levels; and
- Bring the UK system closer into line with the European system so that businesses can more easily compare the two systems in order to make a choice as to which type of registration is appropriate for them.

##### **(ii) The background**

- 2.2 The Registered Designs Act 1949 is the Act which governs the registration of designs in the UK. Anybody can apply to register a design under the Act, and it has become increasingly popular with small to medium sized enterprises, and with applicants without any legal representation. The purpose of gaining registration for a new design, is that the proprietor can seek to enforce the registration in a court of law, and gain an injunction, with damages, against any other trader who is found to be copying their design either knowingly or otherwise.
- 2.3 For the first time in 2003, a competitive system for obtaining a registered design covering the UK was introduced in the form of the registered Community design system. This was brought about by the Council Regulation (EC) No 6/2002 on the Community Design which paved the way for the introduction of a system for seeking and obtaining a design registration to cover the whole of the European Community by means of one application to the Office for the Harmonisation of the Internal Market (OHIM) in Alicante. Since the introduction of the registered Community design system on 1 April 2003, the input of UK national applications has decreased by almost 60%.

- 2.4 Application for either UK or EC design registration is voluntary, and most applicants would only seek protection from one system, depending on the scope of their business. But the vast majority of designs in the UK have never been registered anywhere, usually because designers are unaware of the value of protecting their new designs by registration, and so UK businesses are leaving themselves vulnerable to unauthorised copying with the rather limited UK and unregistered Community design laws being their only defence.
- 2.5 There is a need to ensure greater fairness to all owners of design registrations when it comes to protecting their rights, and this will be achieved by ending substantive examination on novelty grounds. Under the current regime, an examiner is required to refuse to register an application if he considers that the design is either identical or too similar to an already published design. Because the vast majority of designs are never registered anywhere, it is therefore an impossible task for the examiner to satisfy himself that the design being applied for has never come to the attention of any person located in the European Economic Area. An examiner can, therefore, only refuse to register an application where it appears to him that the design is self evidently not new. This current practice leads to a confusing and unfair examination system because the scope of the search (if any) at examination stage is never known, either by the proprietor or any other trader. The proposal to end novelty examination will therefore make it clear that all design registrations carry no presumption of validity. This new practice will harmonise the UK system with the registered Community design system. It will also avoid confusion over the presumed validity of design registrations, and will encourage more innovators to protect their new designs and gain the benefits, if their preference is for a UK registration rather than a more expensive Community registration.

**(iii) Risk assessment**

- 2.6 If the Designs Registry does not modernise its system, and make it more user friendly for individuals and small to medium sized enterprises, then the expectation is that this category of innovators will not protect their new designs. There is already a perception that a worrying amount of copying of new designs goes on. Encouraging protection through registration should reduce copying and encourage innovation.
- 2.7 If no changes are made to the current system, then the impact on business will be such that the UK will continue to lose revenue to other traders at home and abroad who copy their new designs, which will, in time, disillusion innovators so that they cease to spend any more time creating new designs. Also, if the level of new applications continues at its current low level then the current fees for filing a new application and subsequent renewals will have to be increased so that the cost of running the UK system is not more than the revenue created by the demand for new design registrations. This would not help UK business, as they would then have to choose between higher UK fees and still higher registered Community design fees. If their business is small then statutory costs are a major factor in their decision making.

- 2.8 There is a risk that ending examination of the 8% or so of design applications, which are examined, to determine whether the design appears to create a different overall impression from any earlier registered UK design, may slightly increase the number of designs that may be declared invalid during the course of any litigation proceedings. However, the benefits of the proposals are felt to significantly outweigh this risk.

### **3. Options**

#### **3.1 Option 1: Do nothing**

- 3.2 Although the national system of design registration currently pays for itself there is reason to believe that registration fees will have to increase significantly in 3 to 4 years time, if nothing is done to make the registration system more attractive to users and thereby increase the volume of new design applications. The Patent Office is a trading fund and must therefore cover the costs of running the system of registration. National design applications have reduced by 60% since the introduction of the registered Community design on 1 April 2003. Although application fee income has reduced, the Patent Office is covering the cost of running the system through design renewal income, which has remained healthy so far, but is bound to reduce from 2008 reflecting the drop in new national registered designs. As income from national design registration renewals dwindles over time, more of the cost of running the national system will have to be met from new applications. This is likely to mean increases in the national applications fees. UK Businesses will then be faced with a choice between higher national registration fees or higher-still Community design registration fees.

- 3.3 UK businesses already protect fewer designs than some of their European competitors, most notably France and Germany. Higher registration fees may lead to even fewer businesses, particularly small to medium sized enterprises, protecting their new designs through registration.

- 3.4 Option 2: Modernise the design registration system with a package of changes to simplify the pre and post registration procedures, and at the same time make the system more transparent and affordable. This will be achieved by:

#### *Proposal 1: Ending substantive examination on grounds of novelty*

This amendment will mean that an application for a registered design cannot be refused on the grounds that it lacks novelty when compared to already published designs, although after its registration it may still be declared invalid on that ground. This will make the registration system easier, less confusing and less costly to use. It will also bring the national system into line with the system used for the registration of Community-wide designs.

#### *Proposal 2: Allowing multiple design applications*

This amendment will remove the administrative burden and cost on those who, by reason of the nature of their business, sometimes need to register a number of new

designs at the same time and who at present need to make a separate application in respect of each design.

*Proposal 3: Ending the ability to withhold some registered designs from public inspection*

This amendment will end the statutory practice whereby some classes of designs are registered and yet remain unavailable for public inspection for a period of two or three years.

*Proposal 4: Restoration of lapsed designs*

This amendment will make it easier for a proprietor to restore a design registration that he has allowed to lapse due to the non payment of the renewal fee.

- 3.5 The proposals will encourage more innovators (especially small and medium sized enterprises) to register their designs in the UK. Larger businesses, many of whom use the services of legal practitioners, would also benefit from the easier and less costly design registration system, should their choice be for a national registration rather than a Community registration.
- 3.6 **Option 3**: Modernise the design registration system without making any changes to the legislation.
- 3.7 Introducing a more simplified and transparent system without changing the legislation would have a limited effect. All of the proposals listed above (and covered in the Consultation Document) require legislative change to bring them into effect. The most that could be achieved without changes being made to the Registered Designs Act 1949 is an update of the Registered Designs Rules, which could make some minor improvements to the way in which applications need to be filed in order to be accepted for examination, such as providing for slightly less bureaucracy at application stage. But such changes would make a negligible difference to the future demand for the system.

## **4. Benefits**

- 4.1 **Option 1**: No changes to the legislation would be required.
- 4.2 **Option 2**: The overriding benefit is essentially that the law and procedures governing the national registration of designs is antiquated, and that users (and potential users of the system) would benefit from modernisation making it easier to use and affordable. Specific improvements include:

- Avoiding confusion

Confusion over the scope of examination on novelty grounds will be removed, by making it clear that no new design application has been examined to determine whether or not the design is new when compared to already published designs;

- The benefits of a multiple design application system

The administrative burden and cost on users who wish to apply for registration of more than one new design at any one time will be reduced. Under the current regime, a typical design application would take 45 minutes to complete, broken down into 15 minutes for the common details on the application form and 30 minutes to prepare the drawings to illustrate the design for which protection is claimed. Ten single applications would therefore require 7 hours and 30 minutes of processing time. But if a multiple design application system was introduced, one multiple application for ten different designs would require one period of 15 minutes to complete the common details on the application form, with ten periods of 30 minutes to prepare the ten sets of drawings to illustrate the different designs. The total time taken to complete a typical multiple design application comprising ten different designs would therefore be 5 hours and 15 minutes. The time saved in preparing a multiple application for ten different designs as against ten single applications would therefore be 2 hours and 15 minutes.

The applicant would make a further savings in monetary terms because it is the intention of the Patent Office to pass on the savings in terms of reduced processing time to the users. It will therefore be cheaper to apply for a multiple design application comprising ten different designs than it would be for ten single applications.

- The benefits of providing for deferred publication

An optional period of deferred publication for all applicants, and not just those whose designs fall into the category of textiles, wallpaper and lace, will improve the system and make it more attractive to users. Under the current regime, a design application must be published and will therefore enter the public arena as soon as it is registered. For what are now grossly outdated reasons, the textile and wallpaper industries are the exception to that rule, as designs of these products must in every case be withheld from public inspection for three and two years respectively. This places a burden on those engaged in business and who may be affected by a registered design yet be denied access to it for all of this time.

But the publication of any design prior to the products embodying the design being placed on the market can have negative consequences for the proprietor. For example, the publication of a company's new designs may give its competitors a commercial advantage by affording them an insight into their rival's forthcoming products. It can also aid the less scrupulous to place out and out copies of the proprietor's designs on the market at a time which coincides with the launch of official products embodying the designs.

The benefit of changing the law to delay the publication and subsequent registration of a new design will be that the applicant can control the

timing of when his new design is shown to the public, and the Patent Office intends to introduce a period of no longer than 12 months for this purpose. The practical consequence of this is that it will be less likely that the situation will arise whereby a registered proprietor of a design will actually have to sue another trader for copying his design.

- 4.3 There are wider benefits to be gained by businesses as a result of the proposals, in terms of time savings as a result of reduced form filling and delays caused by uncertainty and potential legal costs. This will give businesses greater confidence, and will mean that they can spend more time on more productive activities such as innovation and marketing. Also, by harmonising the UK system more in line with the registered Community design system, businesses will not have to spend time in coming to terms with two clearly different operational systems, and will be better able to make a choice as to which type of protection would be the most appropriate for them.
- 4.4 It is intended that the implementation of the new legal procedures will coincide with a marketing effort to draw attention to the benefits of the new system which will take the form of a press release, mail shots, and updated information in the official literature and on the Patent Office website.
- 4.5 **Option 3:** No changes to the primary legislation would be needed.

## **5. Business Sectors Affected**

- 5.1 All business sectors are affected. Demand for new design registrations span the whole product spectrum.

## **6. Costs**

### **(i) Compliance costs**

- 6.1 **Option 1:** The cost of registering a new design is likely to rise if there is no change to make the system more attractive to users in order to create an increase in new applications. The Patent Office is a trading fund and therefore must cover the costs of running the registration system.
- 6.2 **Option 2:** The cost of registering new designs will be less likely to increase than if there is no change. Ending the remaining system of examination on so-called novelty grounds will slightly increase the chance of a business having to initiate proceedings to remove an invalid registered design. However, over 90% of new UK design applications are already registered without a search having been undertaken for earlier designs. And as far as the registered Community design system is concerned, all applications are registered without any search whatsoever being undertaken by OHIM. The cost of mounting invalidation proceedings before the UK Patent Office is likely to be in the region of £500-£2,000.

### **(ii) Other costs**

## **Costs for a typical business**

6.3 None

## **7. Consultation with small business: the Small Firms' impact test**

7.1 With regard to the modernisation of the designs registration system, the designs Registry staff have spoken with members of the intellectual property profession who represent businesses with design interests at a working group. A representative of individual designers is present on this group. We also held a Focus Group of professionally unrepresented applicants (and potential applicants identified from trade associations) in the summer of 2004 to seek their views on what the public want and expect from the designs registration system. The proposals in the consultation document take account of the results of these discussions, with a firm emphasis on simplifying the existing system. These activities have been discussed and agreed with the Small Business Service.

## **8. Competition Assessment**

8.1 The burden on any business as a result of these proposals is minimal, and in most cases it is reduced as a direct result of making the designs registration processes faster, less costly and fairer to all. The Competition Assessment filter has been completed and indicates that a detailed assessment is not necessary. Registered designs may be applied to any product across the whole spectrum, and therefore all markets are potentially affected by changes to the legislation. But application for registration is entirely voluntary, and no market sector is placed at an advantage above any other as a result of the new proposals.

## **9. Enforcement and Sanctions**

9.1 The general public have the choice of whether or not to opt for UK design registration. Registered design rights are a private law matter.

## **10. Monitoring and Review**

10.1 No formal monitoring review process has yet been adopted. The proposals are based on our findings up until now, from speaking with a representative group of intellectual property practitioners and a group of unrepresented applicants (and potential applicants). The Registry will continue to communicate with these groups after implementation in order to measure the success of the changes in terms of modern business needs. We will also record the numbers of new design applications received after the implementation of the new proposals, in order to make a direct comparison with the current level of demand for the system.

## **11. Consultation**

### **(i) Within government**

11.1 DTI Legal, COCAD, Parliamentary Counsel.

**(ii) Public consultation**

11.2 The Patent Office will issue a formal consultation according to established procedures. The publication of the Consultation Document will provide a springboard for dialogue with the public, and the Registry will hold meetings with the professional representative group on designs, and also a Focus Group meeting with businesses that have applied for design registration in the past. The Consultation Document will be circulated widely among industrial and commercial organisations with a potential interest in design registration.

**12. Summary and recommendation**

12.1 It is recommended that Option 2 be pursued. This option would bring the UK designs registration system more into line with the European system on the legal protection of designs, and create a more efficient and less costly system for the public to use.

**13. Declaration**

I have read the Regulatory Impact Assessment and I am satisfied that the benefits justify the costs.

Signed .....

Date

Lord Sainsbury of Turville  
Parliamentary Under-Secretary of State for Science and Innovation  
Department of Trade and Industry

Contact Point

Janet Folwell  
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