

NOTES FOR USERS

A guide to new procedures, forms and fees as from 1 October 2006

following the coming into force of

The Regulatory Reform (Registered Designs) Order 2006

and

The Registered Designs Rules 2006

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BACKGROUND

Why?

The Registered Designs Act 1949 has been substantially amended since it was first passed, although the basic rationale for the system remains the same. In addition, a climate of de-regulation and harmonisation among EU member states on the legal protection of designs has prompted a review of the whole system. Since the introduction of the registered Community design in April of 2003, not only has demand for UK design registration decreased significantly, but also the proportion of unrepresented applicants from small and medium sized enterprises has more than doubled to about 70%. Therefore, there is an even greater need to make changes to the system to ensure that the whole process for the application of new designs and their maintenance on the register is as simple and straightforward as possible.

The government wishes to encourage innovation. However, British designers have traditionally been less likely to register and protect their designs compared to designers in some of our competitors, such as France and Germany. Making it easier to protect new designs should encourage innovation in the field of design. Our intention is therefore to keep the cost of registering new designs as low as possible and to register UK designs in the sort of timescale which is relevant to a fast moving sector of the economy. This will encourage 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.

How?

The Regulatory Reform Act 2001 (which enables burdens to be removed from existing primary legislation by means of an affirmative Statutory instrument known as a Regulatory Reform Order) presented itself as the best vehicle for implementing the necessary changes to the Registered Designs Act 1949. In addition the Registered Designs Rules 2006 and the Registered Designs (Fees) Rules 2006 will support this modernisation of the Act.

When?

It is proposed that the Regulatory Reform (Registered Designs) Order 2006, the Registered Designs Rules 2006 and the Registered Designs (Fees) Rules 2006 will all come into force on 1 October 2006. The Regulatory Reform Order has been approved by the appropriate Parliamentary Committees but the Parliamentary process is not yet complete at the time of the publication of this guidance. Accordingly, this guidance is issued subject to the proposed legal changes receiving the necessary final approval of Parliament, which is expected very shortly.

What?

The purpose of this pamphlet is to advise users of differences of practice that will be required from 1 October 2006. The availability of the new provisions (including,

where relevant, the transitional provisions) are clearly indicated at the beginning of each section.

Summary

The main changes to the Registered Designs Act 1949 will be:

- **Ending the examination of new applications on grounds of novelty and individual character**
At present some applications are examined for novelty and individual character and some are not. This change will remove any confusion over whether or not an examiner has compared the design with the prior art. This will make the registration system easier 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.
- **Allowing multiple design applications**
This amendment will remove the administrative burden on, and reduce the cost to, those who, by reason of the nature of their business, sometimes need to apply to register a number of new designs at the same time.
- **Ending the ability to withhold some registered designs from public inspection**
This amendment will end the practice whereby some classes of designs are registered and yet remain unavailable for public inspection for a period of 2 or 3 years. Instead, new rules will provide for all applicants to have the option of delaying publication and registration of their design for up to 12 months. This will enable official publication of the registration to coincide with the product launch and so reduce the risk the design will be copied before it is marketed by the designer.
- **Restoration of lapsed designs**
This amendment will make it easier for a proprietor to restore a registration that he has allowed to lapse due to the non payment of the renewal fee.

The main changes in the Registered Designs Rules 2006 will be:

- **Simplification of the application procedure**
This is so that it will be less bureaucratic and therefore less time consuming to complete an application.
- **Provision to support a multiple application system**
Businesses will be able to make as many applications for the registration of new designs as they wish, all as part of one application to the UK Intellectual Property Office. This will cut down on the time taken to file separate applications for each design.
- **A modernised set of statutory forms**
The new forms will be easier and therefore less time consuming to complete. They are also designed in the style of the other statutory forms on trade marks and patents.
- **Provision for the public inspection of documents**

This new provision will enable the public to readily see documentation on the official files that surrounded the acceptance of design applications and their maintenance on the register.

- **A requirement on the registrar to publish new designs in a journal**
The Registrar has voluntarily published new designs for some time, but provision will be made to make the publication of all new designs a statutory requirement.

The main changes in the Registered Designs (Fees) Rules 2006 will be:

- **A new multiple application fee structure**
This will enable the multiple application system to be introduced. The cost of registering a single design will remain unchanged at £60. The cost of applying to register additional designs at the same time will reduce to £40.
- **A new deferment of publication fee**
This will enable the new deferment option to be introduced. This will allow the applicant to defer paying £20 of the registration fee for up to one year, but that proportion of the registration fee and an additional fee of £20 will be due when publication is requested. This will cover the administrative cost to the Office of handling deferment requests.

Janet Folwell
Designs Examination Section
Trade Marks and Designs Directorate
The Patent Office

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These Notes are not authoritative, and they are only intended to be a guide to users. They represent the author's views of the changes made to registered designs legislation by the Regulatory Reform (Registered Designs) Order 2006, the Registered Designs Rules 2006 and the Registered Designs (Fees) Rules 2006.

CHANGES TO THE REGISTERED DESIGNS ACT 1949

1. Ending Novelty Examination

1.1 On receipt of a new design application, the Examiner will consider the case in accordance with the new substantive grounds for refusal. These will be exactly the same as before but will exclude any examination, and therefore any potential refusal, on grounds of novelty or individual character.

1.2 The transitional provisions provide for all applications received at The UK Intellectual Property Office before 1 October 2006 to be examined and proceeded to registration or refusal in accordance with the old law provisions. *[This is not right, the transitional provisions mean that the invalidity (cancellations) of pre 2001 designs remains the same, any design application filed before 1st October 2006, may not be refused on novelty grounds]*

2. Allowing Multiple Applications

2.1 The new application system will allow for any number of new designs to be applied for under one single application, with an amended fee structure which will provide financial enhancements for multiple filings rather than single applications. There will be no restrictions on the filing of designs as part of a multiple application. The Form DF2A has been re-designed to provide for more than one design in any application, and a new DF2B form has been introduced to allow for surplus designs in any original multiple application (on the grounds that insufficient fees were paid) to be applied for by maintaining the filing date of the original application. Also, a Designs Ready Reckoner sheet has been designed to assist applicants to calculate the correct fee payable in any multiple application.

2.2 The application form asks for largely the same information as before, but the structure of the form is different, with common information such as name and address and contact details on front, with a back sheet asking for information that is special to the design being applied for. So this back sheet should be copied for as many designs that are being applied for in the application.

2.3 In any multiple application that results in some of the designs being subject to substantive and/or formalities objections by the examiner and the remaining designs being deemed acceptable to proceed to publication and registration, those that are deemed acceptable will be allowed to proceed without delay. The remaining designs will be dealt with in accordance with the requirements in each and every case, and may themselves proceed at different stages.

2.4 Once the designs applied for as part of a multiple application reach registration, they will exist on the register in their own right, with no evidence that they reached registration as part of any multiple application. They will be treated separately for the purpose of all post registration actions. The whole purpose of the new multiple application system therefore is for administrative convenience and not for any post registration matter.

3. Ending the withdrawal of some registered designs from public inspection

3.1 The new system will not require the mandatory deferment of publication by the Registrar of **any** design application. Consequently, as soon as the examiner has completed all processes and no issues are outstanding, the design will proceed to publication and registration as soon as possible.

3.2 All designs received by the UK Intellectual Property Office before 1 October 2006 will be processed in accordance with the old law provisions. Publication of those designs that are not withheld from public inspection will therefore be voluntarily published by the Registrar.

4. Facilitating the restoration of lapsed design registrations

4.1 The new system will show greater flexibility where a registration lapses due to an administrative error. If the applicant for restoration is able to state on the application form that the failure to pay the renewal fee on time was unintentional, then he is unlikely to be asked to show any evidence to support his case. Also, the DF30 form has been abolished and so applications for restoration may be made by filing only a DF29 form with the fee for that form (as well as the renewal fee of course). This differs from the current system in that an application for restoration should 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 the protection.

4.2 The new restoration procedure applies to any application for restoration made after 1st October 2006 regardless of whether the design was applied for before or after that date.

CHANGES TO THE REGISTERED DESIGNS RULES

1.1 A brand new set of rules have been written from scratch in conjunction with the modernisation of the primary legislation. Also, a brand new set of forms have been designed to enable the new system to be introduced.

1.2 The main changes to the existing rules are listed in the following paragraphs.

Simplification of the application procedure

1.3 A new application form DF2A has been designed to provide for multiple designs in any one application. A new form DF2B has also been designed to enable surplus designs filed in any original multiple application (on the basis that insufficient fees were paid) to be re-filed and granted the original filing date. *Hotlink to DF2A plus notes and DF2B plus notes.*

1.4 The requirements for filing are all listed on the application form and in the accompanying notes for guidance. Requirements in the existing rules such as two sets of representations, and text on representations such as page numbering and name of applicant, will have been removed to make the completion of applications less bureaucratic and time consuming.

1.5 Under the new system, the Registrar will grant the filing date if the applicant has not yet prepared paper representations of the design and can only file a specimen.

1.6 The period for putting an application in order will be reduced from 12 months to 2 months, although if an applicant can provide the Registrar with good reasons, the 2 month period may be extended. – *At present the period prescribed for the purposes of section 3(5) is 12 months, not 2 months. Is this wrong?*

Option to defer publication of designs

1.7 In any design application, applicants must consent to the publication and registration of the design or designs. If they do not consent then they must ask to defer the publication and registration of the design or designs, and they will have a period of up to 12 months from the date of filing in which to give their consent and request publication on Form DF2C and pay the outstanding fees.

Public inspection

1.8 A new provision has been introduced to provide for the public inspection of documents. Subject to certain conditions, documentation relating to registered designs may be inspected, although this provision will not be retrospective. A new rule to request confidentiality of documents has also been introduced. However this right of inspection only applies in relation to applications for designs filed after 1st October 2006.

Security for costs

1.9 The Registrar's discretion to require security for costs is limited further. The new rule takes account of the relevant provisions of international treaties and it is derived from the equivalent provision of the Civil Procedure Rules 1998 (CPR r. 25.12 and r.25.13). The Registrar will have the 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.

Filing a counterstatement

1.10 A new Form DF19B has been designed for the purpose of filing a counter statement, and a new consequence for not filing a counterstatement has been introduced, namely that the registrar may treat the registered proprietor as not opposing the application. The counter statement must state which allegations are denied or admitted, and which allegations the registered proprietor requires the applicant to prove.

Filing for self cancellation of a registration

1.11 A new Form DF19C has been designed for the purpose of self cancellation by the registered proprietor. This action is currently covered by the DF19A form which also covers invalidation and cancellation under the old law.

CHANGES TO THE REGISTERED DESIGNS FEES TO ENABLE MULTIPLE DESIGN APPLICATIONS AND DEFERMENT OF PUBLICATION

1.1 The current fee of £60 to file a single design application is being replaced with a fee structure to enable multiple design applications and the option to defer publication.

1.2 The cost of filing a single application with no request to defer publication will remain the same at £60. However, if deferment is requested then the applicant need only pay £40 at the application stage, but a further £40 will be required when publication is requested (on Form DF2C). So ultimately, an applicant will pay £80 for a single application if he defers publication, or only £40 if he files the application but chooses not to proceed to publication and registration after all.

1.3 The cost of filing a multiple application is dependent upon how many designs are being applied for and how many designs in the application are to have deferred publication (if any). The fees are split according to application and publication. The fee for the first design in an application where publication is not deferred is £60, and is £40 for the second and any subsequent design. These applications will proceed to publication and registration as soon as possible.

1.4 The fees for the first design where publication IS to be deferred is £40 for the first design and £20 for the second and any subsequent design. At a time up to a maximum period of 12 months, the applicant may request publication and registration of any of the designs to complete the process. He will need to file a new Form DF2C and pay the £20 publication fee and an extra £20 deferment fee for each design.