

Consultation on proposed new registered designs rules

Summary of Responses and the Designs Registry's Conclusions

Overview

1.1 The formal consultation document entitled "Consultation on the Modernisation of the UK Designs Registration System" included a draft new set of rules, and this was placed on the Patent Office website on 12 July 2005 for a full period of 3 months. During the consultation period, the document was accessed by 1,377 users and paper copies were sent to all of the organisations and individuals listed at [Annex A](#). A total of four organisations commented specifically on the proposed new rules, namely The Chartered Institute of Patent Agents (CIPA), The Institute of Trade Mark Agents (ITMA), The Licensing Executives Society (LES) and The Trade Marks Patents and Designs Federation (TMPDF).

1.2 The Designs Registry is in the process of modernising the system to register new designs, to make it as quick, accessible and as affordable as possible. The aim of the new rules is to achieve the modernisation objectives, and to underpin the changes to the Registered Designs Act 1949 that are due to be made with a Regulatory Reform Order.

1.3 The responses make clear that the users of the system generally welcome the brand new set of rules that are being proposed although some point to the need for the new rules to be crystal clear in order to avoid any ambiguities in the new system. However, balanced against the overwhelming support for the new set of rules, some concerns were raised in respect of particular aspects of the proposed changes. These are summarised below together with our conclusions.

Summary of responses and our conclusions

2.1 The consultation document did not contain any direct questions. Consequently, the responses were limited to comments and observations on the various rules. A number of drafting amendments have been made as a result of the responses. The summary of the main responses, together with our conclusions, are as follows. The rule numbers follow the order of the draft rules in the consultation document. In the final draft, the rule numbers will be reordered.

New Forms

2.2 One organisation commented that draft new forms would have been helpful as part of the consultation process. We felt however that it was far too early to draft the actual forms and that this would be better done at the stage when respondents had had the opportunity to comment on the proposed changes to the rules. A [mini consultation](#) has now been launched to introduce a whole new set of forms as well as a full three month [public consultation on the new fees](#) to support the introduction of the new registration system.

2.3 Following a suggestion that self cancellation and invalidation actions are entirely separate and so should be applied for on separate forms, this has been proposed as part of the forms consultation exercise.

Specimens

2.4 There was some confusion over the meaning of rule 4(5) entitled "formal requirements". To clarify, the effect of Rule 4(5) is that, where a specimen is filed that is larger than the dimensions specified in the second requirement in Rule 4(4), then the applicant may replace it with a representation of the design without affecting the filing date of the application.

2.5 There were comments relating to the meaning of rule 8 (unacceptable specimens) that are dealt with under rule 4(5). To clarify, an applicant may opt to defer publication at the time of making the application. If he does so, he may request publication at any time during the following 12 months, but if a suitable representation was not provided at the time of making the application (or a specimen only was filed) then the registrar will direct that a suitable representation is filed for publication purposes.

IC Claims

2.6 There were a number of specific concerns over the detailed procedure of filing convention applications in rule 6, such as specimens filed in place of representations in earlier applications and office to office e transfer of priority documents. We decided to leave the rule as it stands and to clarify the practice in the published guidance before we implement the new system.

Publication

2.7 One respondent raised concern over the consequence of not providing consent to publication at the application stage. This rule is linked to a new feature of the registration system which is a statutory obligation on the registrar to publish new designs in a journal (see rule 10 entitled "publication"). If consent to publication is not given at the time of making the application, it may be given later (see rule 8 entitled "representation of design for publication") thus deferring publication (and registration) of the designs concerned up to a maximum of 12 months. See section 3(5) of the Registered Designs Act 1949.

2.8 Two organisations questioned the meaning of the words "shall be the representation filed" in rule 10(3) in that this assumes only one representation of the design or that everything filed is published. It is confirmed that an electronic journal will be provided in time for the new system being implemented and that there will be a hotlink to the full registration details from the publication which will only show what the Examiner considers to be the best view. The publication of any other detail (such as renewals) will continue to be at the discretion of the registrar.

Multiple applications

2.9 Following a question from one organisation, it is confirmed that designs filed as part of a multiple application will be treated separately for the purpose of all post registration actions. Therefore, for example, each and every design must be renewed separately.

Restorations

2.10 One organisation questioned why, in rule 12(1)(b), evidence needs to be filed in support of restoration when the guidance note on the Form DF29 suggests that the applicant only need say that failure to pay for renewal was unintentional. It is confirmed that a signature on the Form DF29 will be sufficient evidence unless the registrar requests further evidence in a special case.

Security for costs

2.11 One organisation raised specific concerns about rule 21 and the changes made to security for costs. They feel that the change will result in higher costs to smaller businesses. It was also said that it will present practical problems. We have decided to leave this rule as it stands because it takes account of the relevant provisions of international treaties and is derived from the equivalent provision in the Civil Procedure Rules of 1998. We will clarify the practice in the published guidance as we implement the new system.

Public Inspection

2.12 New rules have been included to answer the concerns of many that there is still no current provision in registered designs legislation to allow for the public inspection of documents. Subject to certain conditions, documentation relating to registered designs may be inspected under the new rules, although the provision will not be retrospective. A new rule on confidential information will also be included.

Address for service

2.13 The rule governing address for service requirements has been amended to reflect the liberalisation of address for service requirements, to cover other EEA states and the Channel Islands.

Annex A

Organisations Consulted

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