

## **IPLA response to Call for Evidence on proposed changes to Registered Designs Act 1949 Intellectual Property Lawyers' Association**

This response is made on behalf of the Intellectual Property Lawyers' Association ('IPLA'). IPLA is a representative body for law firms in England, Scotland and Wales with substantial practices in Intellectual Property ('IP') litigation, and who wish to lobby for improvements in IP law and practice. Around 65 firms are members of IPLA. The vast majority of IP litigation in the UK is conducted by these member firms. This is recognised in the fact that IPLA is the vehicle through which the solicitors' profession's views are represented on the Intellectual Property Court Users' Committee (IPCUC) and the Intellectual Property Enterprise Court Users' Committee. Accordingly, we consider that we are well placed to make constructive comments in relation to the issues raised in this Call for Evidence.

### **Background**

IPLA understands that an amendment ('the Proposed Amendment') to UK designs legislation is proposed to give registered design owners the option of marking a product (or, presumably, its packaging) with the address of a website which links the product with the relevant registered design numbers. This would be sufficient to provide third parties with constructive notice of the owner's design rights. In order to provide safeguards for third parties, the website should be accessible to the public free of charge and clearly associate the product with the number of the registered design right(s). It is anticipated that the Proposed Amendment will mirror section 15 of the IP Act 2014 which makes a similar amendment in respect of patents.

### **Questions posed in the Call for Evidence and the IPLA's response**

*1. Do you have any comments on the proposed changes to allow webmarking for registered design rights?*

IPLA is supportive of the Proposed Amendment. The current scheme of marking a product (or its packaging) with design registration details involves a number of variables. First, when the product itself is marked, it requires an 'out of the ordinary' change to the manufacturing process of a product, and an added cost. Secondly, a particular product may be covered by multiple design registrations in multiple jurisdictions and there may not be enough space on the product to mark it with all the relevant design numbers. Thirdly, grant of the design registration may not occur until after the tooling has been finalised, in which case the tooling will need to be changed in order to add the design registration details or, more likely, the owner will simply decide not to mark the product because of the additional costs involved. Finally, it is a criminal offence in the UK to mark a product as registered after expiry of a registration in the case of both a UK and Community registered design. Therefore, the same retooling costs considerations apply after a design has expired.

In our experience, only the most IP-sophisticated clients regularly mark their products (or their packaging) with the relevant design details.

IPLA considers that the scheme under the Proposed Amendment is more attractive to clients. The IP or Legal department of a client is more likely to be able to organise changes to a website rather than to the tooling of a product. The costs involved in adding, deleting and maintaining registered design details across multiple jurisdictions on a website are likely to be minimal. Further, there are no space restrictions on a website.

*2. Do you currently hold both patent and design rights or intend to do so in the future? If available, would you use webmarking to provide constructive notice for both types of rights?*

IPLA members act as advisers to design right owners. We do not own any designs. There will of course be companies who will not use marking at all because they are not aware of the relevant provisions relating to notice. However, in our experience of acting for clients, IPLA believes that those who do know about the benefits of marking are more likely to use the webmarking scheme under the Proposed Amendment than the current scheme.

*3. Is it likely that the wording will be similar to the patent change introduced in the IP Act 2014, as provided at Annex A. Do you have any specific comments on the drafting?*

IPLA has no comments on the drafting.

**Intellectual Property Lawyers' Association  
10 August 2015**