

# How the Intellectual Property Act 2014 will change British Unregistered Design Right Law



Jane Lambert  
Barrister  
4-5 Gray's Inn Square  
jlambert@4-5.co.uk  
020 7404 5252

Unregistered design right or design right is a peculiarly British intellectual property right. It protects original designs<sup>1</sup> (that is to say aspects of shape or configuration of articles or parts of articles have been recorded in a design drawing, CAD program or other document or embodied in a prototype<sup>2</sup>) from being reproduced<sup>3</sup> for up to 15 years<sup>4</sup>. Although this right can be used to protect ornamental designs it is relied on generally to protect functional designs, that is to say designs of machinery and electrical and mechanical components. Until 31 July 1989 designs recorded in design drawings were protected indirectly by the artistic copyright subsisting in such drawings for the life of the author plus 50 years but that protection was regarded as too long and too full of anomalies. Design right, which is provided by Part III of the Copyright, Designs and Patents Act 1988 ("CDPA"), shortens the duration of that protection and removes some of those anomalies. Although design right has been part of our law since 1 Aug 1989 no other country has adopted it though New Zealand and Hong Kong continue to protect product designs by copyright. Most other countries rely on utility models or a general law of unfair competition to protect the sort of designs that are protected by design right in the United Kingdom.

## Unregistered Design Right

S.213 (1) of the CDPA defines design right as "a property right which subsists in accordance with .... Part [III] of the CDPA in an original design." In that Part "'design' means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article". There are a

<sup>1</sup> S.213 (1) Copyright Designs and Patents Act 1988 1988 c. 48

(<http://www.legislation.gov.uk/ukpga/1988/48/section/213>)

<sup>2</sup> S.213 (2) and (6) *ibid*.

<sup>3</sup> S.226 (1) *ibid*

(<http://www.legislation.gov.uk/ukpga/1988/48/section/213>)

<sup>4</sup> S.216 (1) (a) *ibid*

(<http://www.legislation.gov.uk/ukpga/1988/48/section/216>)

number of exclusions set out in s.213 (3)<sup>5</sup> but the main point is that there is no need for the article to be new, have individual character, appeal to, or even be visible to, the eye. In that respect the requirements for the subsistence of unregistered design right are quite different from those for design registration under the Registered Designs Act 1949<sup>6</sup> or the Community Designs Regulation,<sup>7</sup> the subsistence of unregistered Community design right or registration under the 1949 Act before the Designs Directive<sup>8</sup> was implemented. "Originality" is not defined but s.213 (4) provides that a "design is not "original" if it is commonplace in the design field in question at the time of its creation." As with copyright there is a nationality or residence qualification for the subsistence of design right<sup>9</sup> but as Hong Kong and New Zealand are the only countries that offer reciprocal protection for British designs only citizens or residents of those countries together with citizens or residents of the British islands and our European partners<sup>10</sup> satisfy that qualification.

Like copyright the first owner of the design right in the design is the person who created it ("the designer")<sup>11</sup> or his or her employer<sup>12</sup> unless he or she created it pursuant to a commission in which case (unlike copyright) the first owner is the person who commissioned the design.<sup>13</sup>

Design right in a design is infringed by making articles to the design<sup>14</sup> or by making a design

<sup>5</sup> "(3) Design right does not subsist in—

(a) a method or principle of construction,

(b) features of shape or configuration of an article which—

(i) enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function, or

(ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part, or

(c) surface decoration."

<sup>6</sup> 1949 c. 88 (Regnal. 12\_13\_and\_14\_Geo\_6)

(<http://www.legislation.gov.uk/ukpga/Geo6/12-13-14/88/contents>)

<sup>7</sup> OJ EC No L 3 of 5.1.2002, p. 1

([https://oami.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/aw\\_and\\_practice/cdr\\_legal\\_basis/62002\\_cv\\_en.pdf](https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/aw_and_practice/cdr_legal_basis/62002_cv_en.pdf))

<sup>8</sup> Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (OJ L 289 , 28/10/1998 P. 0028 – 0035)

([https://oami.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/aw\\_and\\_practice/cdr\\_legal\\_basis/EUR-Lex%20-%2031998L0071\\_en.htm](https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/aw_and_practice/cdr_legal_basis/EUR-Lex%20-%2031998L0071_en.htm))

<sup>9</sup> "(5) Design right subsists in a design only if the design qualifies for design right protection by reference to—

(a) the designer or the person by whom the design was commissioned or the designer employed (see sections 218 and 219), or

(b) the person by whom and country in which articles made to the design were first marketed (see section 220), or in accordance with any Order under section 221 (power to make further provision with respect to qualification)."

<sup>10</sup> S.217 CDPA

<sup>11</sup> S.214 (1) *ibid*

<sup>12</sup> S.215 (1) *ibid*

<sup>13</sup> S.215 (2) *ibid*

<sup>14</sup> S.226 (1) (a) *ibid*

document recording the design for the purpose of enabling such articles to be made.<sup>15</sup> Making articles to a design means copying the design so as to produce articles exactly or substantially to that design.<sup>16</sup>

Design right subsists for 15 years from the end of the calendar year in which the design was first recorded in a design document or an article was first made to the design, whichever occurs first.<sup>17</sup> If, however, articles made to the design are made available for sale or hire within 5 years from the end of the calendar year in which either of those events occurred then the term is reduced to 10 years from the end of the calendar year in which those goods were first made available for sale or hire.<sup>18</sup> Moreover, in the last 5 years of that term, anyone in the world including an infringer can apply to the design right owner for a licence to do anything that would otherwise infringe the design right as of right.<sup>19</sup> If the parties cannot agree the terms of such licence they can refer the dispute to the Comptroller-General of Patents, Designs and Trade Marks<sup>20</sup> ("the Comptroller") or in practice a hearing officer appointed by the Comptroller. If an infringer undertakes to take a licence of right he or she cannot be injuncted<sup>21</sup> and the maximum damages or other pecuniary relief that the design right owner can recover from the infringer is twice the royalties payable under a licence of right.<sup>22</sup>

### Problems with Design Right

Although Part III of the Act addressed many of the anomalies that had arisen under the old law it created several of its own. For instance, the definition of design as "the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article" was held by Mr. Justice Laddie in *Ocular Sciences Ltd and Others v Aspect Vision Care Ltd and Others* (No.2)<sup>23</sup> to create a multitude of separate design rights in a range of different contact lens designs which differed from each other only in tiny dimensions that could be measured only under a powerful microscope. It was not clear from the words "commonplace in the design field in question" whether that meant commonplace in the UK, the world or somewhere in between. The lack of reciprocal protection for British meant that designs by companies in the USA, China, Japan, India, Korea and other big countries would not usually qualify for design right protection.<sup>24</sup> The differences between copyright and design law with regard to

commissions and exceptions have already been noted. These were discussed in the IPO's Consultation on the *Reform of the UK Designs Legal Framework*.<sup>25</sup> The Intellectual Property Act 2014<sup>26</sup> ("IPA") is intended to address those issues.

### Definition of "Design"

The problem that occurred in *Ocular Sciences* has been tackled by changing the definition of design in s.213 (2) of the CDPA. S.1 (1) of IPA removes the words "any aspect of" from s.213 (2) CDPA. When this provision comes into force the subsection will read:

"In this Part "design" means the design of ..... the shape or configuration (whether internal or external) of the whole or part of an article."

A corresponding amendment will be made in s.51 (3) in Part I<sup>27</sup> of the CDPA by s.1 (2) IPA.

### Originality

S.1 (3) IPA will insert the words "in a qualifying country" after "commonplace" in s.213 (4) CDPA and "and "qualifying country" has the meaning given in section 217(3)" at the end of that subsection. After the commencement s.S.213 (4) CDPA will read:

"A design is not "original" for the purposes of this Part if it is commonplace *in a qualifying country* in the design field in question at the time of its creation *and "qualifying country" has the meaning given in section 217(3).*"

As I shall explain later, although the list of qualifying countries has not expanded the qualifications for domicile in any of those countries has. This change removes at least one uncertainty of determining originality.

### Commissions

S.2 IPA removes one of the differences between design right and copyright law. It removes references to commissions in s.215 CDPA. After that provision comes into force, the section will read as follows:

#### "215 Ownership of design right.

(1) The designer is the first owner of any design right in a design which is not created ..... in the course of employment.

.....

<sup>15</sup> S.226 (1) (b) *ibid*

<sup>16</sup> S.226 (2) *ibid*

<sup>17</sup> S.216 (1) (a) *ibid*

<sup>18</sup> S.216 (1) (b) *ibid*

<sup>19</sup> S.237 (1) *ibid*

<sup>20</sup> S.237 (2) *ibid*

<sup>21</sup> S.238 (1) (a) *ibid*

<sup>22</sup> S.238 (1) (c) *ibid*

<sup>23</sup> [1997] RPC 289, [1996] EWHC Patents 1, (1997) 20(3) IPD 20022 (<http://www.bailii.org/ew/cases/EWHC/Patents/1996/1.html>)

<sup>24</sup> *Mackie Designs Inc v. Behringer Specialised studio equipment (UK) Ltd and Others* [1999] EWHC Ch 252

<sup>25</sup> July 2012 <http://www.ipo.gov.uk/consult-2012-designs.pdf>

<sup>26</sup> 2014 c 18

(<http://www.legislation.gov.uk/ukpga/2014/18/contents/ena.cted>)

<sup>27</sup> The provisions on copyright.

(3) Where..... a design is created by an employee in the course of his employment, his employer is the first owner of any design right in the design.

(4) If a design qualifies for design right protection by virtue of section 220 (qualification by reference to first marketing of articles made to the design), the above rules do not apply and the person by whom the articles in question are marketed is the first owner of the design right."

There are consequential changes throughout the Act. For instance, s.213 (5) will read

"Design right subsists in a design only if the design qualifies for design right protection by reference to—

(a) the designer or the person by whom the designer was employed (see sections 218 and 219), or

(b) the person by whom and country in which articles made to the design were first marketed (see section 220), or in accordance with any Order under section 221 (power to make further provision with respect to qualification)."

I shall refer to the provisions that relate to qualification in the next paragraph.

S.2 (3) IPA provides that this amendment does not apply to any design created before commencement or indeed to any design created after commencement so long as the design was created in pursuance of a commission and an agreement relating to the commission was entered by the designer and commissioner before commencement.

Clearly, designers and those who commission designs need to review their terms of business and standard form contracts. Businesses that commission designs after commencement that wish to sue to prevent unlicensed copying of their designs must ensure that they obtain an assignment of design right including any right to damages that may have accrued before issuing proceedings for design right infringement. This is thus a potential trap for the unwary.

S.6 of the IPA makes similar provision with regard to commissions of registered designs.<sup>28</sup>

### Qualification

#### <sup>28</sup> "Ownership of design and application for registration

(1) In section 2 of the Registered Designs Act 1949 (ownership of registered designs)—

(a) omit subsection (1A) (which provides for the commissioner of a design to be the original proprietor), and

(b) in subsection (1B), omit " in a case not falling within subsection (1A)."

(2) In section 3 of that Act (application for registration), omit subsection (2) (requirement for application to be made by person claiming to be proprietor).

S.3 of IPA enables businesses that carry on business in the UK, British Islands, EU, Hong Kong or New Zealand to claim design right in any original designs that they create regardless of where they are incorporated or *semble* where the designs are created. Sections 217 of the CDPA will thus read as follows:

#### "217. Qualifying individuals and qualifying persons.

(1) In this Part—

.....<sup>29</sup>

"qualifying person" means—

(a) *an individual habitually resident in a qualifying country, or*

(b) *a body corporate or other body having legal personality which—*

(i) *is formed under the law of a part of the United Kingdom or another qualifying country, and*

(ii) *has in any qualifying country a place of business at which substantial business activity is carried on.*<sup>30</sup>

(2) References in this Part to a qualifying person include the Crown and the government of any other qualifying country.

(3) In this section "qualifying country" means—

(a) the United Kingdom,

(b) a country to which this Part extends by virtue of an Order under section 255,

(c) another member State of the European Union, or

(d) to the extent that an Order under section 256 so provides, a country designated under that section as enjoying reciprocal protection.

.....<sup>31</sup>

(5) In determining for the purpose of the definition of "qualifying person" whether substantial business activity is carried on at a place of business in any country, no account shall be taken of dealings in goods which are at all material times outside that country."

S.218 will become:

#### "218 Qualification by reference to designer.

(1) This section applies to a design which is not created .....<sup>32</sup> in the course of employment.

<sup>29</sup> Omitted pursuant to s.3 (1) (a) IPA.

<sup>30</sup> Text in italics substituted by virtue of s.3 (1) (b) IPA.

<sup>31</sup> Omitted pursuant to s.3 (2) IPA

(2) A design to which this section applies qualifies for design right protection if the designer is ...<sup>33</sup>. a qualifying person.

(3) A joint design to which this section applies qualifies for design right protection if any of the designers is .....<sup>34</sup>. a qualifying person.

(4) Where a joint design qualifies for design right protection under this section, only those designers who are .....<sup>35</sup> qualifying persons are entitled to design right under section 215(1) (first ownership of design right: entitlement of designer).”

S.219, which has been amended by s.2 IPA, will read:

**“219 Qualification by reference to employer.<sup>36</sup>**

(1) A design qualifies for design right protection if it is created *in the course of employment with a* qualifying person.

(2) In the case of ..... joint employment a design qualifies for design right protection if any of ..... employers is a qualifying person.<sup>37</sup>

(3) Where a design which is .... created in the course of joint employment qualifies for design right protection under this section, only those ..... employers who are qualifying persons are entitled to design right under section 215 (3) (first ownership of design right: entitlement of ..... employer).<sup>38</sup>

Section 220 will read as follows:

**“220 Qualification by reference to first marketing.**

(1) A design which does not qualify for design right protection under section 218 or 219 (qualification by reference to designer, .....<sup>39</sup> or employer) qualifies for design right protection if the first marketing of articles made to the design—

(a) is by a qualifying person .....<sup>40</sup>, and

(b) takes place in the United Kingdom, another country to which this Part extends by virtue of an Order under section 255, or another member State of the European Union.

(2) If the first marketing of articles made to the design is done jointly by two or more persons, the design qualifies for design right protection if any of

those persons meets the *requirement* specified in subsection (1) (a).<sup>41</sup>

(3) In such a case only the persons who meet *that requirement* are entitled to design right under section 215(4) (first ownership of design right: entitlement of first marketer of articles made to the design).<sup>42</sup>

(4) .....<sup>43</sup>

References to commissioning of designs are also removed from s.263 and s.264 of CDPA.

**Exceptions from Design Right**

S.4 IPA inserts two sections into Part III of the CDPA which provide exceptions to design right:

*“Miscellaneous*

**244A Exception for private acts, experiments and teaching**

Design right is not infringed by—

(a) an act which is done privately and for purposes which are not commercial;

(b) an act which is done for experimental purposes; or

(c) an act of reproduction for teaching purposes or for the purpose of making citations provided that—

(i) the act of reproduction is compatible with fair trade practice and does not unduly prejudice the normal exploitation of the design, and

(ii) mention is made of the source.

**244B Exception for overseas ships and aircraft**

Design right is not infringed by—

(a) the use of equipment on ships or aircraft which are registered in another country but which are temporarily in the United Kingdom;

(b) the importation into the United Kingdom of spare parts or accessories for the purpose of repairing such ships or aircraft; or

(c) the carrying out of repairs on such ships or aircraft.”

**Appeals**

I have already mentioned the Comptroller’s jurisdiction to settle the terms of a licence of right pursuant to s.237 (2) of the CDPA. The Comptroller also has exclusive jurisdiction under s.246 to resolve disputes on:

<sup>32</sup> Omitted pursuant to s.2 (2) (b) IPA

<sup>33</sup> Omitted pursuant to s.3 (3) (a) IPA

<sup>34</sup> Omitted pursuant to s.3 (3) (b) IPA

<sup>35</sup> Omitted pursuant to s.3 (3) (c) IPA

<sup>36</sup> Text in italics substituted pursuant to s.2 (2) (c) IPA

<sup>37</sup> Text omitted pursuant to s.2 (2) (d) IPA.

<sup>38</sup> Text omitted pursuant to s.2 (2) (e) and text in italics substituted pursuant to s.2 (2) (f) IPA,

<sup>39</sup> Omitted pursuant to s.2 (2) (g) IPA

<sup>40</sup> Omitted pursuant to s.3 (4) (a) IPA

<sup>41</sup> Text in italics substituted pursuant to s.3 (4) (b) IPA

<sup>42</sup> Text in italics substituted pursuant to s.3 (4) (c) IPA

<sup>43</sup> Omitted pursuant to s.3 (4) (d) IPA.

- (a) the subsistence of design right,
- (b) the term of design right, and
- (c) the identity of the person in whom design right first vested.

Again, this jurisdiction is exercised by hearing officers on behalf of the Comptroller. Appeals from the hearing officer relating to the terms of licences of right lie to the Registered Designs Appeal Tribunal<sup>44</sup> which is established under s.28 of the Registered Designs Act 1949. However, appeals on all other matters relating to design right lie to the High Court in England and Wales or the Court of Session in Scotland.<sup>45</sup>

There have been proposals to reform this appeal mechanism for many years<sup>46</sup> and in commenting on one of those proposals I suggested<sup>47</sup> extending the jurisdiction of the person appointed to hear trade mark appeals under s.76 of the Trade Marks Act 1994 ("the Appointed Person"<sup>48</sup>) to designs as long ago as 2005. I am glad to say that Parliament has done just that. S.10 (4) of the IPA repeals s.28 of the Registered Designs Act 1949 thereby abolishing the Registered Designs Appeal Tribunal while s.10 (2) IPA inserts new sections into the 1949 Act that provide for Appointed Persons to be appointed for design appeals.<sup>49</sup> S.10 (7) (a) amends s.249 of the

<sup>44</sup> S.249 (1) CDPA

<sup>45</sup> S.251 (1) CDPA.

<sup>46</sup> See for example my post "Designs: Abolition of Registered Designs Appeal Tribunal" 16 Oct 2005 <http://nipclaw.blogspot.co.uk/2005/10/designs-abolition-of-registered.html>

<sup>47</sup> *Ibid*

<sup>48</sup> S.77 (1) Trade Marks Act 1994 <http://www.legislation.gov.uk/ukpga/1994/26/section/77>

<sup>49</sup> After section 27 of that Act insert—

**"27A Appeals from decisions of registrar**

- (1) An appeal against a decision of the registrar under this Act may be made to—
  - (a) a person appointed by the Lord Chancellor (an "appointed person"), or
  - (b) the court.
- (2) On an appeal under this section to an appointed person, the appointed person may refer the appeal to the court if—
  - (a) it appears to the appointed person that a point of general legal importance is involved,
  - (b) the registrar requests that the appeal be so referred, or
  - (c) such a request is made by any party to the proceedings before the registrar in which the decision appealed against was made.
- (3) Before referring an appeal to the court under subsection (2), the appointed person must give the appellant and any other party to the appeal an opportunity to make representations as to whether it should be so referred.
- (4) Where, on an appeal under this section to an appointed person, the appointed person does not refer the appeal to the court—
  - (a) the appointed person must hear and determine the appeal, and
  - (b) the appointed person's decision is final.
- (5) Sections 30 and 31 (costs, evidence) apply to proceedings before an appointed person as they apply to proceedings before the registrar.

CDPA which provides for appeals on the terms of licences of right by inserting the italicized text in subsection (1) and repealing subsection (2) so that the section now reads as follows:

**"249 Appeals as to terms of licence of right.**

- (1) An appeal lies from any decision of the comptroller under section 247 or 248 (settlement of terms of licence of right) *to a person appointed under section 27A of the Registered Designs Act 1949*."

....."

Similarly, s.10 (8) IPA amends s.251 (4) by providing the option of appeals to the Appointed Person as well as appeals to the Court. After commencement, s.251 will read:

**251 References and appeals on design right matters.**

- (6) In the application of this section to England and Wales, "the court" means the High Court.

**27B Persons appointed to hear and determine appeals**

- (1) A person is not eligible for appointment under section 27A(1)(a) unless the person—
  - (a) satisfies the judicial-appointment eligibility condition on a 5-year basis,
  - (b) is an advocate or solicitor in Scotland of at least 5 years' standing,
  - (c) is a member of the Bar of Northern Ireland or solicitor of the Court of Judicature of Northern Ireland of at least 5 years' standing, or
  - (d) has held judicial office.
- (2) An appointed person must hold and vacate office in accordance with his terms of appointment, subject to subsections (3) to (5).
- (3) An appointed person is to be paid such remuneration (whether by way of salary or fees) and such allowances as the Secretary of State may with the approval of the Treasury decide.
- (4) An appointed person may resign office by notice in writing to the Lord Chancellor.
- (5) The Lord Chancellor may by notice in writing remove an appointed person ("A") from office if—
  - (a) A has become bankrupt or made an arrangement with A's creditors or, in Scotland, A's estate has been sequestrated or A has executed a trust deed for A's creditors or entered into a composition contract,
  - (b) A is incapacitated by physical or mental illness, or
  - (c) A is, in the opinion of the Lord Chancellor, otherwise unable or unfit to perform A's duties as an appointed person.
- (6) Before exercising a power under section 27A or this section, the Lord Chancellor must consult the Secretary of State.
- (7) The Lord Chancellor may remove a person from office under subsection (5) only with the concurrence of the appropriate senior judge.
- (8) The appropriate senior judge is the Lord Chief Justice of England and Wales, unless—
  - (a) the person to be removed exercises functions wholly or mainly in Scotland, in which case it is the Lord President of the Court of Session, or
  - (b) the person to be removed exercises functions wholly or mainly in Northern Ireland, in which case it is the Lord Chief Justice of Northern Ireland."

(1) In any proceedings before him under section 246 (reference of matter relating to design right), the comptroller may at any time order the whole proceedings or any question or issue (whether of fact or law) to be referred, on such terms as he may direct, to the High Court or, in Scotland, the Court of Session.

(2) The comptroller shall make such an order if the parties to the proceedings agree that he should do so.

(3) On a reference under this section the court may exercise any power available to the comptroller by virtue of this Part as respects the matter referred to it and, following its determination, may refer any matter back to the comptroller.

(4) An appeal lies from any decision of the comptroller in proceedings before him under section 246 (decisions on matters relating to design right) to-

(a) the High Court or, in Scotland, the Court of Session, or

(b) a person appointed under section 27A of the Registered Designs Act 1949.”

The advantages of appeals to the Appointed Person are that costs are awarded on the same basis as they are in proceedings before hearing officers and the decision of the Appointed Person is final.

### Examiners' Opinions

S.13 of the Patents Act 2004<sup>50</sup> inserted two new sections<sup>51</sup> into the Patents Act 1977 which enable anyone to seek an opinion from a patent examiner on the validity<sup>52</sup> of a patent or whether it has been infringed.<sup>53</sup> The service costs £200 and has been very popular.<sup>54</sup> Although the opinion does not bind the parties to a dispute and does not preclude proceedings in the courts or Intellectual Property Office it gives them an opportunity to test the strength of their cases and that may in turn assist settlement negotiations or mediation. An examiner's opinion is much cheaper than one from counsel and in sometimes more accurate as the examiner sees evidence and arguments from both sides.

S.11 (1) of the IPA inserts a new s.28A into the Registered Designs Act 1949 which enables the Secretary of State to make regulations to establish an opinions service for registered designs.<sup>55</sup> S.11 (2) IPA inserts a new s.249A into the CDPA:

<sup>50</sup> <http://www.legislation.gov.uk/ukpga/2004/16/section/13>

<sup>51</sup> S.74A and s.74B

<sup>52</sup> S.74A (1) (b) Patents Act 1977

<sup>53</sup> S.74A (1) (a) *ibid*

<sup>54</sup> <http://www.ipo.gov.uk/pro-types/pro-patent/pro-p-dispute/pro-p-opinion/pro-p-opinion-advert.htm>

<sup>55</sup> "Opinions service

### 28A Opinions on designs

### "249A Opinions service

The descriptions of designs which may be specified in regulations under subsection (1)(b) of section 28A of the Registered Designs Act 1949 (requests to the comptroller for opinions on designs) include, in particular—

(a) designs in which design right subsists in accordance with this Part, and

(b) designs in relation to which there is a question whether design right so subsists.”

We shall have to wait for the regulations to be drafted to see the matters that can be referred to the IPO for an opinion but it is difficult to see how an examiner could give an authoritative opinion on any question that turns on issues of fact.

### Conclusion

These amendments do little to simplify what Professor Hargreaves called “the patchwork of protection” in design law and it is hard to see how they can have any effect one way or the other on growth or innovation. They are not what the design lobby wanted, namely criminal sanctions for design right infringement if not the restoration of the *status quo ante*. But they are all worthy in themselves and on balance they were probably worth enacting. 😊

---

(1) The Secretary of State may by regulations make provision about the making of requests to the registrar for an opinion on specified matters relating to—

(a) designs registered under this Act;

(b) designs of such other description as may be specified.

(2) The regulations must require the registrar to give an opinion in response to a request made under the regulations, except—

(a) in specified cases or circumstances, or

(b) where for any reason the registrar considers it inappropriate in all the circumstances to do so.

(3) The regulations may provide that a request made under the regulations must be accompanied by—

(a) a fee of a specified amount;

(b) specified information.

(4) The regulations must provide that an opinion given by the registrar under the regulations is not binding for any purposes.

(5) The regulations must provide that neither the registrar nor any examiner or other officer of the Patent Office is to incur any liability by reason of or in connection with—

(a) any opinion given under the regulations, or

(b) any examination or investigation undertaken for the purpose of giving such an opinion.

(6) An opinion given by the registrar under the regulations is not to be treated as a decision of the registrar for the purposes of section 27A.

(7) But the regulations must provide for an appeal relating to an opinion given under the regulations to be made to a person appointed under section 27A; and the regulations may make further provision in relation to such appeals.

(8) The regulations may confer discretion on the registrar.

(9) Regulations under this section—

(a) may make different provision for different purposes;

(b) may include consequential, incidental, supplementary, transitional, transitory or saving provision.

(10) In this section, “specified” means specified in regulations under this section.”