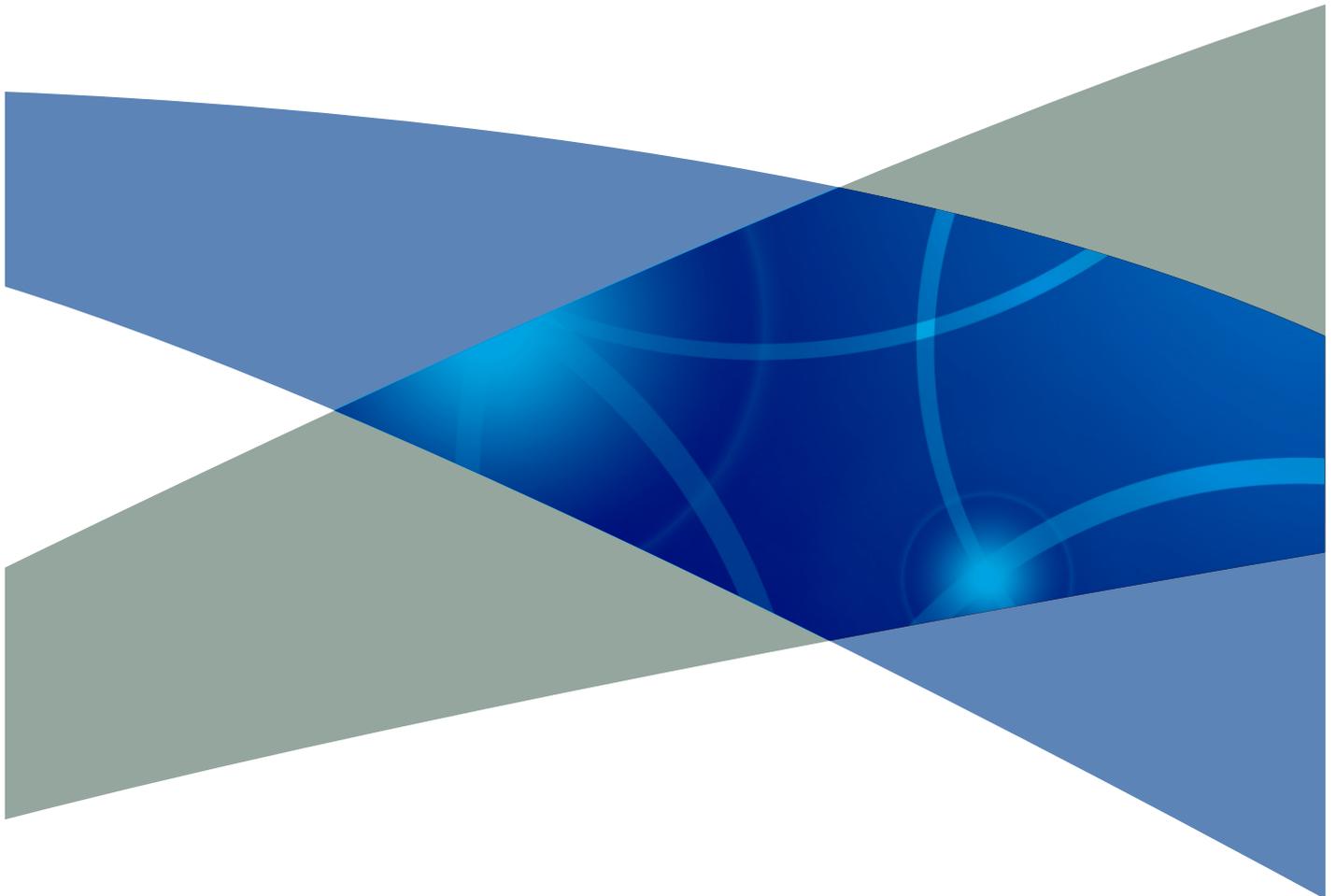




Intellectual  
Property  
Office

## Consultation:

Rules governing appeals to the Appointed  
Person against design decisions of the  
Intellectual Property Office





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## 1. Executive Summary

- 1.1 The Intellectual Property Act 2014 made changes to primary legislation, to amend the route of appeal against decisions of the Intellectual Property Office (IPO) in relation to designs. The changes, to the Registered Designs Act 1949 relating to registered designs and to the Copyright, Designs and Patents Act 1988 relating to unregistered design rights, cannot take effect until rules governing the appeals processes are in place. This consultation asks for comments on the draft rules and drafts of the associated forms.
- 1.2 Appeals relating to decisions of the IPO in relation to both registered designs (and applications) and unregistered designs will follow the same route. That is, the appellant will be able to choose between the 'Appointed Person' for a quicker, cheaper, final decision and the High Court which allows for further appeals.
- 1.3 This choice of appeal routes already exists for appeals relating to trade mark decisions of the IPO. The rules under consideration in this consultation are therefore based largely on the corresponding trade mark rules.
- 1.4 Comments are requested by **7 January 2015**.

## 2. Responding to the consultation

- 2.1 The Government welcomes responses to the issues raised in this consultation document from any individual, organisation or company. Responses to the specific questions which are raised in this document are particularly welcomed, together with any other comments you may have. It is not necessary to respond to all the questions – you are welcome to provide answers only to those issues of most interest or relevance to you.
- 2.2 While the Government will do its best to note responses that are outside the scope of this consultation, it may not be in a position to respond to those points alongside the issues we are asking about.
- 2.3 Please email your responses to: [appealsconsultation@ipo.gov.uk](mailto:appealsconsultation@ipo.gov.uk). Alternatively, please use the following postal address:

**Address:** Janette McNeill  
Trade Marks and Designs Directorate  
Intellectual Property Office  
Room 2B33, Concept House,  
Newport  
South Wales, NP10 8QQ

**Tel:** 01633 814750

Please let us have your comments by **7 January 2015**.

- 2.4 A list of organisations being sent this document is given at **Annex A**.

### 3. What happens next?

- 3.1 The IPO intends to publish a summary of responses to the consultation within three months of the closing date, and to lay the rules in Parliament in time for commencement in April 2015.

### 4. Complaints

- 4.1 If you wish to comment on the conduct of this consultation or make a complaint about the way this consultation has been conducted, please write to:

Angela Rabess  
Better Regulation Unit,  
1 Victoria Street,  
London  
SW1H 0ET

Tel: 020 7215 1661  
E-mail: [Angela.Rabess@bis.gsi.gov.uk](mailto:Angela.Rabess@bis.gsi.gov.uk)

### 5. Openness/Confidentiality

- 5.1 This is a public consultation, the results and conclusions of which may be published. As such, your response may be made public. If you do not want all or part of your response or name made public, please state this clearly in the response. Any confidentiality disclaimer that may be generated by your organisation's IT system or included as a general statement in (for example) your email response or fax cover sheet will be taken to apply only to information in your response for which confidentiality has been requested.
- 5.2 Information provided in response to this consultation, including personal information, may be subject to publication or release to other parties or to disclosure in accordance with the access to information regimes (these are primarily the Freedom of Information Act 2000 (FOIA), the Data Protection Act 1998 (DPA) and the Environmental Information Regulations 2004). If you want information, including personal data that you provide, to be treated as confidential, please be aware that, under the FOIA, there is a statutory Code of Practice with which public authorities must comply and which deals, amongst other things, with obligations of confidence.
- 5.3 In view of this it would be helpful if you could explain to us why you regard the information you have provided as confidential. If we receive a request for disclosure of the information we will take full account of your explanation, but we cannot give an assurance that confidentiality can be maintained in all circumstances. An automatic confidentiality disclaimer generated by your IT system will not, of itself, be regarded as binding on the Department.

## 6. Impact Assessment

- 6.1 During Parliamentary scrutiny of the Intellectual Property Act, an impact assessment (IA) was produced for the amendment to the route of appeal for decisions of the IPO. This IA set out our assessment of the impact this proposal will have and can be accessed alongside the other IAs relating to the legislation<sup>1</sup>.
- 6.2 Since the IA was originally produced, there have been some changes to the environment surrounding the route of appeal, notably the abolition of the Patents County Court (PCC) within the county court tribunal system, and its reinstatement as the Intellectual Property Enterprise Court (IPEC) within the High Court tribunal system. As this consultation makes clear, the proposed changes also apply to the IPO's decisions relating to unregistered designs. However, we believe these changes have very minor impact on the costs benefit assessment within the IA, do not affect the preferred option within the IA, nor do they affect the policy conclusions.
- 6.3 We do not envisage any changes to this IA being necessary following the current consultation – which is purely directed to the detail of the secondary legislation.

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<sup>1</sup> <http://services.parliament.uk/bills/2013-14/intellectualproperty/documents.html>

## 7. Background

- 7.1 As a result of the Hargreaves Review of Intellectual Property and Growth<sup>2</sup>, which was commissioned by the Prime Minister, the Intellectual Property Office (IPO) carried out a programme of work<sup>3</sup> to consider what improvements to the designs IP system might be necessary. A formal consultation<sup>4</sup> concluded that certain amendments should be made<sup>5</sup>, which were subsequently introduced by the Intellectual Property Act 2014 (IPA)<sup>6</sup>. Although many sections of the Act were brought into force on 1 October 2014<sup>7</sup>, the section relating to the route of appeal requires additional legislation before it can be fully brought into force<sup>8</sup>.
- 7.2 This consultation considers the detail of changes to the route of appeal from decisions of the IPO, as covered by section 10(2)-(11) of the IPA and which are expected to be introduced in April 2015. It should be noted that whilst this consultation refers to an appeal against decisions of the IPO, the actual reference in the relevant legislation is to the registrar (Registered Designs Act 1949) and the comptroller (Copyright, Designs and Patents Act 1988).
- 7.3 Until the changes now being consulted on are brought into force, decisions from the IPO in relation to registered designs are made to the Registered Designs Appeal Tribunal, with unregistered design decisions being appealed to the High Court.
- 7.4 Following full commencement of IPA sections 10(2)-(11) in April 2015, and implementation of the rules under discussion here, for both registered and unregistered designs the route of appeal will be to either the Appointed Person (AP) or to the High Court. It will be up to business and individual users to decide which route best suits their needs.
- An appeal to the AP is usually cheaper, with a quicker final decision, than the courts, because there are no further opportunities to appeal against the AP's decision: it is final. As this route is more informal, users are likely to be more comfortable representing themselves, rather than using legal advisors.
  - An appeal to the High Court, however, although likely to be more expensive and potentially take longer, allows for further appeals (to the Court of Appeal and ultimately to the Supreme Court). This might be used where a case is thought sufficiently important or complex to require the potential to challenge the court decisions further.

<sup>2</sup> <http://webarchive.nationalarchives.gov.uk/20140603093549/http://www.ipso.gov.uk/ipreview.htm>

<sup>3</sup> <http://webarchive.nationalarchives.gov.uk/20140603093549/http://www.ipso.gov.uk/types/hargreaves/hargreaves-designs.htm>

<sup>4</sup> <http://webarchive.nationalarchives.gov.uk/20140603093549/http://www.ipso.gov.uk/pro-policy/consult/consult-closed/consult-closed-2012/consult-2012-designs.htm>

<sup>5</sup> <http://webarchive.nationalarchives.gov.uk/20140603093549/http://www.ipso.gov.uk/response-2012-designs.pdf> - see page 26.

<sup>6</sup> <http://www.legislation.gov.uk/ukpga/2014/18/contents/enacted/data.htm>

<sup>7</sup> <http://www.legislation.gov.uk/uksi/2014/2330/contents/made>

<sup>8</sup> Section 10(2) of the IP Act was commenced to the extent necessary to enable recruitment of an Appointed Person <http://www.legislation.gov.uk/uksi/2014/1715/contents/made>.

## 8. The pre-appeal process – requesting a formal written decision from the IPO

### The general decision-making process

- 8.1 The IPO can make formal decisions on many intellectual property matters, at the request of an interested party and usually as a result of a hearing at which that party or parties present their case to a hearing officer of the IPO. In some cases, a hearing is not required – any parties involved will rely instead on documentary evidence filed with the IPO. The IPO's hearing officer will then make a formal written decision ('statement of grounds' or 'reasoned decision') based on those papers. Such statements set out the legal basis for the decision and any relevant case law<sup>9</sup>, and therefore provide a full explanation behind the decision. They are a precursor to any appeal against the IPO's decision, and provide the starting point for those appealing against that decision to set out their counterarguments. They also provide the basis of the IPO's view when the case proceeds to be heard at appeal.
- 8.2 The written statements produced by the IPO will usually be given only after the parties concerned have submitted the relevant form to initiate the IPO decision-making process, together with any supporting documentation and the relevant fee. For example, if someone wishes the comptroller to settle the terms of a licence of right on an unregistered design, the third party will file a form DRF3, the fee of £65 and supporting papers. Similarly, in relation to a trade mark opposition based only on the similarity of other registered trade marks, the opponent will file a form TM7, together with a fee of £100 and supporting documents.

### New form

- 8.3 In line with the general approach above, formal decisions relating to designs which have already been registered require both a form and fee. This is not the case for formal decisions relating to designs which are still at the application, pre-registration, stage, or in post-registration cases where an interim decision has been made. These currently require neither a form nor a fee. With this more informal procedure, the decision is usually in the form of a letter. In some cases, this is all that the applicant requires, but a more formal statement which sets out the legal basis for the decision and the case law, is a necessary precursor to an appeal. To mirror the approach taken in relation to trade marks at the pre-examination stage, the IPO proposes introducing a new form relating to applications or post-registration interim decisions. The new form will request a formal written statement of the grounds for the decision taken in relation to a design. It does not relate to unregistered designs because formal decisions relating to these designs are already triggered as a result of filing a form.

*Q1: A draft form, the DF5, is included at **Annex B**. It may also used to request a formal written decision relating to an application or in post-registration proceedings, such as invalidation, where an interim decision has been given. Please let us know if you have any comments on it.*

<sup>9</sup> For examples of written statements, see <http://www.ipo.gov.uk/pro-types/pro-design/d-decisions.htm>

## No Fee

- 8.4 The corresponding form for trade marks (TM5<sup>10</sup>) currently requires a fee of £100. Although this does not cover the costs to the IPO of the formal written statement, it nevertheless ensures that such statements are only requested by those with a likely interest in pursuing a case to appeal. The IPO currently deals with approximately 10-15 requests a year in relation to trade marks.
- 8.5 In contrast, a request for a formal written decision relating to an application for a design currently requires no fee. The IPO does not wish to place additional hurdles on those who wish to appeal, so will not charge a fee for the new form, as suggested in the information on handling incorporated in the impact assessment which accompanied the original consultation<sup>11</sup>. It seems unlikely that this will have a major impact on the IPO: for example, applications for registered designs are subject to a limited examination process, and there are therefore correspondingly few cases which proceed beyond the decision of the examiner – usually only one or two a year.
- 8.6 The current lack of appeals has meant that there is little guidance on applying the law for appellants and the IPO's design staff alike, and this situation is unlikely to change as a result of the proposals under consideration here. However, ensuring that this stage in the process retains its no fee status also maximises the likelihood of more cases being taken beyond an initial examination to provide useful precedents.
- 8.7 The IPO will nevertheless keep the level of requests for statement of grounds and the associated costs under review, as it is in no one's interest that frivolous cases are encouraged.

*Q2: If the IPO were to review this decision at a later stage, are there any circumstances in which you would consider it appropriate to charge a fee? What level of fee do you think would be appropriate?*

<sup>10</sup> <http://www.ipo.gov.uk/tm5.pdf>

<sup>11</sup> <http://webarchive.nationalarchives.gov.uk/20140603093549/http://www.ipo.gov.uk/consult-2012-designs>

## 9. The appeal process

- 9.1 Having received a formal written statement of the IPO's reasoning for its decision, the recipient is entitled to appeal against that decision. The amendments made to the Registered Designs Act 1949 (RDA), and Copyright Designs and Patents Act 1988 (CDPA) by the IPA provide that such an appeal can be submitted either to the AP, or the High Court<sup>12</sup>. This reflects the existing routes of appeal against decisions of the registrar available for trade marks.
- 9.2 Although this consultation relates only to the AP route of appeal, for completeness a brief reference to the alternative appeal route (the High Court) is included below.

### Appeals to the High Court

- 9.3 As is currently the case with any appeal which goes to the High Court, it will be up to the appellant to appeal directly to the Court, making sure the necessary papers and fees are also filed there. The IPO may wish to be represented as one of the parties before the Court in certain cases, but it has no role in administering the Court processes. The IPO's role is generally limited to requiring notification of the referral to the Court and the eventual outcome, to ensure that the necessary action is taken to implement the Court's decision.

### Appeals to the Appointed Person

- 9.4 The Appointed Person is someone with the necessary knowledge of, and experience in applying, intellectual property law, and is specifically appointed after open competition by the Lord Chancellor. Appointees are typically barristers, but may be other IP specialists such as academics or other legal advisers. The role of the AP is fulfilled by a number of individuals.
- 9.5 The current appointees have been appointed only in relation to appeals falling under the Trade Marks Act 1994 (TMA). The Lord Chancellor will therefore be seeking to make new appointments under the (amended) RDA and CDPA<sup>13</sup>. As with appointments under the TMA, the Judicial Appointments Commission will be responsible for recruitment<sup>14</sup> and Registered Patent and Trade Mark Attorneys will be eligible to apply<sup>15</sup>.
- 9.6 The IPO has two distinct but separate roles in relation to an appeal to the AP:
- As an appeal results from a decision made by the IPO, the IPO may appear before the AP to argue its case, because it is one of the parties.
  - Its main role though is administrative. The IPO liaises with the AP through the Treasury Solicitors office to ensure the smooth running of the appeal process. For example, forms relating to appeals, together with any supporting statements or evidence, are received and processed by the IPO on behalf of the AP. The IPO's role also extends to implementing the AP's decision.
- 9.7 In both cases, the IPO has no role in making the determination of a case. That is entirely a matter for the AP, who is independent of the IPO.

<sup>12</sup> RDA, s. 27A(1); CDPA, s. 249 and 251(4)

<sup>13</sup> As amended by IPA, s. 10(2)-(11). This was commenced to the extent necessary to permit appointments under The Intellectual Property Act 2014 (Commencement No.1) Order 2014 <http://www.legislation.gov.uk/ukdsi/2014/1715/contents/made>.

<sup>14</sup> See notification of recruitment launch <http://jac.judiciary.gov.uk/selection-process/3031.htm> and The Judicial Appointments and Discipline (Addition of Office) Order 2014 <http://www.legislation.gov.uk/ukdsi/2014/2040/contents/made>

<sup>15</sup> <http://www.legislation.gov.uk/ukdsi/2014/978011117590>

## 10. The current trade mark process: a template for the new design process

### Trade Mark Process

10.1 In line with the general provisions of the IP Act, which largely reflect primary legislation for trade mark appeals, the AP process will follow as closely as possible the process used in trade mark appeals. Broadly this is as follows, with the IPO forwarding relevant papers to the AP (and other involved parties) as necessary:

- On receipt of the formal written decision from the IPO, the appellant has 28 days to appeal (subject to requests for an extension of that time period).
- The request for an appeal is filed at the IPO on the relevant trade mark form together with the fee, a statement giving the reasons for the appeal, and any supporting evidence.
- If the appeal relates to a dispute between two parties, the IPO notifies the respondent, who then has 21 days to file their own response.
- The AP arranges the time/date of the hearing giving the parties 14 days notice.
- Following the hearing, the parties (and the IPO) are notified of the AP's decision.
- The decision of the AP is final, so the IPO will then take the necessary action to implement it.

10.2 It is possible that the respondent may believe that the case is better dealt with by the court. He may therefore request that this be considered by the AP. The current trade mark process in such cases is broadly as follows:

- If the respondent wishes to have the case heard by the Court, he has 28 days in which to make such a request.
- The appellant is notified of the request and then has 28 days to respond.
- The AP will notify the parties whether he considers a point of general legal importance to be involved in the case, which may indicate a court reference, and the parties then have a further 28 days to respond.

10.3 It is proposed that the same approach (with the exception of fees – see paragraphs 8.4-8.7 above) is taken in relation to appeals against *all* of the design matters for which the IPO has responsibility. These are:

- Design applications at examination stage – see RDA sections 3A and 3B
- Registered designs – see RDA sections 11-11ZE, 11A and 11AB
- Unregistered designs – see CDPA sections 246, 247 and 248.

*Q3: Do you agree that using the trade mark appeal process as a template for all appeals against the IPO's decision relating to designs is appropriate? If not, please explain why not, and indicate which appeals your comments relate to.*

## New form

10.4 In line with the approach outlined above, the IPO proposes introducing forms to request an appeal to the AP. One form will be specific to registered designs and applications for registered designs, and the other will deal with unregistered design right cases.

*Q4: Drafts of the forms, DF55 (registered) and DRF55 (unregistered), are attached at Annexes C and D, respectively. Please let us know if you have any comments on them.*

## No fee

10.5 The fee to appeal to the current appeal tribunal, the Registered Designs Appeal Tribunal (RDAT) is £6<sup>16</sup>. The AP will effectively stand in its stead as the cheaper, quicker, more informal route for appealing against the IPO's decisions, than that offered by the High Court. To ensure that this 'status' is retained, and that no further burdens are placed on businesses wishing to use this route, the IPO does not intend to charge a fee for an appeal to the AP. This is in line with the information on handling incorporated in the impact assessment which accompanied the original consultation<sup>17</sup>.

The IPO will nevertheless keep this under review.

*Q5: If the IPO were to review this decision at a later stage, are there any circumstances in which you would consider it appropriate to charge a fee? What level of fee do you think would be appropriate?*

<sup>16</sup> <http://www.legislation.gov.uk/uksi/1973/165/contents/made>

<sup>17</sup> <http://webarchive.nationalarchives.gov.uk/20140603093549/http://www.ipo.gov.uk/consult-2012-designs>

## 11. Details of the proposed design rules for the AP

11.1 The draft rules governing the appeal process are based on the corresponding rules (69-73) in the Trade Mark Rules 2008 (TMR)<sup>18</sup> and are attached at Annex E.

*Q6: Please let us know if you have any comments on the drafting of the rules. If your comments suggest a substantive departure from the current TMRs, please explain your reasoning.*

### “House Keeping”: rules 1-3

11.2 Rule 1 gives the rules their formal title and specifies when they come into effect. We are planning to introduce them at the next date of common commencement (when most law changes affecting businesses take effect), namely on 6 April 2015.

11.3 Rules 2 and 3 give the meaning of terms used within the rules, including defining “the registrar” so that this term covers titles used in both registered design law and unregistered design right law. This definition and combining that use of the relevant powers from the RDA and CDPA allows a single set of rules to cover both registered and unregistered designs in the UK.

*Q7: Does using a single set of rules to cover appeals for both registered design and unregistered design right appeals have any negative consequences? If so, please explain your reasoning.*

### Decision of the registrar: rule 4

11.4 It is necessary to take account of the introduction of the new form requesting a formal written statement of the grounds for the decision. This rule specifies that the party concerned will be able to request a formal decision, where grounds have not been given previously, and to do so, must use the relevant form (see Annex B). This form will be set out by means of directions published by the registrar. This relates to an application for a design (see paragraph 8.3 above), but may also cover interim decisions in registered design cases. The rule will also indicate that such a request must be made within a month of receiving the IPO’s informal decision.

### Decisions subject to appeal: rules 5 and 6

11.5 It is necessary to specify which decisions made by the IPO are subject to appeal to the AP, in line with the provisions of IPA section 10(2), amending the RDA, and section 10(7), amending the CDPA. Rule 5 provides that the decisions relate to:

- Applications for registered designs and modifications to those applications<sup>19</sup>
- Cancellations, invalidations and modifications of registrations<sup>20</sup>
- Orders relating to registrations dealing with the protection of public interest or merger and market investigations<sup>21</sup>
- Licences of right relating to unregistered designs<sup>22</sup>
- Subsistence, term or ownership of unregistered designs<sup>23</sup>

<sup>18</sup> <https://www.gov.uk/government/publications/trade-marks-rules>

<sup>19</sup> RDA ss. 3A and 3B

<sup>20</sup> RDA ss. 11 to 11ZE

<sup>21</sup> RDA ss. 11A and 11AB

<sup>22</sup> CDPA ss. 247 and 248

<sup>23</sup> CDPA s. 246

- 11.6 The rule does not make reference to the Designs Opinion Service<sup>24</sup>, which will be dealt with by a separate set of the rules which will be subject to consultation in 2015.
- 11.7 Rule 6 also specifies that interim decisions may be subject to appeal, but that such appeal is subject to the permission of the registrar, who acts for the IPO. In practice, this means that the registrar may have a say in the timing of an appeal against an interim decision. It does not mean that the registrar has a veto on whether an appeal should take place.

### **Appeal to the appointed person: rules 7-13**

- 11.8 Rules 7-13 set out the handling for filing the appeal, including the types of information required and the processes to be followed before the AP can make a decision. They specify that a request for an appeal has to be made within 28 days of the IPO's formal written decision, on an appropriate form (see Annexes C and D), together with the reasons why the appeal is being made (rules 7, 8 and 9). Two separate rules (7 and 8) are required to reflect the different legal regimes governing the forms: published 'directions' made by the registrar for registered designs and statutory instruments made by the Secretary of State for unregistered designs.
- 11.9 Rules 10 and 11 require the registrar to forward all the relevant material to the AP and where appropriate to any other party involved in the process.
- 11.10 Rule 11 further requires that in cases where another party is involved and wishes to respond, they have 21 days to say why they believe the original decision should be maintained. Their response should only cover grounds which are different from, or additional to, those covered in the IPO's formal written decision (rule 12). The IPO must forward this material to the AP and the party making the appeal (rule 13).

### **Determination whether appeal should be referred to court: rules 14-19**

- 11.11 As mentioned in paragraph 10.2, a case which is initially referred to the AP can instead be referred to the court<sup>25</sup>. Rules 14-19 set out the circumstances and processes involved, and gives the registrar or any of the parties involved the opportunity to ask the AP to refer the case to the court (rule 14). Where such requests are made, the rules provide that all parties receive copies (rules 15 and 16) and give them the chance to respond to the request, within 28 days (rule 17).
- 11.12 Rule 18 also allows the AP to consider a reference to the court without being asked by the other parties to do so. This only applies where the AP considers that case involves a matter of general legal importance, and he or she must give the parties, including the registrar, 28 days to respond (rule 19).

### **Hearing and determination of appeal: new rules 20-25**

- 11.13 Rules 20-22 concern the procedures about holding the appeal hearing. The AP is required to give all the parties concerned at least 14 days written notice of the time and date for the hearing (rules 20 and 21). The rules also provide that a hearing may not take place if none of the parties wish to attend and the AP may then make a decision from the papers already filed (rule 22).

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<sup>24</sup> IPA s.11

<sup>25</sup> RDA, s. 27A(2)

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- 11.14 Rules 23 and 24 ensure that the AP has the same powers in relation to hearings and how they are conducted as the registrar, by referring to other rules within the existing RDR.
- 11.15 Rule 23 refers to RDR rules 19, 22 and 23 under which the AP may, for example, require the parties to attend a case management conference, award costs or require security for costs. By also referring to RDR rule 24, rule 23 of these rules ensures that the AP has the same powers to require witnesses to attend hearings, or for the discovery of documents, as an official referee of the Supreme Court.
- 11.16 Rule 24, referring to RDR rule 20, means that hearings are public, but the AP may allow them to be heard in private under certain circumstances.
- 11.17 Finally, rule 25 ensures that copies of the AP's decision are sent to all the relevant parties, including the registrar.

## Annex A: List of individuals/organisations consulted

This consultation document has been sent to the following organisations. We will also contact other individuals who have been in direct contact with us in relation to design policy issues.

Administrative Justice and Tribunals Council  
Anti Copying in Design (ACID)  
Anti-Counterfeiting Group  
Apple  
Appointed Persons  
Association Against Intellectual Property Theft (AAIPT)  
Association of British Chambers of Commerce  
Association of the British Pharmaceutical Industry  
Association for University Research and Industry Links (AURIL)  
BBC  
British Brands Group  
British Chambers of Commerce  
British Design Innovation  
British Generics Manufacturing Association  
British Library  
British Retail Consortium  
Centre of Research for Intellectual Property & Technology (SCRIPT)  
Channel 4  
Channel 5  
Chartered Institute of Patent Attorneys  
Chartered Society of Designers  
Community Matters  
Confederation of British Industry (CBI)  
Consumer Focus  
Creative Economy  
Creators Rights Alliance  
Design Council  
Federation of Small Businesses (FSB)  
FICPI UK  
Google  
Institute of Information Scientists, Patent and Trade Mark Group  
Institute of Practitioners in Advertising  
Institute of Trade Mark Attorneys  
Intellectual Property (IP) Crime Group  
Intellectual Property Institute  
Intellectual Property Lawyers Association  
IP Federation  
Law Society of England & Wales  
Law Society of Northern Ireland  
Law Society of Scotland  
Licensing Executives Society  
London Chamber of Commerce and Industry  
Ministry of Justice  
NOKIA  
Northern Ireland Office  
Patent Judges

- : Scottish Office
- : Universities UK
- : University of Cambridge
- : University of Edinburgh
- : University of London, Queen Mary
- : Wellcome Trust
- : Welsh Office



# Annex B: Draft 'DF5' form for requesting a formal written statement of the IPO's decision relating to a design



Intellectual  
Property  
Office

## Design Form DF5 Request for a statement of reasons for registrar's decision

### No Fee

**Use this form** if you want a written statement that explains the reasons for a decision that we made in respect of a design.

**Note:** You must file this form within one month of the date we sent our decision.

<b>1. Design number</b>		
<b>2. Invalidation number</b> If the decision was made during invalidation proceedings, enter the number in the relevant field, otherwise leave blank		
<b>3. Full name</b> Person making this request		
<b>Address</b> The address must be in the United Kingdom, European Economic Area (EEA) or the Channel Islands		
	Postcode	
<b>4. Interest in the design</b> Tick one of the options	<input type="checkbox"/>	Recorded Owner or Holder of design
	<input type="checkbox"/>	Recorded Representative for Owner or Holder
	<input type="checkbox"/>	Invalidation Applicant
	<input type="checkbox"/>	Recorded Representative for the Invalidation Applicant
	<input type="checkbox"/>	Other <i>(Please specify)</i>
<b>5. Registrar's decision</b> Tick the option that applies to your Design application	<input type="checkbox"/>	Decision at the examination stage
	<input type="checkbox"/>	Decision in invalidity proceedings

<b>6. Signature</b>	
<b>Name</b> (BLOCK CAPITALS)	
<b>Date</b>	
<b>7. Your reference</b> Complete if you would like us to quote this in communications with you, otherwise leave blank.	
<b>Contact details</b> Name, daytime telephone number of the person to contact in case of query	

<b>Checklist</b> Please make sure you have remembered to: <input type="checkbox"/> Provide the design number <input type="checkbox"/> Sign the form	<b>Where to send</b> Intellectual Property Office Trade Marks and Designs Registry Concept House Cardiff Road Newport South Wales NP10 8QQ
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Rev Sept 2014 DF5

## Annex C:

# Draft 'DF55' form, to appeal against the IPO's decision relating to an application or to a registered design



Intellectual  
Property  
Office

### Design Form DF55 Notice of appeal to the appointed person

#### No Fee

**Use this form** to appeal a decision to the appointed person.

**Do not use this form for unregistered design rights.** Use form DRF 55 instead.

**You must file** this form **no later** than 28 days after the date that we sent you our decision.

<b>1. Design number</b>	
-------------------------	--

<b>2. Invalidation number</b> If the decision was made in invalidity proceedings, enter the number in the relevant field, otherwise leave blank	
--	--

<b>3. Full name</b> Person filing this request.	
--	--

#### Address

The address must be in the United Kingdom, European Economic Area (EEA) or the Channel Islands.

	Postcode

<b>4. Interest in the design</b> Tick one of the options	<input type="checkbox"/>	Recorded Owner or Holder of Design
	<input type="checkbox"/>	Recorded Representative for Owner or Holder
	<input type="checkbox"/>	Invalidation Applicant
	<input type="checkbox"/>	Recorded Representative for the Invalidation Applicant
	<input type="checkbox"/>	Other (Please specify)

**5. Type of decision**

Tick the option that applies to the hearing decision you want to appeal.

<input type="checkbox"/>	Invalidation (decision on substance)
<input type="checkbox"/>	Invalidation (procedural decision)
<input type="checkbox"/>	Examination decision
<input type="checkbox"/>	Other (Please specify)

**6. Reasons for appeal**

(Continue on separate sheets if required).

Number of continuation sheets attached

**7. Signature**

**Name**  
(BLOCK CAPITALS)

**Date**

**8. Your reference**

Complete if you would like us to quote this in communications with you, otherwise leave blank.

**Contact details**

Name, daytime telephone number of the person to contact in case of query.

**Checklist**

Please make sure you have remembered to:

- Provide the design number
- Sign the form

**Where to send**

Intellectual Property Office  
Trade Marks and  
Designs Registry  
Concept House  
Cardiff Road Newport  
South Wales  
NP10 8QQ

## Annex D:

# Draft 'DRF55' form, to appeal against the IPO's decision relating to unregistered design right



Intellectual  
Property  
Office

**Design Right Form DRF 55**  
**Notice of appeal to the appointed person**

**No Fee**

**Use this form** to appeal a decision on unregistered design right (licence of right and subsistence).  
**You must file** this form **no later** than 28 days after the date that we sent you our decision.

**1. Decision number being appealed**  
For the design being appealed.

**2. Full name**  
Person filing this request.

**Address**  
The address must be in the United Kingdom, European Economic Area (EEA) or the Channel Islands.

	Postcode

**3. Reasons for appeal**  
(Continue on separate sheets if required).

Number of continuation sheets attached

**7. Signature**

**Name**  
(BLOCK CAPITALS)

**Date**

**8. Your reference**

Complete if you would like us to quote this in communications with you, otherwise leave blank.

**Contact details**

Name, daytime telephone number of the person to contact in case of query.

**Checklist**

Please make sure you have remembered to:

Sign the form

**Where to send**

Intellectual Property Office  
Designs Registry  
Concept House  
Cardiff Road Newport  
South Wales  
NP10 8QQ

## Annex E: Draft of the Appointed Person Rules 2015

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### STATUTORY INSTRUMENTS

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**2015 No. XXXX**

### DESIGNS

#### The Appointed Person Rules 2015

<i>Made</i>	- - - -	***
<i>Laid before Parliament</i>		***
<i>Coming into force</i>	- -	***

The Secretary of State in exercise of the powers conferred by section 36 of the Registered Designs Act 1949<sup>(a)</sup> and section 250 of the Copyright, Designs and Patents Act 1988<sup>(b)</sup> makes the following Rules.

#### Citation and commencement

1. These Rules may be cited as the Appointed Person Rules 2015 and come into force on [6th April] 2015.

#### Interpretation

2. In these Rules—

“the appointed person” means a person appointed by the Lord Chancellor under section 27B of the Registered Designs Act;

“the Copyright, Designs and Patents Act” means the Copyright, Designs and Patents Act 1988;

“design right” means a design right within the meaning of Part III of the Copyright, Designs and Patents Act;

“published” means published on the Intellectual Property Office website and any amendment or modification of a form shall also be published on the Intellectual Property Office website;

“registered design” means a design registered under the Registered Designs Act;

“the Registered Designs Act” means the Registered Designs Act 1949;

“the registrar” means the Comptroller-General of Patents, Designs and Trade Marks and includes references to the comptroller under Part III of the Copyright, Designs and Patents Act;

“the Rules” means the Registered Design Rules 2006<sup>(c)</sup>.

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<sup>(a)</sup> 1949 c.88.

<sup>(b)</sup> 1988 c.48.

<sup>(c)</sup> S.I. 2006/1975.

3. In these Rules a reference to a form is a reference to that form as issued under directions under section 31A of the Registered Designs Act or section 250 of the Copyright, Designs and Patents Act.

#### **Decision of the registrar**

4. In relation to a registered design, where a party has not been given a statement of the grounds of a decision in relation to any proceedings before the registrar, any party may, within one month of the date of the decision, request the registrar on a published form to send a statement of the reasons for a decision and upon such request the registrar shall send such a statement, and the date on which that statement is sent shall be deemed to be the date of the registrar's decision for the purpose of any appeal against it.

#### **Decisions subject to appeal**

5. Under these Rules an appeal lies from any decision of the registrar made under: sections 3A, 3B, 11 to 11ZE, 11A and 11AB of the Registered Designs Act and sections 246, 247 and 248 of the Copyright, Designs and Patents Act, including a decision which terminates the proceedings as regards one of the parties or a decision awarding costs to any party ("a final decision") or a decision which is made at any point in the proceedings prior to a final decision ("an interim decision").

6. An interim decision (including a decision refusing leave to appeal under this paragraph) may only be appealed against independently of any appeal against a final decision with the leave of the registrar.

#### **Appeal to appointed person**

7. In respect of a registered design, notice of appeal to the appointed person shall be filed on a published form, which shall include the appellant's grounds of appeal and his case in support of the appeal, together with any supporting documentation.

8. In respect of the design right, notice of appeal to the appointed person shall be filed on Form DRF 55, which shall include the appellant's grounds of appeal and his case in support of the appeal, together with any supporting documentation.

9. The forms referred to in rules 7 and 8 shall be filed within the period of 28 days beginning immediately after the date of the registrar's decision which is the subject of the appeal ("the original decision").

10. The registrar shall send the notice and the statement to the appointed person.

11. Where any person other than the appellant was a party to the proceedings before the registrar in which the original decision was made ("the respondent"), the registrar shall send to the respondent a copy of the notice and the statement and the respondent may, within the period of 21 days beginning immediately after the date on which the notice and statement was sent, file a notice responding to the notice of appeal.

12. The respondent's notice shall specify any grounds on which the respondent considers the original decision should be maintained where these differ from or are additional to the grounds given by the registrar or comptroller in the original decision.

13. The registrar shall send a copy of the respondent's notice to the person appointed and a copy to the appellant.

#### **Determination whether appeal should be referred to court**

14. Within 28 days of the date on which the notice of appeal is sent to the respondent by the registrar under rule 11—

- (a) the registrar; or
- (b) any person who was a party to the proceedings in which the decision appealed against was made,

may request that the appointed person refer the appeal to the court.

**15.** Where the registrar requests that the appeal be referred to the court, the registrar shall send a copy of the request to each party to the proceedings.

**16.** A request under rule 14(b) shall be sent to the registrar following which the registrar shall send it to the appointed person and shall send a copy of the request to any other party to the proceedings.

**17.** Within 28 days of the date on which a copy of a request is sent by the registrar under rule 15 or 16, the person to whom it is sent may make representations as to whether the appeal should be referred to the court.

**18.** In any case where it appears to the appointed person that a point of general legal importance is involved in the appeal, the appointed person shall send to the registrar and to every party to the proceedings in which the decision appealed against was made, notice to that effect.

**19.** Within 28 days of the date on which a notice is sent under rule 18, the person to whom it was sent may make representations as to whether the appeal should be referred to the court.

#### **Hearing and determination of appeal**

**20.** Where the appointed person does not refer the appeal to the court, the appointed person shall send written notice of the time and place appointed for the oral hearing of the appeal—

- (a) where no person other than the appellant was a party to the proceedings in which the decision appealed against was made, to the registrar and to the appellant; and
- (b) in any other case, to the registrar and to each person who was a party to those proceedings.

**21.** The appointed person shall send the notice at least fourteen days before the time appointed for the oral hearing.

**22.** If all the persons notified under rule 20 inform the appointed person that they do not wish to make oral representations then—

- (a) the appointed person may hear and determine the case on the basis of any written representations; and
- (b) the time and place appointed for the oral hearing may be vacated.

**23.** Rules 19, 22, 23, and 24 of the Rules shall apply to the appointed person and to proceedings before the appointed person as they apply to the registrar and to proceedings before the registrar.

**24.** If there is an oral hearing of the appeal then rule 20 of the Rules shall apply to the appointed person and to proceedings before the appointed person as it applies to the registrar and to proceedings before the registrar.

**25.** A copy of the decision of the appointed person shall be sent, with a statement of the reasons for the decision, to the registrar and to each person who was a party to the appeal.

*Baroness Neville-Rolfe*

Parliamentary Under Secretary of State for Business, Innovation and Skills  
Department for Business, Innovation and Skills

Date

### **EXPLANATORY NOTE**

*(This note is not part of the Rules)*

These Rules set out the process and time period for appealing against decisions of the registrar (or comptroller in the case of the UK unregistered design right) to the appointed person. The appointed person is able to hear and determine appeals against decisions of the registrar under the Registered Designs Act 1949 (in respect of UK registered designs) and the Copyright, Designs and Patents Act 1988 (in respect of the UK design right).

These Rules do not cover appeals against decisions of the registrar under the opinions service for designs (section 28A of the Registered Designs Act 1949 and section 249A of the Copyright, Designs and Patents Act 1988).

A full impact assessment in respect of the effect that the introduction of appeals to the appointed person will have on the costs of business and the public sector was completed in preparation for the Intellectual Property Bill (now the Intellectual Property Act 2014) and is available from the Intellectual Property Office, Concept House, Cardiff Road, Newport, South Wales, NP10 8QQ and is published with the Explanatory Memorandum alongside this instrument on [www.legislation.gov.uk](http://www.legislation.gov.uk).

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Cardiff Road  
Newport  
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[www.gov.uk/ipo](http://www.gov.uk/ipo)

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