

EXPLANATORY MEMORANDUM TO
THE DESIGN (INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS)
ORDER 2017

2017 No. XXXX

1. Introduction

- 1.1 This explanatory memorandum has been prepared by the Intellectual Property Office (IPO), an Executive Agency of the Department of Business, Energy & Industrial Strategy, and is laid before Parliament by Command of Her Majesty.

2. Purpose of the instrument

- 2.1 This Instrument modifies the Registered Design Act 1949 (RDA) and the Registered Designs Rules 2006 to give effect in the United Kingdom to the provisions of the Geneva Act of the Hague Agreement¹ concerning the International Registration of Industrial Designs and the Common Regulations²
- 2.2 As a result of the UK's ratification of the Geneva Act of the Hague Agreement, UK businesses will have access to a more cost-effective and time-efficient route when seeking to register their designs internationally

3. Matters of special interest to Parliament

Matters of special interest to the Joint Committee on Statutory Instruments

- 3.1 None.

Other matters of interest to the House of Commons

- 3.2 Disregarding minor or consequential changes, the territorial application of this instrument includes Scotland and Northern Ireland

4. Legislative Context

- 4.1 The Intellectual Property Act 2014 amended the RDA to modernise the legal framework for designs and provided the necessary legislative framework for the United Kingdom to ratify the Geneva Act of the Hague Agreement.
- 4.2 This Instrument is made by the powers conferred under section 15ZA of the Registered Designs Act 1949 (RDA) and gives effect in the UK to the provisions of the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs. The Geneva Act, which was adopted on 2 July 1999 and entered into force on 23 December 2003, allows designers to obtain design protection in a number of countries through a single international registration.

5. Extent and Territorial Application

- 5.1 The extent of this instrument is England, Scotland, Wales, Northern Ireland and the Isle of Man.

¹ Geneva Act is available via: www.wipo.int/hague/en/legal_texts

² Common Regulations under the 1999 Act and 1960 Act of the Hague Agreement (as in force on January 1, 2015) http://www.wipo.int/treaties/en/text.jsp?file_id=355960

5.2 The territorial application of this Instrument is England, Scotland, Wales, Northern Ireland and the Isle of Man. References in the RDA to the United Kingdom are construed as including the Isle of Man (section 47 RDA).

6. European Convention on Human Rights

6.1 The Minister of State for Universities, Science, Research and Innovation Joseph Johnson MP has made the following statement regarding Human Rights:

In my view the provisions of the Designs (International Registration of Industrial Designs) Order 2017 are compatible with the Convention rights.

7. Policy background

What is being done and why

7.1 The Hague Agreement establishes a system for the international registration of industrial designs. The system makes it possible to obtain protection in various contracting parties (which may be States or intergovernmental organisations) by means of a single application filed at the International Bureau in the World Intellectual Property Organisation (WIPO).

7.2 Businesses in the UK have been able to access the Hague system since 2008 by virtue of the EU's membership. However, unlike some other EU Member States (Germany, Denmark, France, Hungary and Spain), the UK is not a member in an individual capacity meaning that it cannot be designated other than as part of an EU application. The decision to pursue individual ratification of the Hague Agreement was taken to support business, particularly SMEs, who may not require protection across the whole of the EU territory. National membership will give these businesses an additional option of opting to register in key territories without designating the EU. We consulted on joining the Agreement in September 2015 and there was strong stakeholder support.

7.3 The result of the EU Referendum means that it is important to join in a national capacity. If we do nothing, UK businesses will lose access to the international registration system when the UK leaves the EU.

Consolidation

7.4 This instrument modifies the RDA and the Registered Design Rules 2006 so consolidation is not appropriate.

8. Consultation outcome

8.1 A consultation exercise ran from 15 September 2015 to 10 November 2015. It sought views on the UK's proposed ratification of the Geneva Act of the Hague Agreement. Ten responses were received from a range of stakeholders including design right and IP owners, lawyers, and company and industry representatives.

8.2 Respondents expressed support for the UK joining the Hague Agreement and agreed that UK ratification would result in a greater flexibility for users.

8.3 The response to the consultation is available at <https://www.gov.uk/government/consultations/uk-accession-to-the-hague-agreement>.

9. Guidance

- 9.1 Detailed guidance about the UK ratification of the Hague Agreement, including user guidelines, will be signposted on Gov.UK and WIPO websites.

10. Impact

- 10.1 The impact on business, charities or voluntary bodies is zero net-cost. A number of these organisations are unlikely to need EU-wide design protection and smaller businesses are unlikely to be able to afford the additional expenses required to register EU rights. By providing firms with a direct route for UK protection through this international mechanism, those who wish to have designs registered across multiple countries can have a simpler, more cost effective method for managing their rights.
- 10.2 The impact on the public sector is zero net-cost.
- 10.3 An Impact Assessment was prepared at the time of the Intellectual Property Act 2014 and has not been updated since that time. The Impact Assessment is available at <http://www.legislation.gov.uk/ukpga/2014/18/impacts>.

11. Regulating small business

- 11.1 The legislation applies to activities that are undertaken by small business
- 11.2 No specific action is proposed to minimise regulatory burdens on small businesses as the approach taken has no specific negative impact on that sector.

12. Monitoring & review

- 12.1 A review clause has not been included as the Order does not make regulatory provision. However, the IPO will carry out ongoing monitoring of the impact of the instrument alongside regular contact with affected stakeholders.

13. Contact

- 13.1 Andrew Feldon at the Intellectual Property Office, Telephone: 01633 814377 or email: andrew.feldon@ipo.gov.uk can answer any queries regarding the instrument.