Law Society of Scotland

Consultation Response

IPO Transformation programme: second consultation

October 2023

Introduction

The Law Society of Scotland is the professional body for over 12,000 Scottish solicitors.

We are a regulator that sets and enforces standards for the solicitor profession which helps people in need and supports business in Scotland, the UK and overseas. We support solicitors and drive change to ensure Scotland has a strong, successful and diverse legal profession. We represent our members and wider society when speaking out on human rights and the rule of law. We also seek to influence changes to legislation and the operation of our justice system as part of our work towards a fairer and more just society.

Our Intellectual Property Law sub-committee welcomes the opportunity to consider and respond to the Intellectual Property Office consultation: IPO Transformation programme: second consultation[1].

We have the following comments to put forward for consideration.

Consultation Questions

Question 1. What is your name?

The Law Society of Scotland.

Question 2. In what capacity are you responding to this consultation?

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[1] IPO Transformation programme: second consultation - GOV.UK (www.gov.uk)

Question 3. What would be the impact of having an online inspection service for trade marks and design documents?

We have no comments.

Question 4. Should the designs provision which prevents a document from being inspected until the period of fourteen days beginning after the day it was filed at or received by the IPO has passed, be removed?

We have no comments.

Question 5. What are your views on allowing someone who is not the filer to request confidentiality of information filed at the IPO in respect of trade marks?

We are not sure when this would be necessary, perhaps, in the case that a company that was the filer, then it would allow for one of the directors to file for confidentiality of information.

Question 6. What are your views on allowing a request for confidentiality to be filed at a date later than the document was filed, in respect of trade marks?

We believe this should be acceptable. However, there is an obvious risk that the information may have already been viewed by the public and this protection may not be as effective as it would have been if this protection was implemented within the usual timeframe.

Question 7. Do you have any other views on the proposals to amend design and trade mark legislation to harmonise public availability of documents and requests for confidentiality?

We have no comments.

Question 8. Do you find series marks to be useful? Please explain why.

Series marks offer a cost-effective solution for applicants using variations on a mark as part of their branding. In jurisdictions where this is not available, applicants must either incur significant additional costs or reduce the scope of protection sought. Series marks in the UK are a useful solution.

Question 9. What are the main drivers for you or your clients when deciding to apply for a series of marks?

We have no comments.

Question 10. What are the legal and practical benefits of series marks?

We have no comments.

Question 11. What is your view on the proposal to reduce the number of marks which may constitute a series?

Please see our response at question 12.

Question 12. Do you have any views on which, a maximum of four or two marks, would be more appropriate?

While a maximum number of marks in a series is a sensible solution, we would recommend a limit to no less than four marks.

Question 13. What are the potential impacts of the UK ceasing to offer series marks?

This would be a significant detriment to UK applicants and may impact both UK focussed SMEs and the willingness for international businesses to bring products or services to the UK, given the cost involved as against the limited size of the market.

Question 14. Do you foresee any practical issues for trade mark holders with this proposed change which cannot be mitigated through the existing infringement provisions and/or existing ability to apply for multiple trade marks?

Please see our comments at question 13.

Question 15. Which of the options presented do you think the government should take forward to balance the needs of rightsholders whilst addressing the current issues faced by series marks? Please explain why.

Please see our comments at question 13.

Question 16. Are there any options not identified which you think should be considered regarding the future of series marks?

We have no comments.

Question 17. What are your views on aligning the SPC payment periods with renewal payment periods for other IP rights?

We have no comments.

Question 18. Do you prefer keeping both the standard period and the later grant period the same or would you prefer them to differ? Please explain why.

We have no comments.

Question 19. Should the IPO stop including full addresses for inventors in the patents register?

We believe the IPO should consider the interface with other international patent systems before removing information which affected parties should have access to.

Question 20. If the government were to implement this change, are you in favour of option 1 or 2 above? Please provide your reasons.

We are in favour of option 2 to ensure best compliance with data protection legislation.

Question 21. If option 2 were implemented, should patents legislation require the applicant to provide contact details for the inventor, if the IPO needs to contact the inventor? Please provide your reasons.

We believe the IPO should always be in a position to access inventor details as necessary to support the patent system in other territories.

Question 22. What do you think of:

- **the idea of a Mediation Information and Assessment Meeting (MIAM)?**

We do not see this as adding a meaningful solution to IP disputes.

- **more robust use of hearing officer powers to direct that parties attempt to mediate, and to stay proceedings?**

Parties can never be compelled to mediation against their will. To do so is to introduce uncertainty and cost in inappropriate circumstances. We believe that the IPO should avoid creating a situation where the potential actions of a hearing officer in relation to procedure may impact the outcome of a dispute other than on substantive grounds.

- **more routine awarding of costs against a party if they unreasonably fail to engage in mediation?**

Please see our comments above, and parties would be faced with incurring unnecessary cost and delay by participating in mediation activities which will not resolve a dispute in order to avoid an award of costs.

Question 23. What do you think is the optimum point (before or during proceedings) to offer mediation?

The IPO should ensure mediation is always available but should never impose it as a requirement.

Question 24. Are there particular types of proceedings where mediation should be more actively encouraged? For example where the parties are unrepresented, or concerning particular IP rights or on particular grounds?

We do not think mediation should be imposed or actively encouraged unless there is a mutual desire from the parties to engage. Many simple disputes (particularly involving the type of party likely to be unrepresented) are capable of swift, effective, and inexpensive resolution by the tribunal in circumstances where mediation would only add cost, delay, and uncertainty.

Question 25. Do you have other views in relation to mediation and resolving disputes at the IPO tribunal?

Mediation is consensual in its essence. We think the IPO should be cautious in exploring any compulsive element to its approach to mediation.

For further information, please contact:

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