



European Communities Trade Mark Association

Antwerp, 5 September 2008

Position Paper on Proposed Changes to the Locarno Classification System for Industrial Designs

Introduction

A number of proposals have been put forward by Intellectual Property Offices with the aim of improving the Locarno Classification system for designs. This paper will present our comments, as practitioners, on the advantages and disadvantages of both the current system and the proposed changes.

Background

The Locarno Classification is an international classification system for industrial designs which was established in accordance with the Locarno Agreement of 1968. The Agreement is administered by WIPO and is open to States party to the Paris Convention for the Protection of Intellectual Property. There are presently 49 States party to the Locarno Agreement and consequently they have adopted and apply the Locarno Classification to Industrial Designs in their territories. In addition, the Benelux Designs Office, OHIM and WIPO use the Locarno Classification in relation to Benelux, European Community and International designs, respectively.

At present, the Locarno Classification comprises a list of 32 classes and 223 subclasses, an alphabetical list of goods in which industrial designs are incorporated - with an indication of the classes and subclasses into which they fall, and explanatory notes. In total there are 6,831 indications of goods which have been classified and, for searching purposes, these are provided in a purely alphabetical list as well as alphabetically within each subclass.

In order to keep the Locarno Classification up to date it is revised by a Committee of Experts established under the Locarno Agreement and a new edition is published every 5 years. The present (eighth) edition of the Locarno Classification was introduced on 1st January 2004 and the next (ninth) edition is due to enter into force on 1st January 2009. The ninth edition will include some revision to the goods specified in the classes and sub-classes but will not introduce substantive changes to the Classification system itself. Possible substantive changes are currently being considered by the member States and it is these proposed changes which have prompted us to submit this paper.

Purpose of the Locarno Classification

In accordance with the Locarno Agreement, the Intellectual Property Offices of the member States are required to include in the official documents and publications relating to registered designs and their applications, the numbers of the classes and subclasses of the Locarno Classification into which the goods incorporating the design belong. Consequently, registered design searches of Official Registers can be performed based upon the class (and subclass) in which the design in question belongs. In other words, it is possible to use the Locarno Classification to search for designs by type of product. The purpose of such searching may be for novelty (e.g. to see if a design is new and possibly registrable in its own right), for validity (e.g. to see if there any prior designs which would invalidate a later registered design) or for infringement (e.g. to see if a design would infringe any existing rights if used).

It is important to remember that the Locarno Classification is solely an administrative tool and does not bind the member States with regards to the nature of protection afforded by a design so classified. Having said that, there are some States in which, due to the nature of their national laws, the indication of the product which incorporates the design (which usually corresponds to the description of those goods in the Locarno Classification) does limit the scope of protection conferred.

In many States the indication of the product incorporating the design is also used as the title of the application/registration and this is also usually searchable in the same way as the Classification codes themselves.

In addition, the Locarno Classification is used in States which permit multiple design applications to be filed, to determine whether the various designs submitted can be validly included in a multiple application (e.g. whether they all belong in the same Locarno Classification).

Benefits of the Locarno Classification

The use of the Locarno Classification as a single international classification system adopted by several Industrial Design Offices facilitates design searching in a number of different territories. It can also negate the need for re-classification when related designs are filed in more than one member State.

Moreover, as the Locarno Classification system is product-based it is relatively easy to expand it to include new products by adding new classes, sub-classes or product descriptions, as required. This can often be done without the need to re-classify existing designs. Furthermore, since design protection is limited in time, old designs will not remain in force for long and therefore product trends and commercial conflicts can be relatively easily tracked.

Limitations of the Locarno Classification

A major limitation of the current Locarno Classification is that it does not classify the appearance of the design and so it is not possible to search for a design which looks the same or similar to another design. Instead, it is only possible to search for designs by product. This is significant because, in most States, the scope of protection of a design extends to all products which have a similar appearance and not just those which are the

same type of product. Similarly, the novelty of a design is typically determined with reference to all known designs and not just to those in the same product field. Thus, it is possible that relevant designs exist in other product classes and as such they would not be identified when searching in the product class in question.

Other deficiencies of the present system include the unbalanced scope of the classes and subclasses (resulting in the overloading of certain classes/subclasses), inadequate explanatory notes in relation to the definition of certain products (especially regional products), and insufficient search tools for retrieving relevant designs.

Proposals for Improvement

Various proposals have been put forward with the aim of improving the current Locarno Classification system by supplementing the present product classes and subclasses with further subclasses denoting the visual features of the design. Some of these proposals are highly complex and include different categories of subclasses, for example, for shape, surface, ornamentation and colour, with a number of classification codes within each category. Although such a system might be capable of enabling a relatively accurate picture of the design to be formed once all of the subclasses have been decoded, it would be extremely time-consuming to use (both in terms of the person classifying the design and anyone trying to search for such a design). It would also be relatively costly to implement because its non-intuitive nature would necessitate specific training for users, particularly those classifying designs, and, even then, there would be discrepancy in how to classify certain designs since the descriptions of many visual features are subjective.

An alternative approach would be to adopt a separate classification system for visual features which could be used alongside the present Locarno Classification. Such a system could be descriptive rather than encoded and as such it would be more user-friendly. If provided with an appropriate keyword search facility to locate an accurate description of the design from a pre-determined list it would also be relatively quick to use. In this case, the bulk of the costs would be in relation to the establishment of a search tool and a system with an appropriate selection of descriptive features as opposed to training and human resource costs.

Some Practical Considerations

1. Any classification system must be usable without too much effort. It needs to be easily searchable and provide sensible results (not too many/too few). Multiple classifications add to the problem of searching. Thus we need to consider in particular the availability of and ease of use of automated search tools and the costs of using them. For instance we understand that the French office have a search tool for images which whilst not perfect functions well but the users have to pay for it (is it not freely accessible.)
2. The main purposes of the system must be kept in mind. The system is not primarily designed to define the scope of rights, it is a search tool and an administrative tool to enable fees to be collected.
3. Using the same system everywhere whatever it is would create uniformity but that means keeping it simple especially for the poorer IPOs lacking resources

4. Registered designs can be 2-dimensional or 3-dimensional and so any classification system based on visual appearance should ideally make clear which of these two options is relevant.
5. It is also noted that in some countries design protection can apply to the whole or a part of a product. However, at the time of filing a design application it is often not clear whether protection will subsist in the whole or a part of the product since this often depends upon the scope of currently unidentified prior art. Consequently, it will not be possible for an Applicant/Representative to identify the important features of the design and so any Classification system which proceeds on assumptions about the dominant feature of the design is going to be extremely subjective.

Implications of Change for Users

We need to consider in particular the typical users of the system (the public, practitioner, examiner).

1. Using a more complicated system based on **features** imposes a severe burden on searchers, increases the risk of varying classifications between offices and inconsistent classification and creates a higher risk of negligence actions. How often would this option help? Furthermore as indicated above the choice of feature is highly subjective and variable, leading to possibly very inconsistent search results.
2. In contrast using a more complicated system based on **products** can add progressively without re-classifying old designs, unlike for TMs the problem of older designs disappears with time quite quickly and helps to track commercial conflicts better and the classification is less likely to be ambiguous or variable since identification of products is typically easier than identification of features. Whilst many systems do not limit protection of a design to a particular product, as a commercial matter most conflicts arise between designs for the same or a competing product.
3. The enhanced costs of a more complicated system may well be passed on by IPO offices to the users in the form of higher fees. Private search tools should and could be developed but there is no need to impose this as a mandatory cost on users who do not wish to take advantage of more sophisticated search tools.

A Practical Solution

1. As a compromise, on the face of it improving subject matter search by product and restricting to the single dominant feature might help searching for 3D designs whilst at the same time enabling searches to limit their search to product only classes or using a sub-sub-class with floating higher classes (for example *.*12) to look for basic features.
2. An electronic searching by key word function would be highly desirable. The Vienna Classification of trade marks is used on the Marquesa database for searching designs and this is shown to work quite well by word searching. Such searching is also useful for those untrained in searching techniques and thus

represent added value to the public. Some money could usefully be spent on making databases electronically searchable.

3. If further classification by feature is required then conveniently the Vienna Classification for Figurative Marks could be used as a ready made system alongside the Locarno class to categorise at least the ornamentation of the design. This could perhaps be supplemented with further categories along the lines suggested by the Czech IPO - say, for shape (2D, 3D, geometric, complex, rigid, flexible...), texture (smooth, rough, dimpled, grooved...), materials (wood, glass, plastic, metal...) and surface features (holes, recesses, controls, handles...).
4. The uniform acceptance of the home IPO classification of a design, which is not always adopted in overseas IPOs might help to reduce varying results in each country arising from different classifications of the same design subject matter

We hope that you find our comments useful. If you have any questions in this regard or if we can assist you in any other way, please feel free to contact us.

Sincerely yours,

Simon Reeves
President

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Member of the Design Committee