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INDUSTRIAL DESIGN LAW AND PRACTICE - ANALYSIS OF THE RETURNS TO WIPO QUESTIONNAIRES

prepared by the Secretariat

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I. INTRODUCTION

1. At the fifteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from November 28 to December 2, 2005, a number of delegations expressed an interest in commencing work on the harmonization and simplification of design registration procedures. Other delegations, while agreeing on the desirability of harmonization and simplification in design registration procedures, were of the view that preparatory work was first necessary. Accordingly, the SCT requested the International Bureau to prepare a preliminary information document, which was submitted at the sixteenth session of the SCT, held in Geneva from November 13 to 17, 2006.

2. At the conclusion of the sixteenth session, the SCT agreed to an exchange of information, by way of a questionnaire relating to the formalities of industrial design registration, to be prepared by the International Bureau, with a view to promoting better understanding of the various industrial design systems which operate currently.

3. Accordingly, the Secretariat presented a draft questionnaire to the seventeenth session of the SCT, held in Geneva from May 7 to 11, 2007, which was adopted and then circulated among the members of the SCT under the title *Questionnaire on Industrial Design Law and Practice (Part I)*. In addition, a second questionnaire, on the basis of additional questions by SCT members (*Questionnaire on Industrial Design Law and Practice (Part II)* was prepared by the International Bureau, at the request of the SCT, and circulated among the members. To date, 68 members of the SCT have replied to Part I of the questionnaire and 42 members have replied to Part II.

4. The present document provides an analysis of certain areas in industrial design law and practice, based on the returns to the questionnaires.

5. The document is supplemented by an Annex, entitled *Quantitative Summary of Replies to the Questionnaires on Industrial Design Law and Practice*, which contains a table showing the number of returns to each question in the affirmative and in the negative. The purpose of the Annex is to provide a summarized, quantitative analysis of the returns to the questionnaires.

II. THE APPLICATION

(a) Contents of the Application

(i) The reproductions

6. The reproduction of an industrial design is one of the core elements of an application for registration. Certainly, the form and number of copies of the reproduction differ from one jurisdiction to another. However, the returns to the questionnaires would suggest that the extent of such differences might not be as significant as it is generally believed.

7. Two forms of reproduction, namely drawings and photographs, are almost unanimously accepted (95% of the returns accept drawings and black and white photographs, and 92% accept color photographs). Technical drawings are also widely accepted (almost 60 % of the returns).

8. On the other hand, computer-generated representations, including CAD drawings, do not appear to be largely accepted (only 7% of the returns).

9. As to the required number of copies of the reproduction, it ranges, in general, between one and three copies, as follows: 26% of the returns seem to require one copy, 24% require two, and 22% require three copies.

10. It seems to be widely agreed that the reproductions should depict a sufficient number of *views* to completely disclose the appearance of the claimed design (88% of the returns). However, in most cases (80%), the number of views is not limited. Specific *types* of view, such as front, rear, top or perspective view, are required by one quarter of the returns, but appear to be only optional in the majority of cases (for instance, 79% of the returns have declared that perspective views are optional).

11. Sectional views of an industrial design are permitted by 69% of the returns, while detailed views (enlargements) are permitted by 83%. However, sectional or detailed views do not seem to be *required* in any of the jurisdictions which replied to the questionnaires.

12. Finally, many jurisdictions[1] (72%) confirmed that dotted or broken lines may be used to represent matter that is not part of the claimed design.

(ii) Other contents of the application generally required

13. The following elements are required by a vast majority of jurisdictions:

– an indication of the product or products which constitute the industrial design or in relation to which the industrial design is to be used (94%);

– indications allowing the identity of the owner of the industrial design to be established (93%);

– indications allowing the identity of the creator to be established (76%).

(iii) Additional contents required in certain jurisdictions

– a *claim*: some laws, particularly those recognizing the notion of “patent design”, require that applications for the registration (or patenting) of an industrial design contain one or several claims. Approximately one third of the returns confirmed that they require a claim;

[1] The reference to “jurisdictions” in the present document means “jurisdictions which responded to the questionnaires.”

– the application must be *filed in the name of the creator* in one quarter of the jurisdictions;

– a *description* of the reproduction, or of the characteristic features of the industrial design, is mandatory in nearly 40% of the jurisdictions. It is generally not permitted in 15% of the jurisdictions. In all other cases (57%), it is merely optional.

(iv) Specimens

14. The possibility of submitting a specimen, sometimes in place of a reproduction of the industrial design is considered as facilitating the filing procedure, particularly in certain sectors, and is thus perceived as a positive feature of those systems which include it. The returns to the questionnaire provide a snapshot of the situation, taking into account two critical aspects, namely the number of jurisdictions which admit the submission of specimens and the actual use of specimens by applicants in those jurisdictions.

15. With respect to the first point, one third of the returns do not seem to permit, in general, the submission of design specimens. In contrast, it would appear that 38% of the returns accept the optional submission of specimens for *two* and *three-dimensional* designs, while 28% accept the optional submission of specimens for *two-dimensional* designs only. Where a specimen is admitted, it usually complements the reproduction (44% of the returns which admit specimens), as opposed to substituting it (22% of the returns which admit specimens).

16. Overall, more than 60% of the returns admit the submission of specimens, whether for two-dimensional designs only, or for both two and three-dimensional designs. It is interesting to note, however, that applicants in those jurisdictions tend to make a rather infrequent use of specimens. Out of the 40 returns which admit specimens, 31 declared that they are *rarely* submitted by applicants. According to the figures provided by 22 returns (more than half of those which admit specimens), between just 0 and 5% of applications are accompanied by a specimen.

(b) Filing Date Requirements

17. It is important that the filing date of an application for registration of an industrial design be accorded as soon as possible, since the filing date is the decisive point in time for the assessment of novelty. The filing date is also the basis for a claim of priority for subsequent applications in respect of the same design, filed by the applicant, in another jurisdiction. For this reason, a harmonized approach to the definition of filing date requirements for industrial designs would appear to be desirable, in the same way as it is provided for trademark applications in the Singapore Treaty on the Law of Trademarks and for patent applications in the Patent Law Treaty.

18. The returns to the questionnaire show that, in the vast majority of jurisdictions, there are at least four elements, or indications, which are commonly required for a filing date to be accorded. These are the following:

– a request that the registration of an industrial design is sought (98%);

– indications allowing the identity of the applicant to be established (97%);
– a sufficiently clear reproduction of the industrial design (95%);

– indications allowing the applicant or its representative, if any, to be contacted (83%).

19. Other elements which constitute a filing date requirement in just over half of jurisdictions are the following:

– a sufficiently clear indication of the product(s) which constitute the industrial design or in relation to which the industrial design is to be used (57%);

– the payment of a fee (52%).

(c) Multiple Applications and Division

20. The notion of a multiple application refers to the possibility of including several industrial designs in one application for registration. This seems to be perceived as a positive feature in a large number of jurisdictions, as evidenced by the fact that 76% of the returns allow the filing of multiple applications. Moreover, 69% of the returns which allow the filing of multiple applications declared that this facility is largely availed of by applicants.

21. It is often the case that the number of industrial designs that may be included in a multiple application is limited (over half of the returns). Nearly one quarter of the returns which impose a restriction on the number of designs in a multiple application have fixed the limit at 100 industrial designs, and a further quarter have fixed it at 50 industrial designs.

22. In addition, the industrial designs which may be included in the same application must usually share certain characteristics. The criteria which are taken into account to determine the common characteristics may vary from one jurisdiction to another. The most widespread criteria are the following:

– all the products which constitute the industrial designs should belong to the same class of the International Classification for Industrial Designs (63%);

– all the products which constitute the industrial designs should belong to the same set or composition of items (51%);

– the industrial designs should conform to a requirement of unity of design (44%).

23. Where the industrial designs in a multiple application do not meet the criteria to be included in one application, the applicant may generally divide the application. That is the case in 81% of the 42 letter returns. Moreover, in a large number of jurisdictions which allow a division (88%), there is a time limit for requesting such division (more than one third of the returns to the question concerned impose a time limit of two months).

(d) Grace Period for Disclosure

24. Article 25(1) of the TRIPS Agreement stipulates that "Members shall provide for the protection of independently created industrial designs that are new or original." The returns to the questionnaire reveal that the requirement of novelty is included in almost all jurisdictions (95% of the returns to Part II of the questionnaire declared that registration of an industrial design may be invalidated on the ground that the design is not new).

25. At the same time, many jurisdictions are of the view that it is important to give a creator the possibility of testing the market for the design or the products which incorporate the design, before deciding whether it is worth applying for the registration of the design (86% of the returns). To that end, those jurisdictions allow the disclosure of the industrial design within a given period of time before the date of filing, without affecting the requirement of novelty.

26. The period of time, known as the "grace period," may vary from one jurisdiction to another. The most commonly accepted grace periods are 12 months (60% of the returns) and 6 months (33%).

27. As to the persons who may disclose the industrial design within the grace period, most jurisdictions admit that a disclosure made by the creator, or a person authorized by her or him, does not affect the novelty of the industrial design (88% of the returns). Many jurisdictions also allow that a disclosure made by an unauthorized person, in bad faith or unintentionally, does not affect novelty (60% of the returns).

III. EXAMINATION

(a) Overview

28. Offices may examine industrial design applications only for compliance with formal requirements (42% of the returns), or for both formal and substantive requirements (56%).

(b) Contents of Formal Examination

29. Nearly all Offices examine whether the application provides, indicates, or is accompanied by:

- the contact details of the applicant or his representative (99%);
- the identity of the applicant (97%);
- a reproduction of the industrial design (97%);
- the required fee (97%);
- a request that the registration of an industrial design is sought (96%).

30. The majority of Offices also examine as to whether the application indicates, contains, or complies with:

– an address for service (88%);

– a correct indication of the product or products to which the industrial design is to be applied (86%);

– the requirements that apply to a multiple design application (79%);

– the requirement concerning the design creator (73);

– the required number of reproductions (69%);

– the number of views for the industrial design to be fully disclosed (61%).

(c) Contents of Substantive Examination

31. The vast majority of Offices examine as to whether the industrial design for which registration is sought:

– is contrary to morality or public order (83%);

– fulfils the notion of “design” established by the relevant legal framework (81%).

32. Over half of the Offices who responded indicated that they also examine as to whether the industrial design for which registration is sought:

– conflicts with official signs or emblems protected under Article 6*ter* of the Paris Convention (68%);

– is new (54%);

– differs significantly from known designs (52%).

(d) Timing of Substantive Examination

33. 74% of the Offices which carry out a substantive examination appear to conduct it *ex officio*. Substantive examination is carried out following opposition by a third party in over one third of the Offices, and following an invalidation action in another third. In some jurisdictions (16%), substantive examination is carried out *ex officio* and also following opposition.

34. Substantive examination is carried out *before* registration of the industrial design in 68% of the Offices, as opposed to 22% which conduct it *after* registration.

IV. OPPOSITION

(a) Overview

35. In reply to the question as to the existence of an opposition procedure, it appears that at least 58% of the Offices have either a pre or a post-registration opposition procedure, as opposed to 35% which do not have any.

(b) Pre-Registration or Post-Registration Procedure

36. Just over one quarter of the returns indicated that there is a pre-registration procedure in their jurisdiction, while approximately one third indicated that they operate a post-registration procedure.

(c) Period of Opposition

37. It follows from the responses obtained that the two most widespread opposition periods are two months (one third of the Offices which operate an opposition procedure) and three months (27%). A smaller number of returns indicate that there is an opposition period of one month (14%) and of six months (11%).

(d) Grounds for Opposition

38. The returns to the questionnaire reveal that in an opposition, the opponent may invoke in general that

– the design is not new (76%);

– the design does not differ significantly from known designs (70%);

– the design does not fulfill the notion of “design” under the applicable law (67%);

– the design conflicts with official signs or emblems protected under Article 6*ter* of the Paris Convention (65%).

39. The returns also reveal that the opponent may also base an opposition, in general, on a conflict with

– a prior industrial design (75%);

– a prior trademark (69%);

– copyright in a literary or artistic work (68%).

V. PUBLICATION AND DEFERMENT

(a) Timing of Publication

40. The returns to the questionnaire indicate that 61% of the Offices publish the industrial design for the first time after registration, which results in a *de facto* deferment of publication in those jurisdictions. Approximately one third of the Offices publish it for the first time after the examination by the Office, and 20% publish it for the first time before the examination by the Office.

(b) Mode of Publication

41. The returns further indicate that 69% of the Offices publish the industrial design in a paper gazette and 31% publish *only* on paper.

42. On the other hand, 67% of the Offices publish on the website of the Office and 23% publish *only* on the website.

43. Finally, 38% of the Offices publish on compact disk or DVD. Just 3% publish *only* in that mode.

(c) Deferment

44. It is interesting to note that there is almost a balance between those jurisdictions which allow deferment of publication (49%) and those which do not (42%). Among those which include the possibility of deferment in their legislation, just under half have a period of deferment of more than 12 months, 38% have a period of 12 months, and 14% have a period of 6 months or less. The latter figure is probably due to the fact that, in most jurisdictions, there is a *de facto* deferment of publication, as most jurisdictions publish the industrial design for the first time after registration or after the examination by the Office (see paragraph 40, above). There would therefore seem to be little interest in those jurisdictions in providing for a period of deferment of publication of 6 months or less.

45. As to the use which applicants make of the possibility of requesting deferment of publication, out of the 32 jurisdictions which recognize that possibility in their legislation, only 5 (16%) declared that deferment is requested largely. It is interesting to note that the possibility of deferment is much used in the Scandinavian countries (85% of designs are subject to deferment in Finland, 70% in Norway, and 50% in Sweden).

VI. TERM OF PROTECTION AND RENEWAL

(a) Term of Protection

46. Under half of the returns indicated that the maximum term of protection for a registered industrial design is 25 years. One third indicated that the maximum term of protection is 15 years. Finally, a small number (12%) declared that it is 10 years.

47. The majority of jurisdictions (69%) afford an initial term of protection of 5 years, which may be renewed for additional terms of five years.

(b) Rate of Renewal

48. The rate of renewal depends greatly on whether it is a first or a subsequent renewal, as evidenced by those returns that gave figures for different periods of protection. According to the figures given by 41% of the returns, between 30 and 60% of registered designs are renewed once, at least. In certain jurisdictions (one third), the rate of first renewal is of more than 60% of registered designs.

VII. COMMUNICATION WITH THE OFFICE

(a) Types of Communication

49. Paper communications, including applications, are accepted by all the jurisdictions which replied to the questionnaire. Most Offices accept communications filed by electronic means of transmittal, such as fax (68% of the returns). Communications filed by other electronic form, for instance, via the Internet, are accepted by 40% of the returns. However, as regards the filing of design applications, only one third of the returns accept electronic form (e-filing).

(b) Signature Requirements

50. A communication on paper must be signed by the applicant, holder or other interested person in the vast majority of jurisdictions (94%), but it is seldom that the signature must be certified (13%). In the case of surrender, certification is required in over one third of the jurisdictions.

(c) Electronic Communications

51. In one half of the returns which accept the filing of communications by electronic form (40% of all the returns), communications filed electronically may be authenticated through a system of electronic authentication.

52. As regards the e-filing of applications, it is interesting to note that in 44% of the jurisdictions which accept e-filing, that facility does not impose any limit to the total number of designs which may be included in the application, while there is a limit in 28% of such jurisdictions. With respect to the format of the reproductions in an application filed in electronic form, most jurisdictions accept JPEG format (72% of the returns which accept e-filing). Other accepted formats are pdf (28%) and tiff (22%).

(d) Relief Measures

53. The majority of the returns (84%) declared that at least one type of the relief measures presented as an option in the questionnaire is available in case of failure to comply with a time limit before the Office. The questionnaire enquired about the availability of one or more of the following relief options: extension of the time limit concerned, continued processing and reinstatement of rights.

54. An extension of the time limit concerned is available in 81% of the jurisdictions. In 60% of the jurisdictions, that measure exists together with another relief measure, whether continued processing or reinstatement of rights.

55. The effect of continued processing is that the Office will continue with the procedure concerned as if the time limit had been complied with. The omitted act must then be completed within the time period available for filing a request for continued processing, without it being necessary for the person making the request to state the reasons for the failure to comply with the time limit. Continued processing is available as far as 40% of the returns are concerned.

56. Reinstatement of rights is subject to a finding by the Office that the failure occurred in spite of due care required by the circumstances or that the failure was unintentional. The request for reinstatement of rights should usually state the reasons for the failure to comply with a time limit. Reinstatement of rights is available in 49% of the returns.

VIII. CONCLUSION

57. The returns to the questionnaires have provided a broad overview of the different industrial design systems and procedures currently operating, and constitute a basis for any future work aiming at a process of convergence in the field of industrial designs.

58. It is particularly interesting to note that, while differences clearly exist in several fields relating to the law and practice of industrial designs, there are nonetheless several areas in which there is convergence, to a greater or lesser extent. Aspects such as design reproductions and other contents of the application, the filing date requirements, multiple applications and the grace period for disclosure, do present similarities between many jurisdictions surveyed.

59. In addition, the returns reveal two other areas, which are particular to the field of industrial designs that could benefit from further discussion within the SCT, namely the filing of specimens and deferment of publication. Although the returns of the questionnaires indicate great divergence in those areas in the different jurisdictions, they also demonstrate that the use of those facilities might not be as large as generally believed. A discussion as to the future of those features, bearing in mind the existence of other available schemes, such as the unregistered design system, might therefore be of interest.

60. The SCT is invited to consider the contents of the present document, as well as to

i) indicate possible areas of convergence covered by the present document in which it wishes to pursue work, and

ii) identify any other possible area of convergence to which it would like to extend such work.

[Annex follows]