

# WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
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## STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

**Eighteenth Session**  
**Geneva, November 12 to 16, 2007**

### QUESTIONNAIRE ON INDUSTRIAL DESIGN LAW AND PRACTICE (PART II)

*prepared by the Secretariat*

#### INTRODUCTION

1. At the seventeenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from May 7 to 11, 2007, the SCT requested the Secretariat to develop, in addition to the Questionnaire on Industrial Design Law and Practice (Part I), a second questionnaire on the basis of additional questions by SCT Members (see document SCT/17/8, paragraph 432). Accordingly, the Secretariat prepared a draft questionnaire on design law and practice (part II) (document SCT/18/8) and presented it to the 18<sup>th</sup> session of the SCT for comments. The Annex to the present document contains Part II of the Questionnaire on Industrial Design Law and Practice as agreed by the SCT at its 18<sup>th</sup> session. An electronic version of this questionnaire is available at [www.wipo.int/sct/en/meetings](http://www.wipo.int/sct/en/meetings).
2. The completed questionnaire should reach WIPO by January 31, 2008, at the latest, by e-mail to [sct.forum@wipo.int](mailto:sct.forum@wipo.int), by facsimile to +41 22 338 87 45 or by surface mail to the World Intellectual Property Organization (WIPO), 34 chemin des Colombettes, 1211 Geneva 20, Switzerland.

[Annex follows]

ANNEX

QUESTIONNAIRE ON  
INDUSTRIAL DESIGN LAW AND PRACTICE (PART II)

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## I. SUBJECT MATTER OF INDUSTRIAL DESIGN

Q1: The following subject matter may be protected as an industrial design:

- |   |   |
|---|---|
| – a typeface  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a mere word or sequence of letters without a particular styling                           | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – colors  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – color per se  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a graphic symbol, such as a drawing, picture or logo                                      | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – ornamentation, such as figurative elements and patterns                                   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – product packaging   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – product shape   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – get-up and trade dress  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a specific texture or material  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a graphical user interface  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – an architectural structure  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – an architectural plan as such   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – the interior of a room, shop, vehicle, etc.   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – the appearance of a product of variable form, such as a fountain or an inflatable balloon | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – labels  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – holograms   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a cartoon character   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – an animated icon  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a layout-design of integrated circuits  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – spare parts   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – other   | _____   |

Q2: A part of a product which can be separated from the product may constitute an industrial design. yes  no  n/a

Q3: A part of a product which cannot be separated from the product may constitute an industrial design. yes  no  n/a

## II. INDUSTRIAL DESIGN APPLICATION

(a) Division of a Multiple Design Application

Q4: Where the industrial designs in a multiple design application do not meet the necessary requirement to be included in a single application, the applicant may divide the application. yes  no  n/a

Q5: If yes, division should take place within a given time limit. yes  no  n/a

If yes, please specify the time limit: \_\_\_\_\_

(b) Allowed Disclosure Before Application

Q6: A disclosure of the industrial design within a given period of time before the date of filing, or the priority date of the application (grace period), is allowed, without affecting the requirement of novelty of the industrial design. yes  no  n/a

If yes, please specify the period of time: \_\_\_\_\_

Q7: A “grace period” is available for disclosure made by:

- the creator yes  no  n/a
- a person authorized by the creator yes  no  n/a
- an unauthorized person (in bad faith or unintentionally) yes  no  n/a
- other \_\_\_\_\_

Q8: A disclosure of the industrial design does not affect the novelty of the industrial design if it was made at:

- an official or officially recognized international exhibition yes  no  n/a
- an official or officially recognized national exhibition yes  no  n/a
- other \_\_\_\_\_

(c) Changes to Industrial Design After Application

Q9: Amendments to the industrial design after the application has been filed are allowed. yes  no  n/a

If yes, please specify the circumstances under which the amendments are allowed:

- under all circumstances yes  no  n/a
- only where the changes relate to non-essential features of the industrial design yes  no  n/a
- other \_\_\_\_\_

Q10: Where the amendments to the industrial design after the application has been filed exceed the scope of the original application, the application is considered to be filed on the date of the amendments. yes  no  n/a

If yes, the Office informs the applicant of that fact. yes  no  n/a



Q19: If the grounds for refusal are not overcome by the applicant, the Office notifies a final decision of refusal. yes  no  n/a

(b) Time Lapse for First Office Action

Q20: On average, the period of time between the date of filing an industrial design application and the date of issue of a first office action is \_\_\_\_\_

#### IV. DURATION AND SCOPE OF PROTECTION

(a) Commencement of Period of Protection

Q21: According to the applicable law, the registration of an industrial design is effected for a period of time which starts to run from:

- the date of filing of the application yes  no  n/a
- the date of registration of the industrial design yes  no  n/a
- the date of publication of the industrial design yes  no  n/a
- other \_\_\_\_\_

(b) Scope of Protection

Q22: The scope of protection afforded by a right in an industrial design is determined on the basis of:

- the reproduction only yes  no  n/a
- the reproduction and claims yes  no  n/a
- the reproduction and a description of the characteristic features yes  no  n/a
- other \_\_\_\_\_

Q23: Where an infringement action on the basis of a registered industrial design is lodged before a Court of law, the plaintiff *may* submit a formal search report on prior known designs which are relevant to such registered industrial design, or a technical opinion as to the registrability of that industrial design, prepared by the Registry/Industrial Property Office or any other relevant authority. yes  no  n/a

Q24: Where an infringement action on the basis of a registered industrial design is lodged before a Court of law, the plaintiff *must* submit a formal search report on prior known designs which are relevant to such registered industrial design, or a technical opinion as to the registrability of that industrial design, prepared by the Registry/Industrial Property Office or any other relevant authority. yes  no  n/a

Q25: The formal report or technical opinion mentioned in Q23 and Q24 may be submitted to authorities other than a Court of law (for example, at the Customs). yes  no  n/a





Q32: If yes, the following disputes may be referred to an alternative dispute-settlement mechanism:

- |  |   |
|--|---|
| – those concerning the validity of an industrial design            | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – those concerning an alleged infringement of an industrial design | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – other  | _____   |

## VII. INVALIDATION PROCEEDINGS

### (a) Possible Grounds

Q 33: A registration of an industrial design may be invalidated on the grounds that the design:

- |  |   |
|--|---|
| – does not fulfill the notion of “design” established by the legal framework | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – is not new   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – is not original  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – does not have individual character   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – is dictated solely by technical or functional considerations               | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – is dictated partly by technical or functional considerations               | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – is contrary to morality or public order                                    | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – is in conflict with an earlier right                                       | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – was not filed by the creator or an authorized person                       | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – other  | _____   |

### (b) Competent Authority

Q34: A registration of an industrial design may be declared invalid by the following authority:

- |                               |   |
|-------------------------------|---|
| – the Registrar               | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – another Administrative Body | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a Court                     | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – other                       | _____   |

## VIII. RELATION WITH TRADEMARKS

### (a) Subject Matter Enjoying Co-existing Protection

Q35: According to the applicable law, the following subject matter may enjoy co-existing protection as a trademark and an industrial design:

- |   |   |
|---|---|
| – a typeface  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a mere word or sequence of letters without a particular styling                           | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – colors  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – color per se  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a graphic symbol, such as a drawing, picture or logo                                      | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – ornamentation, such as figurative elements and patterns                                   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – product packaging   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – product shape   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – get-up and trade dress  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a specific texture or material  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a graphical user interface  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – an architectural structure  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – an architectural plan as such   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – the interior of a room, shop, vehicle, etc.   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – the appearance of a product of variable form, such as a fountain or an inflatable balloon | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – labels  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – holograms   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a cartoon character   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – an animated icon  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – a layout-design of integrated circuits  | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – spare parts   | yes <input type="checkbox"/> no <input type="checkbox"/> n/a <input type="checkbox"/> |
| – other   | _____   |

Q36: A protected industrial design may acquire distinctiveness in the sense of trademark law during the period of industrial design protection. yes  no  n/a

### (b) Subject Matter Dictated Essentially by Technical or Functional Considerations

Q37: According to the applicable law, subject matter that is dictated essentially by technical or functional considerations is excluded from:

- protection as a trademark yes  no  n/a

If yes, such exclusion is limited to three-dimensional subject matter. yes  no  n/a

Q38: According to the applicable law, subject matter that is dictated essentially by technical or functional considerations is excluded from:

- protection as an industrial design yes  no  n/a

If yes, such exclusion is limited to three-dimensional subject matter. yes  no  n/a

(c) Enforcement of Cumulative Rights

Q39: In case of subject matter enjoying cumulative protection, trademark and industrial design rights can be invoked in parallel before the courts:

- without having to satisfy any specific requirements yes  no  n/a
- only if the interested party shows a distinct legitimate interest with regard to each of the two protection regimes yes  no  n/a
- other \_\_\_\_\_

IX. RELATION WITH COPYRIGHT

Q40: Subject matter which is protected under industrial design law:

- is protected at the same time under copyright law (cumulative protection) yes  no  n/a
- cannot be protected under copyright law yes  no  n/a
- may be protected under copyright law under certain conditions only yes  no  n/a
- may be alternatively protected under copyright law yes  no  n/a
- other \_\_\_\_\_

Q41: Where the subject matter which is protected under industrial design law may be protected under copyright law under certain conditions only, those conditions are the following:

- that the subject matter can be identified *separately* from, and exist *independently* of, the functional aspect of the product yes  no  n/a
- that the subject matter presents a *high* or *marked* artistic character yes  no  n/a
- other \_\_\_\_\_

Q42: In case of subject matter enjoying co-existing protection, copyright and industrial design rights can be invoked in parallel before the courts:

- without having to satisfy any specific requirements yes  no  n/a
- only if the interested party shows a distinct legitimate interest with regard to each of the two protection regimes yes  no  n/a
- other \_\_\_\_\_

X. RELATION WITH UNFAIR COMPETITION LAW

Q43: Subject matter which is protected under industrial design law:

- is protected at the same time under unfair competition law (cumulative protection)      yes  no  n/a
- cannot be protected under unfair competition law      yes  no  n/a
- may be protected under unfair competition law under certain conditions only      yes  no  n/a
- other      \_\_\_\_\_

Q44: Where the subject matter which is protected under industrial design law may be protected under unfair competition law under certain conditions only, those conditions are the following:

- that there is a *distinct* act of unfair competition, which can be identified *separately* from an act of infringement of the industrial design      yes  no  n/a
- other      \_\_\_\_\_

Q45: Actions based on unfair competition law and on industrial design law can be lodged in parallel before the courts:

- without having to satisfy any specific requirements      yes  no  n/a
- only if the interested party shows a distinct legitimate interest with regard to each of the two protection regimes      yes  no  n/a
- other      \_\_\_\_\_

XI. SYSTEM UNDER WHICH REPLIES TO QUESTIONNAIRE HAVE BEEN PROVIDED

Q46: The replies to the present questionnaire have been provided under the following legislation: \_\_\_\_\_

Q47: According to the applicable law, protection for industrial designs is provided also under:

- design patent legislation      yes  no  n/a
- registered industrial design legislation      yes  no  n/a
- unregistered industrial design legislation      yes  no  n/a
- copyright legislation      yes  no  n/a
- protection against unfair competition legislation      yes  no  n/a
- other      \_\_\_\_\_

XII. PUBLICATION OF THE QUESTIONNAIRE

Q48: Returns to this questionnaire may be published  
on the WIPO website

yes  no

[End of Annex and of document]