
USER ASSOCIATION QUESTIONNAIRE ON DESIGN TOPICS

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Basic Data

Please indicate the User Association that you represent:
International Trademark Association (INTA)
Please indicate your name and email address (in case clarification is needed regarding any of your answers):
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Criteria for assessing disclosure of designs on the internet

1. Do you think that the practices of the EU IP Offices regarding the criteria for assessing disclosure of designs on the internet are harmonised?
No [A2]

1.a. Please elaborate on your answer to question 1:
<p>The Court of Justice has been clear in its case law - a disclosure will be a relevant disclosure for invalidity purposes unless it is truly obscure (Case C-478/12). Thus, most Internet disclosures will be relevant disclosures for the purposes of invalidity. The exclusion is clearly intended to be a narrow one: see Green Lane Products v PMS [2008] EWCA Civ 358 at para 68.</p> <p>Both the EUIPO and national offices have been inconsistent in applying the test as set out in the Regulation and clarified by the Court of Justice. INTA Designs Committee believes that EUIPO and national offices should be encouraged to apply strictly and more consistently the Regulation/ Directive and the case law of the Court of Justice. This would increase harmonization and legal certainty. This may be an appropriate issue for further training and capacity building, but it is not in our view an appropriate convergence project.</p> <p>Where there is potentially some prospect of convergence is the evidentiary requirements for proving disclosure. For example, the EUIPO has acknowledged the reliability of the Wayback Machine (at www.archive.org): Case ICD 3184, Case ICD 8468. Having that acknowledged across national offices as well would assist users of the system.</p>

1.b. What (if any) are the problems that you face as a result of divergence among the practices of the EU IP Offices regarding the criteria for assessing disclosure of designs on the internet?
[Different formats for providing the screenshot of the webpage]

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[Differences in the consideration of the 'accessibility' of the webpage]
Yes [Y]

1.b. What (if any) are the problems that you face as a result of divergence among the practices of the EU IP Offices regarding the criteria for assessing disclosure of designs on the internet?
[Differences in the criteria for assessing disclosure]
Yes [Y]

1.b. What (if any) are the problems that you face as a result of divergence among the practices of the EU IP Offices regarding the criteria for assessing disclosure of designs on the internet?

[Differences in establishing a reliable date of disclosure on the internet]

1.b. What (if any) are the problems that you face as a result of divergence among the practices of the EU IP Offices regarding the criteria for assessing disclosure of designs on the internet?

[Other]

2. Do you think that agreeing on a Common Practice among the EU IP Offices regarding the criteria for assessing disclosure of designs on the internet would be beneficial for the users?

No [A2]

3. Please justify your answer to question 2:

INTA considers that the convergence projects are an excellent way of harmonizing office practice as between the EUIPO and the national offices. However, INTA does not consider that the convergence projects are the best way of clarifying the law, in circumstances where the law is unclear. That is a matter for Community Design Courts and the Court of Justice. Therefore, any attempt to harmonize the legal analysis of disclosure should be left to the courts.

Moreover, there is little chance that many national offices will have the resources to contribute to the issue as most of them do not assess prior disclosures. Indeed, the issue of disclosure of prior designs arises only in relation to design invalidity. This is examined ex officio by a few offices, but not most (and not by the EUIPO). Further, a few offices provide for design invalidity actions to be heard before the office (including the EUIPO) - but many offices do not. INTA Designs Committee considers that convergence projects that involve the EUIPO and all national offices are to be preferred. INTA supports education and capacity building on this topic, but not a convergence project.

4. Do you foresee any difficulties that could arise during discussions to reach a Common Practice regarding the criteria for assessing disclosure of designs on the internet?

Yes. Please see above.

5. Please provide us with any other comments that you find relevant for the analysis of this topic:

Classification of ornamentation and its product indication

6. Do you think that the practices of the EU IP Offices regarding the product indications used for ornamentation are harmonised?

No [A2]

6.a. Please elaborate on your answer to question 6:

Users of the system benefit when a system is efficient and predictable. Hence, a designer (especially an individual designer or an SME) filing a design in multiple EU Member States would expect administrative matters like the product indication not to differ. A refusal or other administrative act on the basis of the product indication is inefficient for the designer, as steps have to be taken and time spent dealing with the refusal or other administrative action.

Therefore, INTA Designs Committee advocates for consistent and predictable practices on product indication between the EUIPO and Member States.

6.b. What (if any) are the problems that you face as a result of divergence among the practices of the EU IP Offices regarding the product indications used for ornamentation?

Please see above.

7. Do you think that agreeing on a Common Practice among the EU IP Offices regarding the product indications used for ornamentation would be beneficial for the users?

Yes [A1]

8. Please justify your answer to question 7:

9. Do you foresee any difficulties that could arise during discussions to reach a Common Practice regarding the product indications used for ornamentation?

We do not see any immediate difficulties. We would ask that users be actively involved in the process, as previously for the convergence projects, to ensure that the harmonized position meets the needs of users.

10. Please provide us with any other comments that you find relevant for the analysis of this topic:

Criteria of protection for a set of articles

11. Do you think that the practices of the EU IP Offices regarding sets of articles are harmonised?

No [A2]

11.a. Please elaborate on your answer to question 11:

The notion of "sets" does not appear in the Regulation, Implementing Regulation or Directive. It is therefore a creation of the EUIPO Guidelines, which allows a set to be filed "if the articles making up this set are linked by aesthetic and functional complementarity and are, in normal circumstance, sold altogether as one single product, like a chess board and its pieces or sets of knives, forks and spoons". The Office requires that at least one view must show the set of articles together.

Sets also appear in the Locarno classification, and are allowed specifically in the design law of non-EU countries (see for example the recent reforms in Singapore).

The Board of Appeal has not been so kind to sets, ruling in Case R 1258/2008-3 that the armchair, two-seat sofa and three-seat sofa depicted in RCD 512074-0001 was not a set.

Similar, a "set" of cans was invalidated by the Board of Appeal in Case R 1408/2012-3, but the Board of Appeal did acknowledge that a set was protectable.

Practices differ in Member States, and are not particularly clear at the EUIPO.

This is something that may require clarification by the Court of Justice in due course - the Regulation and Directive only provide design protection for "a product or part of a product". Product is defined as "any industrial or handicraft item" - noticeably in the singular. Is a set of table wear an "item" when the plates etc. can be purchased separately? Is time of purchase really something that should come into design law at all, given that it is to protect designers, rather than consumers? It may be that in due course the Court of Justice rules that a set is not a product, hence invalidating all designs for sets. A cautious approach is therefore essential.

Where convergence may be appropriate is on how to depict a set. For example, it would be possible to harmonize the requirement that the first view contains the whole set (it is suggested that it is the first view, as that is the view that usually shows up on web portals and the like).

It is not possible to attempt to harmonize through convergence what level of protection is provided by a registered design for a set - this is a matter for Community Design Courts and the Court of Justice. For example, the Bundesgerichtshof has held that an infringing design should be compared against the whole set - not part of it - which is unlikely to be the understanding of many designers filing for designs for sets: Case I ZR 124/10.

Taking the above into account, INTA Designs Committee supports a convergence project on sets because it will help to raise the visibility of this particular form of protection, to educate designers about what rights they obtain for a set and whether there may be more appropriate filing options for broader protection (for example, filing the articles in the set separately).

11.b. What (if any) are the problems that you face as a result of divergence among the practices of the EU IP Offices regarding sets of articles?

Please see above.

12. Do you think that agreeing on a Common Practice among the EU IP Offices regarding sets of articles would be beneficial for the users?

Yes [A1]

13. Please justify your answer to question 12:

Please see above.

14. Do you foresee any difficulties that could arise during discussions to reach a Common Practice regarding sets of articles?

Yes. It is important that the convergence process avoids attempting to describe the scope of protection provided by a set registration - this is a matter for the courts. However, converged practice on how to file for a set is to be encouraged. INTA Designs Committee also supports the educative possibilities of a convergence project in this area.

15. Please provide us with any other comments that you find relevant for the analysis of this topic:

Assessment of the degree of freedom of the designer

16. Do you think that the practices of the EU IP Offices regarding the assessment of the degree of freedom of the designer are harmonised?

No [2]

16.a. Please elaborate on your answer to question 16:

INTA Designs Committee does not consider this to be an appropriate topic for a convergence program. Whilst we realize that practice differ between the EUIPO and the national offices, the law about freedom of the designer seems reasonably clear, and the issue lies with the application of the law. Where the law is not clear, clarity should be provided by Community Design Courts and the Court of Justice.

These are not issues that can be agreed by convergence, for the same reason that convergence is inappropriate to agree who the informed user is, for example.

Further, as set out above, many national offices do not currently have to assess design freedom, so this convergence project will be of less interest to them. INTA Designs Committee advocates that convergence projects are best in areas that involve all national offices and the EUIPO.

INTA Designs Committee favors education and capacity building on this topic.

16.b. What (if any) are the problems that you face as a result of divergence among the practices of the EU IP Offices regarding the assessment of the degree of freedom of the designer?

Please see above.

17. Do you think that agreeing on a Common Practice among the EU IP Offices regarding the assessment of the degree of freedom of the designer would be beneficial for the users?

No [A2]

18. Please justify your answer to question 17:

Please see above.

19. Do you foresee any difficulties that could arise during discussions to reach a Common Practice regarding the assessment of the degree of freedom of the designer?

Yes. Please see above.

20. Please provide us with any other comments that you find relevant for the analysis of this topic:

Final questions

21. Please rank the following topics in order of preference for launching a Convergence Project:

[Rank 1]

Criteria for assessing disclosure of designs on the internet [A4]

21. Please rank the following topics in order of preference for launching a Convergence Project:

[Rank 2]

Classification of ornamentation and its product indication [A5]

21. Please rank the following topics in order of preference for launching a Convergence Project:

[Rank 3]

Criteria of protection for a set of articles [A6]

21. Please rank the following topics in order of preference for launching a Convergence Project:

[Rank 4]

Assessment of the degree of freedom of the designer [A8]

22. Please provide us with a short summary of your comments on these 4 proposed topics (approximately 10 lines) which may be included in the second Analysis Paper and brought to the Working Group for discussion in March 2017:

On criteria for assessing disclosure of designs on the Internet:

INTA Designs Committee believes that EUIPO and national offices should be encouraged to apply strictly and more consistently the Regulation/ Directive and the case law of the Court of Justice. This would increase harmonization and legal certainty. This may be an appropriate issue for further training and capacity building, but it is not in our view an appropriate convergence project. Where there is potentially some prospect of convergence is the evidentiary requirements for proving disclosure.

On classification of ornamentation and its product indication:

INTA Designs Committee advocates for consistent and predictable practices on product indication between the EUIPO and Member States.

On criteria of protection for a set of articles

It is important that the convergence process avoids attempting to describe the scope of protection provided by a set registration - this is a matter for the courts. However, converged practice on how to file for a set is to be encouraged. INTA Designs Committee also supports the educative possibilities of a convergence project in this area.

On the assessment of the degree of freedom of the designer

INTA Designs Committee does not consider this to be an appropriate topic for a convergence program. We favor education and capacity building on this topic.

23. Are there any other topics on which you think it would be interesting to launch a Convergence Project?

CP6 was a huge success, in part because it focused on matters of office practice and procedure, rather than substantive law, and in part because of the active involvement of offices but also user groups to ensure that the practice arrived at was efficient and fair. INTA Designs Committee therefore supports further convergence projects of that nature. Ornamentation and sets fall within that. Disclosure and freedom of the designer do not. One issue which might be considered is what various offices examine. The Regulation is clear as to what the EUIPO examine - is it a design (and to reject if it "notifies" the design is contrary to public policy). National offices are not so constrained by the Directive, which left open examining full novelty, as well as some offices taking the unusual step of examining, for example, for "solely dictated by technical function". It would assist users of the system if all offices examined the same things - i.e., to harmonize the national approach with the EUIPO approach (which is in statute, and cannot readily be changed). It would also be worth reviewing the Design Study, which advocated a range of convergence efforts, some of which may be appropriate.

24. Please provide us with any additional comments that you consider relevant for this analysis of design topics:

INTA Designs Committee believes that it is important to improve the searchability of designs by appearance. Community Design Registrations can be and are increasingly used to protect what have traditionally been regarded as trademarks (e.g. registration of logos or 2D artwork as designs). However, it is not possible to search for such design registrations by their appearance. A Community Design Registration protects the design in respect of all products, so it creates real problems in clearing trademarks for use, when there may be a problematic design registration which is not searchable in a reliable way.

A good design search system would greatly enhance knowledge in the IP field. Such a system would also help increase "operational efficiency": it would allow offices and other stakeholders to search for prior designs and in case of conflicts or cancellation actions, make it easier to define the field and its boundaries in which a concrete action takes place. The quality of the Office's operations and the service for users would also be enhanced if there was a good system for conducting searches by design appearance for potentially conflicting earlier designs.

Design View is a good tool to search for specific goods from the official list of goods. Better graphical representation and the harmonization of the product indications will certainly help. However, an additional taxonomy or even the possibility of conducting an automated "image search" that would help finding certain design features of registered designs would be ideal for all stakeholders in the field of design protection and enforcement, and trademark clearance.

A simple to use "image search" would also help the Observatory on Infringements of Intellectual Property Rights, which is developing tools to help public authorities and rights owners enforce IP rights. An "image search" would certainly help in identifying potentially counterfeit goods and could be integrated in the Anti-Counterfeiting Rapid Intelligence System.