

Third Cycle Analysis: "USER ASSOCIATION QUESTIONNAIRE ON DESIGN TOPICS"

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Survey name (ID): Third Cycle Analysis: "USER ASSOCIATION QUESTIONNAIRE ON DESIGN TOPICS" (119449)

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Basic Data	
Please indicate the User Association that you represent:	INTA (International Trademark Association)
Please indicate your name and email address (in case clarification is needed regarding any of your answers):	Hélène Nicora - hnicora@inta.org
Requirements for logos and graphic symbols containing verbal elements and numerals	
1. Do you think that the practices of the Member States IPOs regarding the criteria for assessing requirements for logos and graphic symbols containing verbal elements and numerals are harmonised?	No [A2]
2. Do you think that agreeing on a Common Practice among the Member States IPOs regarding the criteria for assessing requirements for logos and graphic symbols	Yes [1]

<p>containing verbal elements and numerals would be beneficial for the users?</p>	
<p>3. Please justify your answer to question 2:</p>	<p>INTA would support a common practice on this topic. INTA supports convergence projects which consider harmonizing the practices of offices, as opposed to substantive legal issues.</p>
<p>4. Do you foresee any difficulties that could arise during discussions to reach a Common Practice regarding the criteria for assessing the requirements for logos and graphic symbols containing verbal elements and numerals?</p>	<p>See above.</p>
<p>5. In your opinion, would the example below be registrable as a design for "logos and graphic symbols" in Locarno Class 32?</p>	<p>Yes [A1]</p>
<p>6. Please justify your answer to question 5:</p>	<p>Whilst views differ, given the broad nature of the protection offered by EU design law, a broad definition of "graphic symbol" would appear to include the above. Rather than national offices and the EUIPO trying to draw a bright line between a plain font on the one hand and graphic symbols on the other, it may be more appropriate to allow designs such as the above to register, on the basis that they are likely to be invalid for absence of novelty/individual character. In the absence of behavior suggesting that many of designs similar to this are being wrongly registered, a convergence project in this area may also have an educative value.</p>

<p>7. In your opinion, would the example below be registrable as a design for "logos and graphic symbols" in Locarno Class 32?</p>	<p>Yes [1]</p>
<p>8. Please justify your answer to question 7:</p>	<p>See above.</p>
<p>9. Please provide us with any other comments that you find relevant for the analysis of this topic:</p>	<p>See above.</p>
<p>Assessment of the degree of freedom of the designer</p>	
<p>10. Do you think that the practices of the Member States IPOs regarding the assessment of the degree of freedom of the designer are harmonised?</p>	<p>No [2]</p>
<p>11. Do you think that agreeing on a Common Practice among the Member States IPOs regarding the assessment of the degree of freedom of the designer would be beneficial for the users?</p>	<p>No [2]</p>
<p>12. Please justify your answer to question 11:</p>	<p>INTA does not consider this to be an appropriate topic for a convergence project. Whilst we realize that practice differs between the EUIPO and the national offices, the law about freedom of the designer seems reasonably clear. 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. We believe these issues cannot be agreed by convergence for the same reason that convergence is inappropriate to</p>

	<p>agree on who the informed user is for example. Moreover, many national offices do not currently have to assess design freedom; such convergence project will be of less interest to them. INTA advocates that convergence projects are best in areas that involve all national offices and the EUIPO. INTA favors educations and capacity building on this topic.</p>
<p>13. 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?</p>	<p>See above. Especially, please note that some offices never have to assess design freedom.</p>
<p>14. In your opinion, when assessing the degree of freedom of the designer, would it be correct to analyse the different parts of the design separately, differentiating between features that are imposed by the technical function and features that are not? (e.g. USB stick)</p>	<p>No, the degree of freedom of the designer should be assessed for the design as a whole [2]</p>
<p>14. In your opinion, when assessing the degree of freedom of the designer, would it be correct to analyse the different parts of the design separately, differentiating between features that are imposed by the technical function and features that are not? (e.g. USB stick)</p> <p>[Comment]</p>	<p>The test for individual character relates to the design as a whole. Therefore, the influence of the degree of design freedom is on the design as a whole.</p>
<p>15. In your opinion, in which industrial sectors is application of the general criteria established by the Court of Justice of the European Union most problematic? (Please specify Class(es) of the Locarno Classification)</p>	<p>There is no such specific sector.</p>

<p>16. Please provide us with any other comments that you find relevant for the analysis of this topic:</p>	<p>There is detailed jurisprudence from the Boards of Appeal, General Court and Court of Justice on design freedom. It is clear from this that design freedom is one factor in a multifactorial assessment of individual character. The Court of Justice also clarified that there is actually a limited number of factors which limit design freedom. Therefore, in most cases, design freedom will be broad, and hence will not impact on the assessment. What will be more important in most cases is how much of a departure the design in issue was from the design corpus. This is therefore not an appropriate area for a convergence project. As design freedom plays an equal role in the assessment of infringement, it is important that any discussion on design freedom keeps that in mind, and does not relate only to validity. The fact that national offices and the EUIPO have no role in relation to assessing infringement is another reason why this area is unsuitable for a convergence project.</p>
<p>Identification of the informed user and circles specialised in the sector</p>	
<p>17. Do you think that the practices of the Member States IPOs regarding the identification of the informed user are harmonised?</p>	<p>No [2]</p>
<p>18. Do you think that the practices of the Member States IPOs regarding the identification of the circles specialised in the sector are harmonised?</p>	<p>No [2]</p>
<p>19. Do you think that agreeing on a Common Practice among the Member States IPOs</p>	<p>No [2]</p>

<p>regarding the identification of the informed user would be beneficial for the users?</p>	
<p>20. Do you think that agreeing on a Common Practice among the Member States IPOs regarding the identification of the circles specialised in the sector would be beneficial for the users?</p>	<p>No [2]</p>
<p>21. Please justify your answers to questions 19 and 20:</p>	<p>The Court of Justice has been clear in its case law in relation to the informed user (PepsiCo) and circles specialised (Gautsch). INTA believes that the 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. The informed user and circles specialised may be appropriate issues for further training and capacity building, but they are not in our view appropriate convergence projects.</p>
<p>22. Do you foresee any difficulties that could arise during discussions to reach a Common Practice regarding the identification of the informed user?</p>	<p>Yes, the question itself indicates some of the difficulties. The Court of Justice clarified that the informed user is a legal fiction, i.e. not a real person. Therefore, the informed user does not need to be "identified". One needs to know what makes the informed user "informed", and how the assessment of overall impression proceeds. However, one does not need to "identify" the informed user in the same way as one needs to identify the person skilled in the art in patent cases or the reasonably circumspect consumer in trademark cases. The case law of the Court of Justice is clear and should be applied by the EUIPO and national offices.</p>
<p>23. Do you foresee any difficulties that could arise during discussions to reach a Common</p>	<p>The question itself demonstrate the issues. The Court of Justice has been clear; the test for whether or not a prior disclosure "counts" for the purposes of</p>

<p>Practice regarding the identification of the circles specialised in the sector?</p>	<p>novelty/individual character is whether or not it is too obscure. According to the Court of Justice, a prior disclosure will be rarely too obscure. INTA does not support breaking the test down to the level the question suggests or seeking to give identity to the circles specialised. As mentioned before, the circles specialised are a fiction, and need no identity.</p>
<p>24. In your opinion, can the informed user be a manufacturer of the products in which the design at issue is intended to be incorporated?</p>	<p>No [3]</p>
<p>25. Please justify your answer to question 24:</p>	<p>INTA believes the Court of Justice has been clear on who the informed user is. Trying to make the informed user a manufacturer or a retailer is unhelpful. A manufacturer is probably closer to a person skilled in the art.</p>
<p>26. In your opinion, can the informed user be a seller of the products in which the design at issue is intended to be incorporated?</p>	<p>No [3]</p>
<p>27. Please justify your answer to question 26:</p>	<p>See above. A seller may be appropriately informed, and may be a user. However, this is not the question to ask.</p>
<p>28. In your opinion, can the informed user be a professional who acquires the products in which the design at issue is intended to be incorporated, in order to distribute them to the end users?</p>	<p>No [3]</p>
<p>29. Please justify your answer to question 28:</p>	<p>For the reasons mentioned before, we do not believe this an appropriate question. In any event, a distributor is not a user.</p>

<p>30. In your opinion, can the informed user be the end user of the product in which the design at issue is intended to be incorporated?</p>	<p>Yes [1]</p>
<p>31. Please justify your answer to question 30:</p>	<p>Yes - the informed user is a user. The Court of Justice has clarified this.</p>
<p>32. If the following design is registered for “toys” in Class 21.01 of the Locarno Classification and it is contested in invalidity proceedings (or it has been applied for and is opposed), who in your opinion would be the informed user whose perception is critical for the assessment of individual character?</p>  <p>[A child between 5-12 years of age who will play with the model house]</p>	
<p>32. If the following design is registered for “toys” in Class 21.01 of the Locarno Classification and it is contested in invalidity proceedings (or it has been applied for and is opposed), who in your opinion would be the informed user whose perception is critical for the assessment of individual character?</p>  <p>[Comment]</p>	

32. If the following design is registered for “toys” in Class 21.01 of the Locarno Classification and it is contested in invalidity proceedings (or it has been applied for and is opposed), who in your opinion would be the informed user whose perception is critical for the assessment of individual character?



[An adult who will purchase the toy]

32. If the following design is registered for “toys” in Class 21.01 of the Locarno Classification and it is contested in invalidity proceedings (or it has been applied for and is opposed), who in your opinion would be the informed user whose perception is critical for the assessment of individual character?



[Comment]

32. If the following design is registered for “toys” in Class 21.01 of the Locarno Classification and it is contested in invalidity proceedings (or it has been applied for and is opposed), who in your opinion would be the informed user whose perception is critical for the assessment of individual character?

Yes [Y]



[Anybody who is aware of the various designs that exist for model houses and possesses a certain degree of knowledge with regard to the features of products in the toy sector]

32. If the following design is registered for “toys” in Class 21.01 of the Locarno Classification and it is contested in invalidity proceedings (or it has been applied for and is opposed), who in your opinion would be the informed user whose perception is critical for the assessment of individual character?



[Comment]

32. If the following design is registered for “toys” in Class 21.01 of the Locarno Classification and it is contested in invalidity proceedings (or it has been applied for and is opposed), who in your opinion would be the informed user whose perception is critical for the assessment of individual character?



Yes [Y]

[Other. Please specify.]	
<p>32. If the following design is registered for “toys” in Class 21.01 of the Locarno Classification and it is contested in invalidity proceedings (or it has been applied for and is opposed), who in your opinion would be the informed user whose perception is critical for the assessment of individual character?</p>  <p>[Comment]</p>	<p>A person between a reasonably circumspect consumer from trademark law and the person skilled in the art from patent law.</p>
<p>33. Please provide us with any other comments that you find relevant for the analysis of this topic:</p>	
Final questions	
<p>34. Please rank the following topics in order of preference for launching a convergence project:</p> <p>[Rank 1]</p>	<p>Requirements for logos and graphic symbols containing verbal elements and numerals</p>
<p>34. Please rank the following topics in order of preference for launching a convergence project:</p> <p>[Rank 2]</p>	<p>Identification of the informed user and circles specialised in the sector</p>
<p>34. Please rank the following topics in order of preference for launching a convergence project:</p>	<p>Assessment of the degree of freedom of the designer</p>

[Rank 3]	
<p>35. Please provide us with a short summary of your comments on these proposed topics (approximately 10 lines) which may be included in the Analysis Paper and brought to the Working Group for discussion:</p>	<p>CP6 was a huge success, in part because it focused on matters of offices practice and procedure, rather than substantive law. It was also a success because of the active involvement of offices but also user groups to ensure that the practice arrived at was efficient, fair and beneficial to users. INTA therefore supports further convergence projects which focus on office practices and procedures. Requirements for logos and graphic symbols meet these criteria. However, the degree of freedom of the designer and the identification of the informed user and the circles specialised do not. INTA considers that the convergence projects are an excellent way of harmonizing office practice as between the EUIPO and national offices. However, INTA does not consider that the convergence projects are the most appropriate way of clarifying the law, in circumstances where the law is unclear. This is a matter for Community Design Courts and the Court of Justice. Therefore, any attempt to harmonize the legal analysis should be left to the courts. Moreover, there is little chance that many national offices will contribute to these issues as many of them do not assess individual character. This is examined ex officio by a few offices, but not by most offices 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 considers that convergence projects that involve the EUIPO and all national offices are to be preferred. It is essential that all user associations be properly consulted on any new envisaged project before the project is suggested to the MBBC. INTA would support an early written consultation of all user associations (and not only those present in a working group) on any new envisaged project, to ensure that</p>

	<p>the practice arrived at is efficient, fair and beneficial to users across the EU.</p>
<p>36. Are there any other topics on which you think it would be interesting to launch a convergence project?</p>	<p>One issue which might be considered is what various offices examine. On one hand, the Regulation is clear as to what the EUIPO examines and rejects if it "notices" the design is contrary to public policy. On the other hand, 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 cannot be readily changed). It would be worth reviewing the Design Study, which advocated a range of convergence efforts, some of which may be appropriate. INTA also believes that it is important to improve searchability of designs by appearance. Community designs registrations can be and are increasingly used to protect what have been 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</p>

	<p>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.</p>
<p>37. Please provide us with any additional comments that you consider relevant for this analysis of design topics:</p>	

